Supreme Court
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No. ____

In The Supreme Court of The United States

CHF INDUSTRIES, INC.,

Petitioner,

v.

PARK B. SMITH, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED FOR REVIEW

Whether the Federal Circuit erred in holding that Fed. R. App. P. 4(a)(2) permits a premature notice of appeal filed from an interlocutory order (that did not decide or dispose of all claims in the case) to operate as a notice of appeal from a subsequently-entered final order.

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

All parties appear in the caption of the case on the cover page. Petitioner CHF Industries, Inc. has no parent corporation and no publicly held company owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

CHF Industries, Inc. hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit entered in this case on February 6, 2009.

OPINIONS BELOW

The opinion of the Court of Appeals is unreported and is set forth in the Appendix ("App.") at A-1. The orders of the Court of Appeals denying motions to dismiss for lack of jurisdiction and for reconsideration are unreported and appear at App. A-6 and A-4, respectively.

The decision of the District Court is unreported and is set forth at App. A-9.

JURISDICTION

The judgment of the Court of Appeals was entered on February 6, 2009. No petition for rehearing was filed. This Court's jurisdiction is invoked pursuant to 28 U.S.C. § 1254(1).

The District Court had jurisdiction to hear Respondent's claim of patent infringement under 28 U.S.C. §§ 1331, 1338(a). The District Court had jurisdiction to hear Petitioner's counterclaims for a declaratory judgment of non-infringement, invalidity, and exceptional case under 28 U.S.C. § 2201(a). Petitioner asserts that the Federal Circuit lacked any

jurisdiction to hear Respondent's appeal under 28 U.S.C. § 1295(a)(1) or any other federal statute or rule.

STATUTES AND RULES INVOLVED

Title 28 U.S.C. §§ 1291, 1295, and 2107 (A-80, A-81, and A-85, respectively).

Rule 4 of the Federal Rules of Appellate Procedure (A-87).

Rules 54 and 58 of the Federal Rules of Civil Procedure (A-95 and A-98, respectively).

STATEMENT OF THE CASE

I. Introduction

In direct conflict with its jurisdictional statute, the Federal Rules of Appellate Procedure ("Rules"), and Supreme Court precedent, the Federal Circuit found that a premature notice of appeal from an interlocutory decision that did not dispose of all claims in the case ripened into an effective notice from a subsequently-entered final order, and thereby granted itself jurisdiction to hear an appeal that should have been dismissed.

The Federal Circuit specifically concluded that Respondent's notice of appeal filed from an interlocutory order granting a summary judgment of non-infringement ripened under Rule 4(a)(2) upon the subsequent disposition of the Petitioner's remaining declaratory judgment counterclaims. Rule 4(a)(2)

permits a premature notice of appeal that is filed "after" a district court's announcement of a final decision and "before" entry of judgment or a final order to be treated as filed after such entry and on the date thereof. The notice of appeal in this case, however, was filed *before* the announcement of a final decision.

Moreover, in *FirsTier Mortgage Co. v. Investors Mortgage Insurance Co.*, 498 U.S. 269 (1991) ("*FirsTier*"), this Court set forth the limited circumstances in which the saving provision of Rule 4(a)(2) applies. First, the decision from which appeal is taken must be one that "would be appealable if immediately followed by the entry of judgment." 498 U.S. at 276 (emphasis omitted). Second, the party who prematurely filed the notice of appeal must have done so because it "reasonably but mistakenly believe[d]" in the finality of the decision from which it was attempting to appeal. *Id.* Only in these circumstances does Rule 4(a)(2) permit a prematurely-filed notice of appeal to serve as an effective notice of appeal from a subsequently-entered final judgment or order.

In this case, the interlocutory order from which the Respondent appealed was not one that would be appealable if immediately followed by the entry of judgment, because it did not dispose of all claims in the case. And because Respondent shortly thereafter negotiated and signed a joint stipulation regarding the dismissal of Petitioner's pending counterclaims, Respondent indisputably knew or should have known that its premature notice of appeal was directed to an order that was neither final nor appealable.

II. District Court Proceedings

Respondent, Park B. Smith, Inc., filed suit against Petitioner, CHF Industries, Inc., in the United States District Court for the Southern District of New York accusing Petitioner of infringing two U.S. design patents. (A-33.) Petitioner answered and, in addition to its affirmative defenses, asserted multiple counterclaims under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, for non-infringement, invalidity, and exceptional case. (A-41, A-50 – A-58.) The District Court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 2201(a).

Petitioner moved for summary judgment of non-infringement of both patents-in-suit and invalidity of one of the patents. Respondent cross-moved for partial summary judgment of infringement. On March 6, 2008, the District Court issued a "Memorandum and Order" that (i) granted Petitioner's motion for summary judgment of non-infringement, (ii) denied Petitioner's motion for summary judgment of invalidity of one of the patents for claim indefiniteness, and (iii) denied Respondent's motion for partial summary judgment of infringement. (A-9, hereinafter "March 6, 2008 Order," at A-24.) The interlocutory March 6, 2008 Order also did not dispose of, or mention, any of Petitioner's other invalidity counterclaims, or its exceptional case counterclaim. Thus, the March 6, 2008 Order did not dispose of all claims in the case.

On March 10, 2008, the District Court Clerk entered a "Judgment" (that makes no reference to a "final judgment") for the purpose of effectuating the District Court's interlocutory March 6, 2008 Order. (A-

23, hereinafter "the March 10 judgment"). The March 10 judgment did not end the litigation on the merits, because it did not dispose of all of Petitioner's pending declaratory judgment counterclaims. Because all but one of Petitioner's declaratory judgment counterclaims remained outstanding, the March 10 judgment was not final as to all claims in the case, and did not dismiss the entire action. Moreover, the March 10 judgment was not certified for immediate appeal under Federal Rule of Civil Procedure 54(b) or under 28 U.S.C. § 1292(b).

On April 9, 2008, Respondent filed a Notice of Appeal from the March 10 judgment to the Second Circuit. (A-25.) Because Respondent had thereby appealed this patent suit to the wrong Court of Appeals, Respondent filed a second Notice of Appeal on April 21, 2008, naming the Federal Circuit. (A-27, hereinafter "Premature Notice of Appeal.")[1]

Apparently aware that the March 10 judgment was not final and appealable, on April 23, 2008, Respondent negotiated and signed a joint stipulation agreeing to the voluntary dismissal of Petitioner's pending declaratory judgment counterclaims. (A-29.) Pursuant to the joint stipulation, on May 6, 2008, the District Court issued an order dismissing without

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[1] Although Respondent's second notice is dated and bears a date stamp of April 9, 2008, Respondent admitted in a special conference before the District Court on May 20, 2008, that the second notice of appeal was actually filed on April 21, 2008. Respondent's back-dating of its April 21, 2008 notice of appeal will be the subject of discovery concerning litigation misconduct in connection with Petitioner's counterclaim that this is an exceptional case warranting an award of attorneys' fees.

prejudice all of Petitioner's outstanding counterclaims. (A-32.)

The District Court's May 6, 2008 Order was a final decision for the purpose of appeal; it ended the litigation between the parties on the merits of the case and left nothing to be done. The Order was entered on the same day. (A-110, A-136.) The only final and appealable order rendered by the District Court was thus entered on May 6, 2008.

Respondent did not file any notice (or amended notice) of appeal within 30 days of entry of the District Court's final order on May 6, 2008 — the triggering event that started the clock running on Respondent's time to appeal. (*See* A-136.) The Federal Circuit docketed the case notwithstanding the fact that no timely notice of appeal had been filed by June 5, 2008.[2]

III. Federal Circuit Proceedings

Petitioner moved to dismiss the appeal on the ground that the Federal Circuit lacked jurisdiction to hear the appeal. In an unpublished order authored by a single judge, the Federal Circuit denied Petitioner's motion to dismiss on June 19, 2008. (A-6, A-8.) The Court of Appeals determined that the case involved a "premature [notice of] appeal filed before the disposition

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[2] Even if entry of the May 6, 2008 Order did not satisfy the separate document requirement of Fed. R. Civ. P. 58(a), the judgment would have been considered entered on October 3, 2008 — 150 days after the May 6 Order was entered on the docket. *See* Fed. R. Civ. P. 58(c). Respondent also did not file any notice (or amended notice) within 30 days of October 3, 2008.

of pending claims and before entry of final judgment." (A-7.) The Court of Appeals ruled, however, that "[Respondent] filed a premature notice of appeal that ripened upon disposition of the pending counterclaims. Fed. R. App. P. 4(a)(2)." (A-7.) Apart from its single, bald citation to Rule 4(a)(2), the Federal Circuit provided no reasoning to support its conclusion regarding an important issue of appellate jurisdiction. The Federal Circuit's opinion does not even acknowledge the existence of this Court's controlling precedent — *FirsTier*.

Petitioner filed a motion for reconsideration of the June 19, 2008 order. The motion was denied without explanation. (A-4 – A-5.)

In its main brief, Petitioner raised the jurisdictional issue again and argued that the Federal Circuit lacked jurisdiction to hear the appeal under Rule 4. (A-63 – A-64.) In addition, at oral argument before a three-judge panel of the Federal Circuit, Petitioner again raised the jurisdictional issue.

On February 6, 2009, in a two-sentence *per curiam* opinion, the Federal Circuit vacated the District Court's March 6, 2008 summary judgment of non-infringement, and remanded the case to the District Court. (A-1, A-3.) The Court of Appeals did so in view of its decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (*en banc*), *cert. denied*, No. 08-1031, 77 U.S.L.W. 3556 (U.S. April 6, 2009), which revised the test for infringement of design patents. (A-2 – A-3.) The Federal Circuit's February 6, 2009 opinion was completely silent concerning the jurisdictional issue,

despite the Court of Appeals' special obligation to satisfy itself of its own jurisdiction. *E.g., Bender v. Williamsport Area Sch. Dist.*, 475 U.S. 534, 541 (1986).

REASONS FOR GRANTING THE PETITION

I. The Federal Circuit's Decision Below Concerning the Scope of Its Jurisdiction Under Rule 4(a)(2) Conflicts With Statute, the Federal Rules of Appellate Procedure, and Controlling Supreme Court Precedent — *FirsTier*

The Federal Circuit impermissibly expanded its jurisdiction to hear this case by stretching Rule 4(a)(2) without statutory authority and against controlling Supreme Court precedent.

The saving provision of Rule 4(a)(2) simply does not apply here. Neither the District Court's March 6, 2008 Order granting summary judgment of non-infringement nor the March 10 judgment entered shortly thereafter was an appealable, final decision or order — a fact quickly realized by the Respondent. The March 6, 2008 summary judgment order from which Respondent sought review — which only addressed a few of the claims in the case — is a classic example of an interlocutory order that was only one step towards final disposition of the case. It was not appealable as a final order even after entry of the March 10 judgment, and the Federal Circuit erred in applying Rule 4(a)(2)'s saving provision to Respondent's Premature Notice of Appeal.

Before we reach the Federal Circuit's misapplication of Rule 4(a)(2), we first analyze the scope of the Federal Circuit's appellate jurisdiction, namely (i) whether the Federal Circuit had jurisdiction to review the interlocutory March 6, 2008 Order in this case, and (ii) whether the Federal Circuit's jurisdiction was properly invoked.

A. The Federal Circuit Does Not Have Jurisdiction Over an Interlocutory Order That Did Not Dispose of All Claims in the Case and Was Not Otherwise Certified as a Final Order

The Supreme Court has stated that "[f]ederal courts are courts of limited jurisdiction. They possess only that power authorized by [the] Constitution and statute, which is not to be expanded by judicial decree." *Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 377 (1994) (citations omitted).

The Federal Circuit's jurisdiction is limited to (i) final decisions described in 28 U.S.C. § 1295 (*see* 28 U.S.C. § 1291), (ii) decisions that are certified pursuant to Fed. R. Civ. P. 54(b) for immediate appeal as to one or more but fewer than all of the claims or parties, (iii) certain interlocutory decisions described in 28 U.S.C. §§ 1292(c) and (d), and (iv) certain other narrow exceptions to the final order rule that are inapplicable here. *See, e.g., Johnson v. Jones*, 515 U.S. 304, 309-10 (1995) (describing final order rule of Section 1291 and its limited exceptions); *Nystrom v. Trex Co.*, 339 F.3d 1347, 1350-51 (Fed. Cir. 2003) (describing final order rule of

Section 1295 and its limited exceptions, mirroring the discussion in *Johnson*). *See generally* Fed. R. Civ. P. 54 Advisory Committee Notes, 1946 Amendment ("The historic rule in the federal courts has always prohibited piecemeal disposal of litigation and permitted appeals only from final judgments except in those special instances covered by statute."). (A-107.)

As a threshold matter, neither party sought, and the District Court did not enter, an order certifying an immediate appeal pursuant to Fed. R. Civ. P. 54(b). In addition, the Federal Circuit's appellate jurisdiction over the interlocutory decisions defined in 28 U.S.C. § 1292 is not at issue in this case. There is no dispute that such jurisdiction was not invoked in this case. The District Court's March 6, 2008 Order, which did not dispose of all claims in the case, was not certified for immediate appeal under Fed. R. Civ. P. 54(b), and is simply not the type of interlocutory decision that the Federal Circuit has jurisdiction to review under Section 1292. Thus, if the Federal Circuit had jurisdiction in this case, it would have to have been based somehow on 28 U.S.C. § 1295.[3]

Section 1295(a)(1) provides that the Federal Circuit has appellate jurisdiction in patent cases only "from a *final decision* of a district court." 28 U.S.C. § 1295(a)(1) (emphasis added). The Supreme Court has

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[3] The collateral order doctrine, another narrow exception to the final order rule, is clearly inapplicable to the case at bar. *See, e.g., Johnson*, 515 U.S. at 310 (collateral order doctrine permits appeal of an order that would be unreviewable on appeal from a final judgment and conclusively determines an important issue completely separate from the merits of an action).

established that "a 'judgment' or 'decision' is final for the purpose of appeal only 'when it terminates the litigation between the parties on the merits of the case, and leaves nothing to be done but to enforce by execution what has been determined." *Parr v. United States*, 351 U.S. 513, 518 (1956) (internal citations omitted). *Accord, e.g., Catlin v. United States*, 324 U.S. 229, 233 (1945) (same).

The statutory requirement of "finality" that limits the Federal Circuit's jurisdiction to review of final decisions or judgments is more than a mere technical rule of procedure, yielding when necessary to the exigencies of particular situations. *Cobbledick v. United States*, 309 U.S. 323, 326 (1940) ("For purposes of appellate procedure, finality . . . is not a technical concept of temporal or physical termination. It is the means for achieving a healthy legal system. As an instrument of such policy the requirement of finality will be enforced . . . ."). Rather, it is a longstanding and healthy federal policy that protects litigants and courts from the disruptions of piecemeal review.

As this Court observed in *Johnson*:

> [R]ules that permit too many interlocutory appeals can cause harm. An interlocutory appeal can make it more difficult for trial judges to do their basic job — supervising trial proceedings. It can threaten those proceedings with delay, adding costs and diminishing coherence. It also risks additional, and unnecessary, appellate court work either when it presents appellate courts with less developed

> records or when it brings them appeals that, had the trial simply proceeded, would have turned out to be unnecessary.

515 U.S. at 309. *See also Cobbledick*, 309 U.S. at 325 ("Congress from the very beginning has, by forbidding piecemeal disposition on appeal of what for practical purposes is a single controversy, set itself against enfeebling judicial administration.").

Moreover, allowing appeals from decisions that are not truly final (*e.g.*, where, as here, there has been no 54(b) certification, and pending counterclaims have not been resolved) encourages parties to file interlocutory appeals, which results in administrative headaches and wasteful jurisdictional litigation.

In short, for the District Court's March 6, 2008 Order to have been appealable, it had to decide or dismiss all the claims and counterclaims then pending in the case, or fall within one of the exceptions to the finality rule of Section 1295. Here, the District Court's March 6, 2008 Order did not decide or dismiss the counterclaims in the case and did not terminate the litigation on the merits. The interlocutory order only resolved Respondent's infringement claims and (implicitly) granted Petitioner's counterclaim for a declaratory judgment of non-infringement. It did not foreclose further dispute and trial on the remaining declaratory judgment counterclaims still pending in the case — *i.e.*, Petitioner's invalidity and exceptional case counterclaims.

Moreover, the interlocutory March 6, 2008 Order did not fall within any of the limited exceptions to the final order requirement. It is undisputed that the District Court did not make or enter an express Rule 54(b) judgment or a Section 1292(b) certification in this case. Neither party sought such a judgment or certification of the March 6, 2008 summary judgment order or the March 10 judgment. Instead, after the March 10 judgment was entered, the parties negotiated and agreed to a joint stipulation to dismiss Petitioner's outstanding counterclaims. The District Court allowed the parties to so stipulate and ordered the pending counterclaims dismissed without prejudice. The case thus did not come to a conclusion until the District Court's May 6, 2008 Order was entered. At that point, Respondent's statutorily-defined time to appeal began.

The Federal Rules of Civil Procedure also make clear that absent an express 54(b) judgment,

> *any order or other decision,* however designated, *that adjudicates fewer than all the claims* or the rights and liabilities of fewer than all the parties *does not end the action* as to any of the claims or parties and may be revised at any time before the entry of a judgment adjudicating all the claims and all the parties' rights and liabilities.

Fed. R. Civ. P. 54(b). In sum, the District Court did not enter a Rule 54(b) judgment, and because the March 6, 2008 Order was not a "final decision" that disposed of all

claims and counterclaims in the case, it was not appealable to the Federal Circuit under Section 1295(a)(1).

Understanding the bounds of the Federal Circuit's appellate jurisdiction includes not only understanding when the Court of Appeals has jurisdiction (*i.e.*, which orders the Federal Circuit has jurisdiction to review), but also whether the Federal Circuit's jurisdiction was properly and timely invoked.

B. The Federal Circuit's Jurisdiction Was Neither Properly Nor Timely Invoked Because a Notice Of Appeal Was Not Filed Within 30 Days After Entry of the District Court's May 6, 2008 Final Order

The governing statute and Federal Rule of Appellate Procedure are clear — the Federal Circuit's jurisdiction is limited to appeals filed *after* entry of a final judgment or order. 28 U.S.C. § 2107(a); Fed. R. App. P. 4(a)(1)(A). In this case, Respondent did not file any notice of appeal *after* entry of the final order that terminated the case on May 6, 2008. Respondent's Premature Notice of Appeal was filed from an interlocutory order and prior to the announcement and entry of the May 6, 2008 final order. It was fatally premature and ineffective for purposes of invoking appellate review.

28 U.S.C. § 2107(a) clearly defines the time period for appealing, *i.e.*, within 30 days *after* the final order is entered:

> Except as otherwise provided in this section, no appeal shall bring any judgment, order or decree in an action, suit or proceeding of a civil nature before a court of appeals for review *unless notice of appeal is filed, within thirty days after the entry of such judgment, order or decree.*

28 U.S.C. § 2107(a) (emphasis added). The parallel appellate rule also plainly states: "In a civil case, . . . *the notice of appeal* required by Rule 3 *must be filed* with the district clerk *within 30 days after the judgment or order appealed from is entered.*" Fed. R. App. P. 4(a)(1)(A) (emphasis added; inapplicable exceptions omitted).

"[Section] 2107 contains the type of statutory time constraints that would limit a court's jurisdiction." *Bowles v. Russell*, 127 S.Ct. 2360, 2364-65 (2007). When the purpose of a statute is clear from its words, this Court "follow[s] their plain meaning." *United States v. Am. Trucking Ass'ns*, 310 U.S. 534, 543 (1940).

Moreover, this Court has made clear that the courts of appeals must follow the "plain wording of the Rules" and, in particular, the "plain import of [the] language." *Acosta v. Louisiana Dep't of Health and Human Resources*, 478 U.S. 251, 253-54 (1986).

The plain words of the governing statute and rule make clear that the time for filing an appeal begins when the judgment or order appealed from was "entered." Of course, as discussed *supra*, the lower court's decision

must first be appealable. Because the Federal Circuit's jurisdiction is limited to review of certain interlocutory decisions (not applicable here) and "final decisions," the time period for appealing in this case began on May 6, 2008, when the final order dismissing Petitioner's outstanding counterclaims was entered. The time period for Respondent to file its appeal ended 30 days thereafter. Respondent did not file any notice of appeal during that 30-day period, or at any time thereafter.

The time limits for filing a notice of appeal under Section 2107(a) and Rule 4(a)(1)(A) are inflexible. "Under Fed.Rule App.Proc. 4(a) and 28 U.S.C. § 2107, a notice of appeal in a civil case must be filed within 30 days of entry of the judgment or order from which the appeal is taken." *Browder v. Dir., Dep't of Corrections of Illinois,* 434 U.S. 257, 264 (1978). "This Court has long held that the taking of an appeal within the prescribed time is 'mandatory and jurisdictional.'" *Bowles,* 127 S.Ct. at 2363 (citing *Griggs v. Provident Consumer Discount Co.,* 459 U.S. 56, 61 (1982) (*per curiam*)). Indeed, this Court in *Bowles* could not have been more clear: "Today we make clear that the timely filing of a notice of appeal in a civil case is a jurisdictional requirement." *Id.* at 2366.

Further, this Court has made clear that time periods in the federal rules characterized as "jurisdictional" are to be strictly applied. *Eberhart v. United States,* 546 U.S. 12, 18-20 (2005) (*per curiam*).

This Court has long held that "when an 'appeal has not been prosecuted in the manner directed, within the time limited by the acts of Congress, it must be

dismissed for want of jurisdiction.'" *Bowles,* 127 S.Ct. at 2366 ("Bowles' failure to file his notice of appeal in accordance with the statute therefore deprived the Court of Appeals of jurisdiction."), citing *United States v. Curry,* 47 U.S. 106, 113 (1848).

In short, Respondent's failure to file a timely notice of appeal as required by Section 2107(a) and Rule 4(a)(1)(A) deprived the Federal Circuit of jurisdiction. And as will be discussed below, the saving provision of Rule 4(a)(2), which permits certain premature notices of appeal to serve as effective notices, does not apply here.

C. Rule 4(a)(2) Does Not Apply to a Premature Notice of Appeal Filed From an Interlocutory Order That Did Not Decide or Dismiss All Claims in the Case

The saving provision of Rule 4(a)(2) only permits *certain* (not all) premature notices of appeal to serve as effective notices from subsequently-entered final judgments or orders: "A notice of appeal filed after the court announces a decision or order — but before the entry of the judgment or order — is treated as filed on the date of and after the entry." Fed. R. App. P. 4(a)(2). Thus, in limited circumstances, Rule 4(a)(2) provides a basis on which a premature notice of appeal relates forward to the date of entry of a final judgment or order and serves as an effective notice of appeal. But Respondent's appeal to the Federal Circuit does not fall within Rule 4(a)(2)'s reach. Without some other basis for finding Respondent's Premature Notice of Appeal to be effective for appeal purposes, the Federal Circuit

should have declined jurisdiction over Respondent's appeal.

Rule 4(a)(2) was intended to deal with specific situations where a decision or order is final in substance although not in form. The Advisory Committee Notes from 1993 — the last time the subsection (a)(2) was amended — explain: "The amendment treats a notice of appeal filed after the announcement of a decision or order, but before its formal entry, as if the notice had been filed after entry." Fed. R. App. P. 4 Advisory Committee Notes, 1993 Amendment. (A-101.)

In other words, the purpose of Rule 4(a)(2) was to protect litigants from losing the right to appeal when they prematurely file a notice of appeal *after* a district court announces a final decision but before its formal entry as a final judgment or order. The provision was not intended to protect litigants against knowing disregard of appeal requirements; and it was not intended to validate an anticipatory notice of appeal filed prior to a final decision. Phillip Allen Lacovara *et al.*, Federal Appellate Practice 82 (2008) ("Note, however, that a notice of appeal filed before the court announces an *appealable* decision is ineffective and does not protect the right to appeal from a later, appealable decision.").

Respondent's Premature Notice of Appeal does not meet the requirements of Rule 4(a)(2). The interlocutory March 6, 2008 Order from which Respondent filed a notice of appeal did not announce an appealable decision that only needed to be entered as a final judgment or order. In fact, the interlocutory order was entered as a judgment on March 10, 2008, but

Petitioner's counterclaims seeking a declaratory judgment of invalidity and exceptional case remained unresolved. Thus, when Respondent filed its Premature Notice of Appeal to the Federal Circuit on April 21, 2008, no appealable decision or final order had yet been announced or entered.

The Federal Circuit apparently realized as much in its order denying Petitioner's motion to dismiss for lack of jurisdiction: "[T]here was no final judgment when the notices of appeal were filed . . . ." (A-7.)[4] The Federal Circuit thus implicitly determined that the interlocutory March 6, 2008 Order did *not* announce a final decision that only needed to be entered via the March 10 judgment. But the Federal Circuit's reliance on Rule 4(a)(2) to save Respondent's Premature Notice of Appeal then falls apart.

As noted above, Rule 4(a)(2) only applies to notices of appeal filed *after* the announcement of a final decision, but before its formal entry. In this case, while the interlocutory March 6, 2008 Order was formally entered as a judgment on March 10, the March 10 judgment could not and did not transform the interlocutory March 6, 2008 Order into a final, appealable decision or order. The Federal Circuit's implicit determination that the May 6, 2008 Order dismissing Petitioner's unresolved counterclaims somehow "ripened" Respondent's Premature Notice of Appeal (A-7) is legally erroneous and inconsistent with the requirements of Rule 4(a)(2).

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[4] Respondent's notice of appeal to the Second Circuit filed on April 9, 2008 adds nothing that would help Respondent's position under Rule 4(a)(2).

This is not a situation in which what remained to be done after the District Court issued its interlocutory March 6, 2008 Order was a mere formality. Quite the contrary, Petitioner's counterclaims for a declaratory judgment of invalidity and exceptional case remained outstanding. The counterclaims were not dismissed until two weeks after Respondent filed its Premature Notice of Appeal. Specifically, after the Premature Notice of Appeal (A-27 – A-28) was filed, the parties negotiated and agreed to a joint stipulation dismissing all pending counterclaims without prejudice (A-29 - A-31), which placed the case in a posture for appeal. Therefore, and significantly, Respondent knew (or certainly should have known) that its Premature Notice of Appeal was filed from a non-final, interlocutory decision, and was ineffective to invoke the Federal Circuit's appellate jurisdiction.

In sum, the Federal Circuit has stretched Rule 4(a)(2) to save a premature notice of appeal filed *before* the announcement of a final decision, notwithstanding the intent of the Rule. As a result, the Federal Circuit has improperly expanded its jurisdiction in this case (and similar cases) without statutory authority. Indeed, absent a tolling motion under subsection (a)(4), Rule 4(a)(2) provides the only basis on which a premature notice of appeal may relate forward to become an effective notice following entry of final judgment.

As will be discussed in Part II. *infra*, a number of Circuits in addition to the Federal Circuit misinterpret Rule 4(a)(2), while other Circuits have adopted an

interpretation that conforms to this Court's analysis of Rule 4(a)(2) in *FirsTier*..

D. The Federal Circuit Has Contravened *FirsTier*, This Court's Controlling Precedent Interpreting Rule 4(a)(2)

The Federal Circuit's basis for finding jurisdiction is not only inconsistent with the intent of Rule 4(a)(2), but also conflicts with controlling precedent of this Court interpreting the Rule. The Federal Circuit found that Rule 4(a)(2) saved Respondent's Premature Notice of Appeal despite the requirement of *FirsTier* that the decision from which appeal is taken must be one that "would be appealable if immediately followed by the entry of judgment." *FirsTier*, 498 U.S. at 276 (emphasis omitted). In view of *FirsTier*, which was ignored or went unnoticed by the Federal Circuit, Respondent cannot qualify for relief under Rule 4(a)(2).

In *FirsTier*, this Court squarely held that Rule 4(a)(2) applies only when two requirements are met. *First*, the order from which appeal is taken must be one that "would be appealable if immediately followed by the entry of judgment." *Id.* (emphasis omitted). Stated differently, the decision from which the notice of appeal is filed must finally dispose of all claims and counterclaims in the case. *See, e.g., Parr*, 351 U.S. at 518 (decision is final for purposes of appeal only when it leaves nothing to be done but to enforce the decision by execution).

Second, the litigant who prematurely filed a notice of appeal must have done so because it

"reasonably but mistakenly believe[d]" in the finality of the decision from which it was attempting to appeal. *FirsTier*, 498 U.S. at 276. As the Court observed in *FirsTier*: "This is not to say that Rule 4(a)(2) permits a notice of appeal from a clearly interlocutory decision . . . to serve as a notice of appeal from the final judgment. A belief that such a decision is a final judgment would not be reasonable." *Id.*

As shown above, *FirsTier* provides clear boundaries of appellate jurisdiction based on Rule 4(a)(2) — important jurisdictional boundaries that the Federal Circuit has ignored in this case and has continued to ignore in its binding precedent interpreting Rule 4(a)(2).

To begin with, this Court in *FirsTier* cautioned that Rule 4(a)(2) applies only to notices of appeal filed from a "decision that would be appealable if immediately followed by the entry of judgment." *Id.* (emphasis omitted). This Court held that the bench ruling in *FirsTier* was a "decision" for purposes of Rule 4(a)(2) because "the bench ruling did announce a decision purporting to dispose of all of FirsTier's claims." *Id.* at 277. This Court further reasoned: "Had the judge set forth the judgment immediately following the bench ruling, and had the clerk entered the judgment on the docket, . . . , there is no question that the bench ruling would have been 'final' under § 1291." *Id.*[5]

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[5] Although the Supreme Court based its decision in *FirsTier* on the provisions of Section 1291, the same reasoning would apply in the case at bar to the Federal Circuit's jurisdictional statute (28 U.S.C. § 1295(a)(1)), which shares the same finality requirement as Section 1291.

That is not the case here. The interlocutory March 6, 2008 Order from which Respondent purported to appeal plainly was not an appealable decision, because it did not resolve or dispose of Petitioner's counterclaims seeking a declaratory judgment of patent invalidity and exceptional case.[6] Those counterclaims were still pending after Respondent filed its Premature Notice of Appeal. Hence, the interlocutory March 6, 2008 Order cannot be regarded as an appealable and final decision in substance although not in form; and the subsequent disposition by the parties and the District Court of multiple unresolved declaratory judgment counterclaims can hardly be regarded as a ministerial act.

Moreover, in *FirsTier*, this Court determined that had the District Court's bench ruling been immediately entered as a judgment, the bench ruling would have been final and appealable. As noted above, that is clearly not the case here with respect to the District Court's interlocutory March 6, 2008 Order. Unlike the situation in *FirsTier*, the interlocutory March 6, 2008 Order could not be made final merely by the District Court's entry of judgment on March 10, 2008. Like its interlocutory March 6, 2008 Order, the District Court's March 10, 2008 judgment did not dispose of Petitioner's declaratory judgment counterclaims. Only

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[6] Although it failed to correctly apply the principle in the context of Rule 4(a)(2), even the Federal Circuit recognizes this black letter rule. *E.g.*, *Nystrom v. Trex Co.*, 339 F.3d 1347, 1350, 1351 (Fed. Cir. 2003) ("a 'judgment that does not dispose of pending counterclaims is not a final judgment.'"), quoting *Pandrol USA, LP v. Airboss Railway Prods., Inc.*, 320 F.3d 1354, 1362 (Fed. Cir. 2003).

the District Court's later entry of its May 6, 2008 Order dismissing Petitioner's outstanding counterclaims constituted entry of a final, appealable order. Thus, Respondent fails to satisfy *FirsTier*'s first requirement for applying Rule 4(a)(2) — *i.e.*, the order from which appeal is taken must be one that "would be appealable if immediately followed by the entry of judgment." 498 U.S. at 276 (emphasis omitted).

Further still, Respondent indisputably knew, or should have known, that its Premature Notice of Appeal was directed to an order that was neither appealable nor final. On April 23, 2008 — just after it filed its Premature Notice of Appeal — Respondent negotiated and signed a joint stipulation regarding the dismissal (without prejudice) of Petitioner's pending declaratory judgment counterclaims. (A-27 – A-28, A-29 – A-31.) In view of this record, Respondent cannot now credibly assert that, as of April 23, 2008, it had any belief — let alone a reasonable belief — in the finality and appealability of the March 6, 2008 Order from which it purported to appeal.

Respondent thereby also fails to meet *FirsTier's* second requirement for applying Rule 4(a)(2) — *i.e.*, that the litigant who prematurely filed a notice of appeal must have done so because it "reasonably but mistakenly believe[d]" in the finality of the decision from which it was attempting to appeal. 498 U.S. at 276. Any assertion that the Respondent "reasonably" believed in the finality of the District Court's March 6, 2008 interlocutory order, particularly after Respondent's April 23, 2008 entry into a stipulated dismissal of

Petitioner's remaining counterclaims, would be completely implausible.

In sum, Respondent fails to meet the express requirements set forth by this Court in *FirsTier* for applying Rule 4(a)(2). In particular, under *FirsTier*, the relation forward allowed by Rule 4(a)(2) clearly does not apply to Respondent's Premature Notice of Appeal — a notice that was filed after an interlocutory order that did not decide or dispose of all claims in the case, in a case where Respondent indisputably knew, or should have known, that the order being appealed from was not final. But the Federal Circuit has ignored or refused to apply this Court's controlling interpretation of Rule 4(a)(2) in *FirsTier*.

The Federal Circuit's order denying Petitioner's motion to dismiss for lack of jurisdiction (A-6) does not cite any authority for its interpretation of Rule 4(a)(2), but appears to follow a post-*FirsTier* line of Federal Circuit cases that directly conflicts with both *FirsTier* and the intent of Rule 4(a)(2). *See, e.g., E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1367 (Fed. Cir. 2003) ("*E-Pass*") ("[the] premature notice of appeal ripen[ed] upon subsequent action by the district court, here the dismissal of 3Com's counterclaims.") (internal quotations omitted); *State Contracting & Eng'g Corp. v. Florida*, 258 F.3d 1329, 1335 (Fed. Cir. 2001) ("*State Contracting*") ("a premature notice of appeal ripens upon entry of a proper Rule 54(b) certification.")

In *E-Pass*, factually similar to the case at bar, the District Court granted defendant's motion for summary judgment of non-infringement. 343 F.3d at 1366. The

order did not decide or dismiss the defendant's outstanding counterclaims. *Id.* Plaintiff filed a notice of appeal from the partial summary judgment. *Id. at* 1367. The District Court then dismissed the pending counterclaims of invalidity without prejudice. *Id.* Citing *State Contracting*, the Federal Circuit held that the premature notice of appeal ripened upon the subsequent disposition of the pending counterclaims. *Id.*

The Federal Circuit's decision in *E-Pass* ignored controlling Supreme Court precedent — *i.e.*, *FirsTier*. Moreover, the facts in *State Contracting* differed significantly from those in *E-Pass*.

State Contracting dealt with a Fed. R. Civ. P. 54(b) certification, not with the subsequent disposition of pending claims. *State Contracting*, 258 F.3d at 1334. In particular, the Federal Circuit held that a belated Fed. R. Civ. P. 54(b) certification ripened a premature notice of appeal. *Id.* at 1335. Just as in *E-Pass*, the Federal Circuit did not cite or discuss *FirsTier*. Because *E-Pass* extended the ruling of *State Contracting* from its moorings, and the Federal Circuit failed to consider *FirsTier* as binding precedent in either decision, the Federal Circuit's approach in these cases is questionable, at the very least.

In this case, the panel below appears to have followed this line of published Federal Circuit decisions that are in direct conflict with *FirsTier* — the leading Supreme Court decision on the application of Rule 4(a)(2). In so doing, the Federal Circuit is applying a substantially more expansive rule of appellate

jurisdiction than Congress or the Supreme Court's *FirsTier* decision permit.

There also is a separate, unpublished line of Federal Circuit cases that apply Rule 4(a)(2) as interpreted by *FirsTier*. *See Meade Instruments Corp. v. Reddwarf Starware, LLC*, No. 99-1571, 2000 WL 987268, at *3 (Fed. Cir. June 23, 2000) (non-precedential) ("the Supreme Court's *FirsTier* decision prevents us from asserting appellate jurisdiction over this case. Unlike the situation in *FirsTier*, the district court's order did not purport to dispose of all of [plaintiff's] claims . . . .") (A-65, A-71); *Stoney Point Prods., Inc. v. Underwood*, 15 Fed.Appx. 828, 831 (Fed. Cir. June 7, 2001) (non-precedential) (after determining that Rule 4(a)(2) has limited applicability after *FirsTier*, the Federal Circuit held that defendant's premature notice of appeal filed after a partial summary judgment order but before all claims were dismissed pursuant to a stipulation was ineffective to invoke appellate jurisdiction) (A-73, A-77 – A-78).

The panel in the case at bar apparently chose to follow the line of Federal Circuit cases that conflict with this Court's decision in *FirsTier*. These conflicting lines of published and unpublished decisions demonstrate the profound confusion within the Federal Circuit about its appellate jurisdiction under *FirsTier*. The correct scope of appellate jurisdiction under Rule 4(a)(2) is an important question that should be re-visited and settled by this Court, particularly in light of the direct and irreconcilable clash between the Federal Circuit's ruling below and this Court's decision in *FirsTier*.

II. There Is an Acknowledged Conflict Among the Circuits Concerning the Proper Scope of Appellate Jurisdiction Under Rule 4(a)(2) in View of *FirsTier*

The opinion below (and the published line of Federal Circuit cases that apply Rule 4(a)(2) broadly) not only conflict with *FirsTier* and the requirements of Rule 4(a)(2), but also are irreconcilable with decisions of other Circuits. In short, there is a meaningful split among the Circuits as to (i) the correct interpretation of Rule 4(a)(2) and (ii) whether and when *FirsTier* applies to a premature notice of appeal filed from an interlocutory order that does not dispose of all claims in a case.

The conflicting decisions are not isolated anomalies, but represent a true, ongoing conflict since the Supreme Court last interpreted Rule 4(a)(2) more than 18 years ago in *FirsTier*. The meaningful split and outright confusion among the Circuits, which justify the exercise of this Court's jurisdiction, have resulted in considerable uncertainty as to whether premature notices of appeal are effective to invoke appellate jurisdiction. The conflict between the Circuits on such a fundamental and important issue of appellate jurisdiction needs to be addressed and clarified by this Court.

The Circuit split has arisen out of uncertainties in applying Rule 4(a)(2) and in interpreting *FirsTier*. "The problem with Rule 4(a)(2) is that it is imprecise — it does not tell us *which* announced decisions permit

relation forward." *Strasburg v. State Bar of Wisconsin*, 1 F.3d 468, 471 (7th Cir. 1993), *overruled on other grounds by Otis v. City of Chicago*, 29 F.3d 1159 (7th Cir. 1994). "The reach of Rule 4(a)(2) after *FirsTier*, however, remains somewhat unclear.... The examples that the Court gave of situations in which Rule 4(a)(2) would *not* save a premature appeal... leave a vast middle ground of uncertainty." *Outlaw v. Airtech Air Conditioning and Heating, Inc.*, 412 F.3d 156, 161 (D.C. Cir. 2005).

The Circuits finding jurisdiction are acting as if 28 U.S.C. § 2107(a) and the Federal Rules of Appellate Procedure did not explicitly define the time window for appealing from a district court's judgment or order in a civil action. Rule 4(a)(2), however, in conjunction with Section 2107, imposes express limits on when a party can appeal. These limits ensure that parties will not appeal in a piecemeal manner from interlocutory orders and that parties will act within a reasonable time to perfect an appeal upon entry of a final decision or order.[7]

Most of the Circuits have addressed the application of Rule 4(a)(2) in circumstances like those in the case at bar, which has generated a jurisdictional quagmire of conflicting decisions. In addition to the Federal Circuit's published line of decisions, the First, Third, Fourth, Fifth, Tenth, and D.C. Circuits have chosen to interpret Rule 4(a)(2) broadly and ignore or

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[7] Indeed, the Supreme Court's own practice of not accepting petitions for certiorari that are out of bounds under Rule 13.2 (28 U.S.C. § 2101) and 12.5 highlights the importance of this jurisdictional matter to efficient operation of the courts and fairness to potential appellees.

unduly circumscribe the applicability of this Court's *FirsTier* decision. *See, e.g., Barrett v. United States*, 462 F.3d 28, 35 (1st Cir. 2006) (premature notice of appeal from order dismissing some claims ripened under Rule 4(a)(2) because the order "would have been appealable if certified pursuant to 54(b)"); *ADAPT of Philadelphia, Liberty Resources, Inc. v. Philadelphia Hous. Auth.*, 433 F.3d 353, 362 (3d Cir. 2006) (re-affirming pre-*FirsTier* holdings that a premature notice of appeal filed after disposition of some but not all claims and before entry of final judgment ripens upon district court's disposal of the remaining claims); *Bryson v. Bryson*, 406 F.3d 284, 289 (4th Cir. 2005) (premature notice of appeal from initial decision that did not dispose of all claims was effective under Rule 4(a)(2) because "court issued its 'final adjudication' disposing of all remaining claims before [the appellate court] considered the case on its merits"); *Barrett v. Atlantic Richfield Co.*, 95 F.3d 375, 379 (5th Cir. 1996) (jurisdiction found under Rule 4(a)(2) based on an order that did not resolve all claims because it "would have been appealable if followed by Rule 54(b) certification and order"); *Fields v. Oklahoma State Penitentiary*, 511 F.3d 1109, 1111 (10th Cir. 2007) (found jurisdiction based on premature notice of appeal from an order that did not dispose of all claims, citing *FirsTier*, and reasoning that a "premature notice of appeal may ripen, however, upon entry of a subsequent final order, . . . , so long as the order has some indicia of finality and is likely to remain unchanged during subsequent court proceedings . . . ."); *Outlaw*, 412 F.3d at 162 (D.C. Circuit held that Rule 4(a)(2) saves a notice of appeal filed when pending claims were subsequently dismissed without prejudice).

These decisions are in direct conflict with the unpublished line of decisions of the Federal Circuit, and decisions of the Seventh, Eighth, and Fifth Circuits that interpret Rule 4(a)(2) consistently with *FirsTier*. *See, e.g.*, *Strasburg*, 1 F.3d at 472 (Seventh Circuit applied *FirsTier* to conclude that "a litigant seeking to take advantage of Rule 4(a)(2)'s saving provision must continue to be reasonably 'confuse[d] as to the status of the litigation' . . . until final judgment is actually entered.");[8] *Miller v. Special Weapons, L.L.C.*, 369 F.3d 1033, 1035 (8th Cir. 2004) ("we do not believe that the summary judgment order entered in this case 'would be appealable' and accordingly Rule 4(a)(2) is inapplicable" where unresolved claims were pending when the notice of appeal was filed); *United States v. Cooper*, 135 F.3d 960, 962-63 (5th Cir. 1998) (noting the existence of prior cases applying the rule of cumulative finality and stating "that in light of *FirsTier*, this expansive [pre-*FirsTier*] view of appellate jurisdiction cannot survive"; the Fifth Circuit held that "*FirsTier* allows premature appeals only where there has been a final decision, rendered without a formal judgment[,]" and adding "[a]lthough an appeal need not be from a final judgment, still it must be from a final decision.").[9] In contrast to the decision below, these Circuits have applied Rule 4(a)(2) in

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[8] *Strasburg* was overruled on other grounds in *Otis v. City of Chicago*, 29 F.3d 1159, 1164-68 (7th Cir. 1994), but this does not affect its ruling concerning the scope of Rule 4(a)(2).

[9] In *Cooper*, the Fifth Circuit appears to have switched the position it took in *Barrett v. Atlantic Richfield*, and adopted an interpretation of Rule 4(a)(2) that is consistent with *FirsTier* and the Seventh and Eighth Circuit's view. 135 F.3d at 962-63.

accordance with this Court's controlling authority — *FirsTier*.

This exemplary listing of cases demonstrates the substantial conflict between the Circuits. Such a direct conflict over the interpretation of the Federal Rules of Appellate Procedure calls for resolution by this Court.

The conflict among the Circuits about this fundamental and important matter of appellate jurisdiction has been acknowledged and lamented by the courts and commentators. *E.g.*, *ADAPT*, 433 F.3d at 362 ("while other jurisdictions have narrowed their holdings involving premature appeals in light of *FirsTier*, we have declined thus far to do the same . . . ."); Michael E. Tigar & Jane B. Tigar, Federal Appeals Jurisdiction and Practice § 6.3 (3d ed. 2008) (interpreting *FirsTier* has "posed problems for the courts of appeals" in cases where, at the time a notice of appeal is filed, the district court has not completed adjudication on all issues); 14 No. 4 Fed. Litigator 105 (1999) (remarking on the risks and uncertainty associated with premature notices of appeal post-*FirsTier*).[10] As noted *supra*, the proper

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[10] As this article observed:

> What is not clear is whether under *FirsTier*, a notice of appeal filed after issuance of an order that would not be appealable if immediately followed by entry of judgment becomes effective upon entry of final judgment. . . . Our advice in other contexts, which bears repeating here, is not to take chances with notices of appeal."

Id.

application of Rule 4(a)(2) remains a matter of significant doubt and confusion since this Court last interpreted the Rule more than 18 years ago in *FirsTier*. *See, e.g.*, *Strasburg*, 1 F.3d at 471; *Outlaw*, 412 F.3d at 161.

At bottom, ambiguity and uncertainty remain. *FirsTier* has not completely solved the problem of piecemeal and wasteful litigation (as in this case) over premature appeals filed from interlocutory orders. Thus, this Court should act on this significant matter concerning the scope of appellate jurisdiction and clarify for all of the Circuits the bounds of Rule 4(a)(2) and *FirsTier*.

III. The Time is Right for This Court to Provide Clarity and Uniformity Concerning This Fundamental and Important Jurisdictional Matter

The Federal Circuit's mis-application of Rule 4(a)(2) is a fundamental jurisdictional issue that warrants this Court's attention. And the failure of a number of Courts of Appeals to apply Rule 4(a)(2) as interpreted by *FirsTier* has created considerable conflict and confusion.

This Court last addressed Rule 4(a)(2) and premature notices of appeal in *FirsTier* in 1991. This case is the perfect vehicle for the Court to provide greater clarity and uniformity concerning this fundamental and important jurisdictional issue. There are no underlying factual issues pertaining to patent law that the Court would first have to address before

reaching the important jurisdictional issue at bar. The facts are not unique and they are not extreme. The time is right and this case is ripe for Supreme Court review.

CONCLUSION

For the foregoing reasons, the writ of certiorari should be granted.

Respectfully submitted,

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NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1320

PARK B. SMITH, INC.,

Plaintiff-Appellant,

v.

CHF INDUSTRIES, INC.,

Defendant-Appellee.

Richard A. De Palma, Thompson Hine, LLP, of New York, New York, argued for plaintiff-appellant. With him on the brief was Katheryn M. Ryan, Baker & McKenzie LLP, of New York, New York.

Stephen L. Sulzer, Connolly Bove Lodge & Hutz LLP, of Washington, DC, argued for defendant-appellee. With him on the brief was James P. Calve.

Appealed from: United States District Court for the Southern District of New York

Senior Judge Lawrence M. McKenna

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1320

PARK B. SMITH, INC.,

Plaintiff-Appellant,

v.

CHF INDUSTRIES, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Southern District of New York in case no. 06-CV-0869, Senior Judge Lawrence M. McKenna.

DECIDED: February 6, 2009

Before MAYER, SCHALL, and GAJARSA, Circuit Judges.

PER CURIAM.

The district court's grant of summary judgment of non-infringement to CHF Industries, Inc. was based upon the point of novelty test, which was eliminated by

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc). Accordingly, the judgment of the district court is vacated and the case is remanded for reconsideration and further proceedings as appropriate in light of Egyptian Goddess.

COSTS

Each side shall bear its own costs.

VACATED AND REMANDED

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1320

PARK B. SMITH, INC.,

Plaintiff-Appellant,

v.

CHF INDUSTRIES, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Southern District of New York in case no. 06-CV-0869, Senior Judge Lawrence M. McKenna.

ON MOTION

Before NEWMAN, Circuit Judge.

ORDER

CHF Industries, Inc. moves for reconsideration of the court's June 19, 2008 order denying its motion to dismiss this appeal. Park B. Smith, Inc. responds. CHF Industries, Inc. replies.

Upon consideration thereof,

IT IS ORDERED THAT:

The motion is denied.

8/19/08
Date

s/ Pauline Newman
Pauline Newman
Circuit Judge

cc: Richard A. De Palma, Esq.
Stephen L. Sulzer, Esq.

s20

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

AUG 19 2008

JAN HORBALY
CLERK

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1320

PARK B. SMITH, INC.,

Plaintiff-Appellant,

v.

CHF INDUSTRIES, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Southern District of New York in case no. 06-CV-0869, Senior Judge Lawrence M. McKenna.

ON MOTION

Before NEWMAN, Circuit Judge.

ORDER

CHF Industries, Inc. (CHF) moves to dismiss Park B. Smith's (Smith) appeal from the judgment of the United States District Court for the Southern District of New York as untimely. Smith opposes.

On March 6, 2008, the district court entered an order granting summary judgment of noninfringement

of Smith's two design patents and directed that the district court clerk enter judgment. The clerk of the district court entered judgment on March 10, 2008. However, CHF's counterclaim for a declaratory judgment of invalidity of the two patents remained pending. Subsequently, on May 6, 2008, the district court entered an order dismissing that claim and any other pending claims without prejudice.

Meanwhile, on April 9, 2008, Smith filed a notice of appeal, seeking review by the United States Court of Appeals for the Second Circuit. The Second Circuit apparently returned the notice of appeal to the district court. Smith filed an "amended" notice of appeal, expressly seeking review by the Federal Circuit. The district court transmitted the first notice of appeal and the amended notice of appeal to this court.

CHF argues that the first notice of appeal was defective because it did not identify this court and that the "amended" notice of appeal was defective because it was not filed within 30 days of the district court's order granting summary judgment. However, because there was no final judgment when the notices of appeal were filed, dismissal due to untimeliness is not appropriate. Smith filed a premature notice of appeal that ripened upon disposition of the pending counterclaims. Fed. R. App. P. 4(a)(2). The cases cited by CHF regarding post-appeal entries of Fed. R. Civ. P. 54(b) judgments, nunc pro tunc, do not apply. This case does not involve entry of a 54(b) judgment but rather a premature appeal filed before disposition of pending claims and before entry of final judgment. Thus, the appeal is not untimely.

Accordingly,

IT IS SO ORDERED THAT:

The motion to dismiss is denied.

JUN 19 2008
Date

s/ Pauline Newman
Pauline Newman
Circuit Judge

cc: Richard A. De Palma, Esq.
Stephen L. Sulzer, Esq.

s20

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUN 19 2008

JAN HORBALY
CLERK

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC.,	:	
	:	
Plaintiff,	:	06 Civ. 869
	:	(LMM)(JCF)
v.	:	MEMORANDUM
	:	AND ORDER
CHF INDUSTRIES, INC.,	:	
	:	
Defendant.	:	

McKENNA, D.J.

Plaintiff Park B. Smith, Inc. ("PBS" or "Plaintiff") brought the present auction, alleging infringement by Defendant CHF Industries, Inc. ("CHF" or "Defendant") of two design patents, U.S. Patent Nos. Des. 493,651 ("the '651 patent") and Des. 505,039 ("the '039 patent") (collectively "the patents-in-suit"). Defendant CHF here moves for summary judgment of noninfringement of the '651 and '039 patents and for summary judgment of invalidity of the '651 patent due to indefiniteness. Plaintiff PBS cross-moves for partial summary judgment of infringement of the '651 patent.

I. BACKGROUND

a. Procedural Background

Plaintiff PBS filed a complaint in this court on February 3, 2006, alleging that CHF was infringing the

'039 and '651 patents, owned by PBS, in CHF's "Pole-Top Roman Shade" design. (Complaint and Jury Demand of Plaintiff Park B. Smith, Inc., dated February 3, 2006, Exhibit 1 to Defendant CHF's Memorandum in Support of its Motion for Summary Judgment of Noninfringement ("Def.'s SJ Brief").) On March 24, 2006, Defendant CHF filed its Answer and Counterclaims, denying infringement of the patents-in-suit and asserting various affirmative defenses. (Def.'s SJ Brief p. 2.) CHF additionally asserted counterclaims seeking a declaratory judgment of noninfringement and invalidity of the patents. PBS filed its reply to CHF's counterclaims on April 13, 2006, and the Court confirmed November 30, 2006 as the deadline for completion of all fact and expert discovery. (Id. at 3.)

CHF filed its motion for summary judgment on May 1, 2006, and PBS filed its cross-motion for partial summary judgment of infringement on June 30, 2006. On November 27, 2006, the magistrate judge stayed discovery pending a ruling by this Court on the summary judgment motions.

b. Factual Background

Park B. Smith is an individual and the name of a family-run company with its principal place of business and showroom in Manhattan. (Declaration of Park B. Smith ("Smith Decl.") ¶ 6.) According to Smith's declaration, Park B. Smith's business involves the design, manufacture and sale of quality hand and machine woven products in the Home Fashions Industry, and is a leading resource for select window treatments. (Smith Decl. ¶¶ 8, 10.)

1. The '651 and '039 Patents

Park B. Smith is the owner by assignment of the '651 patent. (Plaintiff's Statement Pursuant to Local Rule 56.1 ("Pl.'s 56.1 Stmt.") ¶ 2.) The '651 patent includes a single claim, for "[t]he ornamental design for a window shade, as shown and described." (Id. at ¶¶ 11-12.) The single claim for the '651 patent is also shown in ten drawings. (Id. at ¶ 13.) The effective filing date of the '651 patent is November 21, 2003. (Id. at ¶ 19.)

Park B. Smith is also the owner by assignment of the '039 patent. (Plaintiff's Statement Pursuant to Local Rule 56.1 ("Pl.'s 56.1 Stmt.") ¶ 4.) The '039 patent includes a single claim, for "[t]he ornamental design for a raisable panel, as shown and described," shown in ten drawings. (Defendant CHF Industries, Inc.'s Statement Pursuant to Local Rule 56.1 ("Def.'s 56.1 Stmt.") ¶¶ 1-3.) The effective filing date of the '039 patent is November 21, 2003. (Id. at ¶ 9.) The '039 patent lists Park B. Smith and Linda Johnson as the inventors. (Id. at ¶ 10.)

The descriptions of both the '039 and '651 patents include a statement indicating that features shown in broken lines are "for illustrative purposes only" and form "no part of the claimed invention." (Id. at ¶¶ 6, 16.)

Park B. Smith describes the novelty in the '651 patent drawings as "the combination of elements in the drawings which is not found in prior window treatment designs (i.e., the sixty patents and other publications considered by the U.S. Patent and Trademark Office during examination of the '651 Patent...)." (Memorandum of Law in Support of Plaintiff's Cross-Motion for Summary Judgment ("Pl.'s S.J. Brief") pp.

10-11.) Plaintiff provides the following description of this combination of elements:

> That novel combination includes, but is not limited to: (i) a single continuous pocket along the entire top of the shade, which is open and rounded at the top, and which tapers to a narrow bottom; (ii) uniform bottom folds, which have open and rounded bottoms, and which taper towards the top, keeping their open and tapered appearance as the shade is raised, and creating a cascading effect, upwards from rear to front; (iii) a cascading effect of the folds fully shown from the side view; (iv) a stacked and compact presentation of folds when viewed from the front and rear; (v) a repeat of the visual effect of the shape of the top pocket in the bottom folds'; and a flat presentation of the unfolded portion of the shade when viewed from the front and rear.

(Id. at p. 11.)

In 2002, Linda Johnson Smith and Park B. Smith created a design for a window shade, which was given the model name "Magic Blind." (Pl.'s 56.1 Stmt. ¶ 1.) According to Park B. Smith, the Magic Blind is the commercial embodiment of the design protected by the '651 patent, though this contention is disputed by Defendant CHF. (Pl.'s 56.1 Stmt. ¶ 3; Defendant's Response to Plaintiff's 56.1 Statement ("Def.'s 56.1 Resp.") ¶ 3.)

2. CHF's "Pole-Top Roman Shade"

Defendant CHF has sold and continues to sell a window shade known as the "Pole-Top Roman Shade." (Pl.'s 56.1 Stmt. ¶ 5.) Plaintiff PBS claims that it became aware in early 2006 of the existence of CHF's Pole-Top Roman Shade, which was available in retail stores such as Bed Bath & Beyond, and which Plaintiff believed was a copy of its Magic Blind design.

II. DISCUSSION

a. Summary Judgment Standard

Federal Rule of Civil Procedure 56(c) provides that summary judgment should be granted "if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). "A dispute is not 'genuine' unless 'the evidence is such that a reasonable jury could return a verdict for the nonmoving party.'" Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43, 45 (2d Cir. 2000) (quoting Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986)). "A fact is 'material' for these purposes if it 'might affect the outcome of the suit under the governing law.'" Overton v. N.Y. State Div. of Military & Naval Affairs, 373 F.3d 83, 89 (2d Cir. 2004) (quoting Anderson, 477 U.S. at 248).

In weighing a motion for summary judgment, ambiguities or inferences to be drawn from the facts must be viewed in the light most favorable to the party opposing the summary judgment motion. See Thompson v. Gjivoje, 896 F.2d 716, 720 (2d Cir. 1990).

However, "the non-moving party must come forward with specific facts showing that there is a genuine issue for trial." Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986) (citing Fed. R. Civ. P. 56) (emphasis and internal quotations omitted). "[C]onclusory statements, conjecture, or speculation by the party resisting the motion will not defeat summary judgment." Kulak v. City of New York, 88 F.3d 63, 71 (2d Cir. 1996) (citations omitted).

Design patent infringement is a question of fact which the patentee must prove by a preponderance of the evidence. See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1124 (Fed. Cir. 1993). In a patent case, summary judgment is appropriate when a patent owner cannot meet an essential part of the legal standard for infringement. See, e.g., TechSearch, L.L.C. v. Intel Corp., 286 F.3d 1360, 1369 (Fed. Cir. 2002) (citing London v. Carlson Pirie Scott & Co., 946 F.2d 1534, 1537 (Fed. Cir. 1991)).

b. Infringement of the '651 and '039 Patents

Defendant CHF moves for summary judgment of noninfringement of the '651 and '039 patents, and Plaintiff PBS moves for summary judgment of infringement of the '651 patent.

A court engages in a two-part process to determine whether a design patent has been infringed. First, a court must interpret the design patent claim. See Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995). After interpreting the claim, a court must apply the ordinary observer and point of novelty tests to determine whether the claim has been infringed.

See Contessa Food Prod., Inc. v. Conagra, Inc., 282 F.3d 1370, 1377 (Fed. Cir. 2002).

1. Claim Construction

As stated in the patent, the '651 patent claim is for "[t]he ornamental design for a window shade, as shown and described." ('651 Patent, Exhibit H to Plaintiff's Cross Motion for Summary Judgment of Infringement ("the '651 patent document").) The '651 patent claim, in light of this specification, the claim drawings, the prosecution history, and the prior art, describes a raisable panel without specified ornamentation; folds that stack and cascade slightly upwards at the bottom of the shade when the shade is raised; and a continuous rod pocket or sleeve formed at the top of the shade for suspending the shade from a rod or pole.

The '039 patent claim describes a design essentially identical to that described in the '651 patent claim, but without the continuous rod pocket along the top of the panel. ('039 patent, Exhibit I to Plaintiff's Cross Motion for Summary Judgment of Infringement ("the '039 patent document").) The '039 patent therefore describes a raisable panel without specified ornamentation; a back also without specified ornamentation; and folds that stack and cascade slightly upwards at the bottom of the shade when the shade is raised. (Id.)

2. Substantial Similarity or Ordinary Observer Test

A determination of infringement of a design patent requires the application of two tests, both of which must be satisfied: (1) the "substantial similarity" test (also known as the "ordinary observer" test); and (2) the "point of novelty" test. Lawman Armor Corp. v. Winner Int'l, LLC, 437 F.3d 1383, 1384 (Fed. Cir. Feb. 22, 2006). To find infringement, a court must both compare "two items through the eyes of the ordinary observer" and "attribute their similarity to the novelty which distinguishes the patented device from the prior art." Litton Sys. v. Whirlpool, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

The "ordinary observer" test requires comparison of the two designs from the viewpoint of the ordinary observer to "determine whether the patented design as a whole is substantially the same in appearance as the accused design." Tropicana Prod., Inc. v. Land O' Lakes, Inc., 286 F.Supp.2d 343, 345 (D. Del. 2003) (internal citations omitted).

Judging from the photographs provided by Plaintiff (Exhibit C to Plaintiff's Cross Motion for Summary Judgment of Infingement), CHF's Pole-Top Roman Shade does appear to have a substantially similar appearance to the design claimed in the '651 patent. The two noticeable differences are the visible slats in the front and back of the blind and the weighted bar that is visible at the bottom edge of the blind. These differences do not, however, detract from the overall similarity in appearance of the '651 patent design and the CHF Pole-Top Roman Shade, from the perspective

of an ordinary observer. The CHF shade shares with the '651 patent design the essentially plain front and back, marred only by the visible slats, which could constitute a visible functional element outside of the ornamental design; bottom folds that stack and cascade slightly upwards as the blind is raised; and a continuous rod pocket along the top of the shade.

Defendant's design also evinces a strong similarity with the '039 patent design, which contains identical elements to the '651 shade but without the specification for the rod pocket along the top of the shade.

The overall similarity of the CHF product and the '651 and '039 patent designs demonstrates the existence of an issue of material fact that would preclude summary judgment of noninfringement on the basis of the substantial similarity (or ordinary observer) test.

3. Point of Novelty Test

However, in addition to demonstrating an overall similarity in design between the accused design and the patented design, Plaintiff must also show that CHF's product appropriates the point of novelty in Plaintiff's '651 patent in order to show infringement. As discussed above, Plaintiff asserts that the point of novelty shown in the '651 patent is a combination of features, including: the continuous rod pocket along the top of the shade; uniform bottom folds with a tapered appearance and a cascading effect when stacked; the cascading, compact, and stacked presentation of folds viewed from the front and rear; and a repeat of the visual effect of the top pocket in the bottom folds. (Supra pp. 4-5.) Defendant

asserts that this combination of features constitutes the "overall appearance" of the '651 patent, a contention that it supports convincingly in Exhibit 11 of the Supplemental Declaration of Ori Katzin, in which each aspect of the '651 patent claim drawings is correlated with one of the characteristics that Plaintiff claims as part of the '651 patent's point of novelty. Defendant demonstrates in Exhibit 11 that when all of Plaintiff's claimed characteristics are eliminated, nothing remains; the combination of characteristics that Plaintiff claims as the '651 patent's point of novelty therefore comprises the "overall appearance" of the design.

With respect to the '039 patent, the Plaintiff has similarly asserted that it is the "combination of elements contained in the '039 Patent drawings" that constitutes the design's point of novelty. (Pl.'s SJ Brief p. 19, ¶ 3.) Thus, Plaintiff PBS clearly asserts that it is the combination of design elements constituting the overall appearance of the '039 patent design that it claims as the design's point of novelty.

The Federal Circuit in Lawman Armor held that summary judgment of noninfringement is appropriate, notwithstanding the existence of factual issues under the ordinary observer test, if the claimed design has no legally cognizable points of novelty. 437 F.3d at 1385. In reaching the holding, and in subsequent clarifying opinion, the Lawman Armor Court found that a combination of features, where each individual feature is found in the prior art, may not constitute a point of novelty where the combination of features constitutes the overall appearance of a design. See Lawman Armor, 437 F.3d at 1386; Lawman Armor Corp. v. Winner Int'l, 449 F.3d 1190 (Fed. Cir. May 31, 2006).

Plaintiff cites numerous Federal Circuit opinions preceding Lawman Armor, including Sun Hill Industries v. Easter Unlimited, 48 F.3d 1193 (Fed. Cir. 1995), L.A. Gear, 988 F.2d 1117, and Litton Systems, 728 F.2d 1423, in support of the conclusion, affirmed by the clarifying opinion in Lawman Armor, 449 F.3d at 1190, that a combination of features may constitute a point of novelty in certain circumstances. None of the cases cited by Plaintiff contradicts Lawman Armor's holding, as clarified by the court's supplemental opinion, 449 F.3d 1190, that a combination of features may not be asserted as a point of novelty where the combination of features asserted constitutes the overall appearance of the design.

In view of the Lawman Armor holding, Plaintiff's assertion of a combination of features comprising the overall appearance of the '651 and '039 patent designs as the designs' sole points of novelty fails to present legally cognizable points of novelty for the two designs. Plaintiff therefore fails to satisfy the two-part test for design patent infringement with respect to the '651 and '039 patents, and Defendant's motion for summary judgment of noninfringement of the '651 and '039 patents is GRANTED.

ii. Invalidity for Indefiniteness of the '651 Patent

Defendant additionally claims that Plaintiff's '651 patent is invalid due to indefiniteness of the claimed design. While the issue need not be resolved in view of the conclusion reached in part II.b.3. of this Memorandum and Order, supra, the Court still considers it for the sake of completeness.

Defendant claims that the '651 patent is impermissibly indefinite due to: (1) the presence of an ornamental horizontal line at the top of the design's front panel in two of the '651 patent's ten drawings but not in the others; and (2) the absence of clarity in the drawings regarding the dimensions of the rod pocket and the height of the stacked folds at the bottom of the shade. (Def.'s SJ Brief pp. 5-6.)

A patent is presumed valid, and the burden of establishing invalidity as to any claim of a patent rests upon the party asserting invalidity. 35 U.S.C. § 282, ¶ 1. This presumption of invalidity may only be overcome by clear and convincing evidence. MDS Assoc. v. United States, 37 Fed. Cl. 611, 624 (Fed. Cl. 1997).

35 U.S.C. § 112, ¶ 2 lays out the requirements for claim precision, stating that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." With respect to a design patent, "[i]t is the drawings in the patent, not just one feature in the claimed design, that define the patented design." Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1371 (Fed. Cir. 2006).

The statutory criteria for definiteness of a patent are satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in light of the specification. Marley Mouldings v. Mikron Indus., 417 F.3d 1356, 1359 (Fed. Cir. 2005). As Plaintiff and Defendant both note in their briefs, "[a] claim is not indefinite merely because it poses a difficult issue of claim construction, or merely because reasonable minds may disagree over the correct

construction, provided that the meaning of the claim is discernible." Def.'s SJ Brief at 23 (citing Bancorp Serv. v. Hartford Life Ins. Co., 359 F.3d 1367, 1371 (Fed. Cir. 2004); Exxon Research and Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001)).

Defendant argues that the horizontal line near the top of the panel in Figures 5 and 8 of the '651 patent, but absent from other eight drawings, renders the '651 patent hopelessly ambiguous and therefore invalid for indefiniteness. According to the Manual of Patent Examining Procedure § 1503.02, relied on by Plaintiff and Plaintiff's expert, "when inconsistencies are found among the views, the examiner should object to the drawings and request that the views be made consistent" and "when the inconsistencies are of such magnitude that the overall appearance is unclear, the claim should be rejected under 35 U.S.C. § 112 as nonenabling and indefinite." Manual of Patent Examining Procedure, U.S. Patent & Trademark Office (2007), available at http://www.uspto.gov/web/offices/pac/mpep/index.html.

Though the Court disagrees with Plaintiff's contention that the fact that the patent examiner failed to see material inconsistencies in the patent should be taken as conclusive proof that the patent is valid, the presence of the extraneous horizontal line in two of the ten drawings does not appear to constitute an inconsistency "of such magnitude that the overall appearance" of the design is unclear. Id. The horizontal line in question appears simply to be extraneous, and is not a sufficiently serious inconsistency to prevent an ordinary observer, much less a trained designer, from understanding the intended overall design.

Defendant's argument that the absence of definite measurements or proportions for the rod pocket renders the '651 patent impermissibly indefinite also failrs. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d 951, 956 (Fed. Cir. 2000). The absence of clear measurements or proportions therefore cannot be grounds on which to find that a patent claim is impermissibly vague.

III. CONCLUSION

For the foregoing reasons, Defendant's motion for summary judgment of noninfringement of the '651 and '039 patents is GRANTED and Defendant's motion for summary judgment of invalidity of the '651 patent is DENIED. Plaintiff's motion for partial summary judgment of infringement is DENIED.

The Clerk is directed to enter judgment in favor of the Defendant dismissing the complaint.

SO ORDERED.

Dated: March 6, 2008

s/ Lawrence M. McKenna
Lawrence M. McKenna
U.S.D.J.

USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DATE FILED: 3/10/08

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

----------X

PARK B. SMITH, INC.,

Plaintiff,

06 **CIVIL** 0869 (LMM)

-against-

JUDGMENT

CHF INDUSTRIES, INC.,

Defendant.

----------X

Plaintiff and Defendant having moved for summary judgment pursuant to Fed. R. Civ. P. 56, and the matter having come before the Honorable Lawrence M McKenna, United States District Judge, and the Court, on March 6, 2007, [*sic*-2008] having rendered its Memorandum and Order granting defendant's motion for summary judgment of noninfringement of 651 and 039 patents, defendant's motion for invalidity of the 651 patent is denied, and plaintiff's motion for partial summary judgment of infringement is denied, it is,

ORDERED, ADJUDGED AND DECREED: That for the reasons stated in the Court's Memorandum and Order dtd Mar 6, 2008, defendant's motion for summary judgment of noninfringement of 651 and 039 patents is granted, defendant's motion for invalidity of the 651 patent is denied, and plaintiff's motion for partial summary is also denied.

Dated: New York, New York
Mar 10, 2008

J. MICHAEL McMAHON

_____
Clerk of Court

BY:

s/ [illegible]
Deputy Clerk

THIS DOCUMENT WAS ENTERED IN THE DOCKET BY _____

FILED U.S. DC
APR 09 2008
S.D. OF N.Y.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC., **Plaintiff,** **-against-** **CHF INDUSTRIES, INC.,** **Defendant.**	**Case No. 06 Civ. 869 (LMM) (JCF)** **NOTICE OF APPEAL**

Notice is hereby given that Plaintiff Park B. Smith, Inc. hereby appeals to the United States Court of Appeals for the Second Circuit from the Judgment that granted Defendant CHF Industries, Inc.'s motion for summary judgment of noninfringement and denied Plaintiff's motion for partial summary judgment entered in this action on the 10th day of March, 2008.

Dated: New York, New York
April 9, 2008

BAKER & McKENZIE LLP

By: s/ Richard A. De Palma
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FILED U.S. DC
APR 09 2008
S.D. OF N.Y.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC., **Plaintiff,** **-against-** **CHF INDUSTRIES, INC.,** **Defendant.**	**Case No. 06 Civ. 869 (LMM) (JCF)** **NOTICE OF APPEAL**

PLEASE TAKE NOTICE that Plaintiff Park B. Smith, Inc. ("PBS") hereby amends its previous Notice of Appeal dated and filed on April 9, 2008, a copy of which is annexed hereto as Exhibit A, as follows:

Notice is hereby given that PBS hereby appeals to the United States Court of Appeals for the Federal Circuit from the Judgment that granted Defendant CHF Industries, Inc.'s motion for partial summary judgment of patent noninfringement and denied Plaintiff's motion for partial summary judgment entered in this action on the 10th day of March, 2008.

Dated: New York, New York
April 9, 2008

BAKER & McKENZIE LLP

By: s/ Richard A. De Palma

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USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DOC #: _____
DATE FILED: 5/6/08

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC., **Plaintiff,** **-against-** **CHF INDUSTRIES, INC.,** **Defendant.**	**Case No. 06 CV 869 (LMM) (JCF)**

JOINT STIPULATION & ORDER OF DISMISSAL

Pursuant to Rules 41(a)(1)(A)(ii), 41(a)(1)(B), and 41(c) of the Federal Rules of Civil Procedure, Plaintiff/Counterclaim Defendant Park B. Smith, Inc. ("PBS") and Defendant/Counterclaim Plaintiff CHF Industries, Inc. ("CHF") hereby agree and stipulate as follows:

WHEREAS, CHF's motion for summary judgment of noninfringement of U.S. Patent Nos. Des. 493,651 ("the '651 patent") and Des. 505,039 ("the '039 patent") was granted by the Court in a Memorandum and Order dated March 6, 2008 (Docket No. 63);

WHEREAS, the Court denied CHF's motion for summary judgment of invalidity of the '651 patent for indefiniteness under 35 U.S.C. § 112, second paragraph, and also denied PBS's cross-motion for partial summary judgment of infringement of the '651 patent;

WHEREAS, the Court entered judgment on March 10, 2008 granting CHF's motion for summary judgment of noninfringement of the '651 patent and the '039 patent, denying CHF's motion for summary judgment of invalidity of the '651 patent, and denying PBS's cross-motion for partial summary judgment of infringement of the '651 patent (Docket No. 64);

WHEREAS, CHF has asserted counterclaims in this case seeking declaratory judgments that (a) the '651 patent and the '039 patent are not infringed by CHF, (b) the '651 patent and the '039 patent are invalid pursuant to 35 U.S.C. §§ 102, 103, 112, and 171, and (c) this case is exceptional under 35 U.S.C. § 285 (hereinafter collectively "CHF's Counterclaims"); and

WHEREAS, CHF's Counterclaims are still pending in this litigation;

NOW THEREFORE, CHF and PBS stipulate and agree that:

1. CHF's Counterclaims are hereby voluntarily dismissed, without prejudice.

2. Each party shall bear its own attorneys' fees, expenses, and costs.

Dated: May 5, , 2008 CONNOLLY BOVE LODGE & HUTZ LLP

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Attorneys for Defendant CHF Industries, Inc.

Dated: April 23 , 2008 BAKER & McKENZIE LLP

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Attorneys for Plaintiff
Park B. Smith, Inc.

PURSUANT TO STIPULATION, IT IS SO ORDERED.

Dated: 5/6, 2008

s/ Lawrence M. McKenna
Hon. Lawrence M. McKenna
UNITED STATES
DISTRICT COURT
JUDGE

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC., **Plaintiff,** **-against-** **CHF INDUSTRIES, INC.,** **Defendant.**	**Case No. 06 CV 869** **COMPLAINT AND JURY DEMAND**

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CASHIERS

Plaintiff PARK B. SMITH, INC., by its attorneys, Baker & McKenzie LLP, as and for its Complaint against Defendant CHF INDUSTRIES, INC. ("CHF") alleges as follows:

JURISDICTION AND VENUE

1. This is an action for patent infringement arising under the patent laws of the United States, Title 35 United States Code. This Court has original jurisdiction over the subject matter of this action

pursuant to 28 U.S.C. § 1331, 1338.

2. This Court has personal jurisdiction over Defendant CHF because Defendant is found in this judicial district, transacts business, does business and solicits business in the State of New York, within this judicial district and elsewhere, and because Defendant is committing and has committed acts of infringement in the State of New York.

3. Venue is proper under 28 U.S.C. §§ 1400(b), 1391(b) and (c) as the claims arose in this judicial district and Defendant resides, does business in and may be found, along with its agents, in this District and Defendant has committed acts of infringement herein.

THE PARTIES

4. Plaintiff Park B. Smith, Inc. is a corporation duly organized and existing under the laws of the State of New York and with its principal place of business at 295 Fifth Avenue, New York, New York 10016. Park B. Smith, Inc. is the owner of the patents-in-suit identified in paragraphs 6-9 below, and markets and sells custom home decor throughout the United States and internationally.

5. Upon information and belief, Defendant CHF is a corporation organized and existing under the laws of the State of Delaware and with its principal place of business at One Park Avenue, 9th Floor, New York, New York 10016. CHF is a marketer and manufacturer of home fashion products that are sold mainly to retail stores throughout the United States.

THE TWO PATENTS-IN-SUIT

6. The two patents-in-suit cover the ornamental design for a window blind and contain substantially similar claims and drawings.

7. United States Design Patent No. D493,651 S (the " '651 Patent") was duly and lawfully issued on August 3, 2004, based upon an application filed by the inventors, Park B. Smith and Linda Johnson. A copy of the '651 Patent is attached hereto as Exhibit A.

8. United Stales Design Patent No. D505,039 S (the " '039 Patent") was duly and lawfully issued on May 17, 2005, based upon an application filed by the inventors, Park B. Smith and Linda Johnson. A copy of the '039 Patent is attached hereto as Exhibit B.

9. Park B. Smith, Inc. is the owner by assignment of the '651 Patent and the '039 Patent (collectively, "the Patents") and has the right to sue, and recover damages, for infringement thereof.

GENERAL ALLEGATIONS

10. Park B. Smith, Inc. is engaged in the business of designing, selling and importing a variety of textile products used to decorate residential interiors including placemats, napkins, table runners, shower curtains, rugs, beddings, window treatment and curtains.

11. In addition to being regarded as a highly esteemed purveyor of a variety of interior and home furnishings and accessories, Park B. Smith, Inc. is one of

the leading resources for select window treatments.

12. Defendant CHF is a marketer and manufacturer of home fashion products that are sold mainly to retail stores throughout the United States.

13. Upon information and belief, Defendant CHF has manufactured, sold and offered for sale, in this judicial district and elsewhere, various soft shade window treatment products identified as the "Pole-Top Roman Shade" that infringe the claims of the Patents. A copy of the cardboard insert included in the Pole Top Roman Shade packaging is attached hereto as Exhibit C.

14. Upon information and belief, Defendant CHF sells and offers for sale the products identified as the Pole-Top Roman Shade to retail stores throughout the United States.

COUNT I

(Patent Infringement)

15. Park B. Smith, Inc. repeats and realleges each and every allegation contained in paragraphs 1 though 14 above with the same force and effect as if filly set forth herein.

16. Upon information and belief, Defendant has been and is now infringing the '651 Patent and the '039 Patent by manufacturing, selling and undertaking substantial preparations for offering to sell the Pole-Top Roman Shade.

17. Upon information and belief, Defendant

CHF has been aware of the existence of, but nevertheless has been and is infringing, these Patents.

18. Upon information and belief, the infringement of the Patents by Defendant CHF has been willful and deliberate and in total disregard for Plaintiff's lawful rights under these patents, thus rendering this case "exceptional" as that term is set forth in 35 U.S.C. § 285.

19. Upon information and belief, Defendant CHF's infringement of the patents has allowed Defendant to reap tremendous profits and Defendant's infringement has caused, and will continue to cause, Plaintiff great and irreparable harm.

20. Plaintiff Park B. Smith, Inc. has been damaged, and will continue to be damaged, by CHF's infringement of the Patents.

COUNT II

(Injunctive Relief)

21. Park B. Smith, Inc. repeats and realleges each and every allegation contained in paragraphs 1 through 20 above with the same force and effect as if filly set forth herein.

22. Upon information and belief, Defendant has undertaken substantial activity directed towards engaging in infringement of the Patents by manufacturing, selling and undertaking substantial preparations for offering to sell the Pole-Top Roman Shade.

23. Upon information and belief, Defendant CHF has for some time had actual knowledge of the Patents, but nevertheless has been and is now engaged in substantial activities directed toward infringing these Patents.

24. Defendant's acts have already caused, and unless restrained and enjoined, will continue to cause Plaintiff irreparable injury, harm and damage for which Plaintiff has no adequate remedy at law. Therefore, Defendant should be enjoined pursuant to 35 U.S.C. § 283.

JURY DEMAND

25. Plaintiff hereby demands trial by jury as to all claims and defenses in this action.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Park B. Smith, Inc. prays for judgment against Defendant as follows:

(1) Permanently enjoining Defendant together with each of its affiliates, subsidiaries, officers, agents, servants, employees, and attorneys, and all persons in active concern or participation with any of them who receive actual notice of this Court's order by personal service or otherwise from infringing the Patents in any manner;

(2) Requiring Defendant to file and serve on Park B. Smith, Inc., within 30 days after service of an injunction, a written report under oath setting forth in detail Defendant's compliance with the injunction;

(3) For a judicial determination and declaration that Defendant has infringed the Patents;

(4) For a judicial determination and declaration that because Defendant's infringement of the Patents is willful and deliberate, this is an exceptional case under 35 U.S.C. § 285;

(5) For an order requiring Defendant to account for the sales and profits related to the sale of the Pole-Top Roman Shade;

(6) For an award, to be determined at trial, of damages adequate to compensate Park B. Smith, Inc. for Defendant's infringement and Plaintiff's costs, but in no event less than a reasonable royalty - plus pre-judgment and post-judgment interest - and for such damages to be trebled, pursuant to 35 U.S.C. § 284.

(7) For an award of Plaintiff's reasonable attorneys' fees and expenses, pursuant to 35 U.S.C. § 285.

(8) For such other and further relief as this Court may deem just and proper.

Dated: New York, New York.
February 3, 2006

BAKER & McKENZIE LLP

By: s/ Richard De Palma
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Attorneys for Plaintiff
Park B. Smith, Inc.

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

PARK B. SMITH, INC., **Plaintiff,** **v.** **CHF INDUSTRIES, INC.,** **Defendant.**	**Case No. 06 CV 869 (LMM) (JCF)**

ANSWER AND COUNTERCLAIMS OF DEFENDANT CHF INDUSTRIES, INC. TO PLAINTIFF PARK B. SMITH, INC.'S COMPLAINT AND JURY DEMAND

Pursuant to Rules 8 and 12 of the Federal Rule of Civil Procedure, Defendant/ Counterclaim Plaintiff CHF Industries, Inc. (hereinafter "CHF") answers the Complaint and Jury Demand of Plaintiff Park B. Smith, Inc. (hereinafter "PBS") in Civil Action No. 06 CV 869 (LMM) as follows:

1. CHF admits that this action purports to be an action for patent infringement under the patent laws of the United States, Title 35 of the United States Code, and that the Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338, but otherwise denies the remaining allegations of paragraph 1.

2. CHF admits that its principal place of business is in this Judicial District, that it transacts and otherwise does business in this Judicial District and in the State of New York, and that this Court has personal jurisdiction over CHF, but otherwise denies the remaining allegations of paragraph 2.

3. CHF admits that it resides, does business, and may be found, along with its agents, in this Judicial District, that it resides in this Judicial District as the term "reside" is defined in Title 28, United States Code, Section 1391(c), that PBS's claims purport to have arisen in this Judicial District, and that venue is proper with respect to CHF in this Judicial District pursuant to Title 35, United States Code, Sections 1391(b) and (c) and 1400(b), but CHF denies that it has committed acts of infringement, or is committing acts of infringement, of either of the patents-in-suit, in this Judicial District, or anywhere in the United States, and otherwise denies the remaining allegations of paragraph 3.

4. CHF is without information or knowledge sufficient to form a belief as to the truth of paragraph 4, and therefore the allegations of paragraph 4 are denied.

5. CHF admits that it is incorporated in Delaware, that its principal place of business is at One Park Avenue, 9th Floor, New York, New York 10016, and that it markets and distributes home fashion textile products to major retailers in the United States, but CHF otherwise denies the remaining the allegations of paragraph 5.

6. CHF admits that United States Design Patent No. D493,651 S ("the '651 patent") purports to

claim an ornamental design for a window shade and that United States Design Patent No. D505,039 S ("the '039 patent") purports to claim an ornamental design for a raisable panel. The remaining allegations of paragraph 6 are too vague and indefinite for CHF to reasonably frame a response, and CHF is without knowledge or information sufficient to form a belief as to the truth of such allegations, which are hereby denied.

7. CHF admits that the United States Patent and Trademark Office issued the '651 patent on August 3, 2004, and that a copy of the '651 patent is attached to PBS's Complaint as Exhibit A. CHF denies that the '651 patent was duly and legally issued, and CHF is without information or knowledge sufficient to form a belief as to the truth of the remaining matters alleged in paragraph 7, and therefore the remaining allegations of paragraph 7 are denied.

8. CHF admits that the United States Patent and Trademark Office issued the '039 patent on May 17, 2005, and that a copy of the '039 patent is attached to PBS's Complaint as Exhibit B. CHF denies that the '039 patent was duly and legally issued, and CHF is without information or knowledge sufficient to form a belief as to the truth of the remaining matters alleged in paragraph 8, and therefore the remaining allegations of paragraph 8 are denied.

9. CHF admits that the '651 patent and the '039 patent identify Park B. Smith, Inc. as the assignee of those patents, but CHF is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations in paragraph 9, and therefore these allegations are denied.

10. CHF is without information or knowledge sufficient to form a belief as to the truth of paragraph 10, and therefore the allegations of paragraph 10 are denied.

11. PBS's allegation that it is "one of the leading resources for select window treatments" is too vague and indefinite for CHF to reasonably frame a response thereto. To the extent that CHF comprehends that allegation, it is without information or knowledge sufficient to form a belief as to its truth. In addition, CHF is without information or knowledge sufficient to form a belief as to the truth of the remainder of paragraph 11, and, therefore, all of the allegations of paragraph 11 are denied.

12. CHF admits that it markets and distributes home fashion textile products to major retailers in the United States, but CHF otherwise denies the remainder of the allegations of paragraph 12.

13. CHF admits that the item attached as Exhibit C to PBS's Complaint purports to be a copy of a cardboard insert that is included with the Empire Silk Pole-Top Roman Shade that is offered for sale and sold by CHF, but CHF denies that this item, or the product with which it is packaged, infringes the '651 patent or the '039 patent. CHF admits that it has offered for sale and sold within the United States a product identified as an Empire Silk Pole-Top Roman Shade, but CHF denies that its offer for sale or sale of such product infringes the '651 patent or the '039 patent. CHF also denies the remaining allegations of paragraph 13, including, in particular, the allegation that products offered for sale and sold by CHF in the United States identified as

"Pole-Top Roman Shade" infringe the claims of the '651 patent or the '039 patent.

14. CHF admits that it offers for sale and sells products identified as "Pole-Top Roman Shade" to retailers in the United States, but CHF denies that its offer for sale or sale of such products infringes the claims of the '651 patent or the '039 patent.

15. CHF repeats and incorporates herein its responses to paragraphs 1 through 14 above as though they were set forth fully herein.

16. CHF repeats and incorporates herein its responses to paragraphs 1 through 15 above as though they were set forth fully herein, and CHF denies the allegations of paragraph 16.

17. CHF denies that it has infringed, or that it is infringing, the '651 patent or the '039 patent. The remaining allegations of paragraph 17 are too vague and indefinite for CHF to reasonably frame a response and are therefore denied.

18. CHF denies the allegations of paragraph 18.

19. CHF denies the allegations of paragraph 19.

20. CHF denies the allegations of paragraph 20.

21. CHF repeats and incorporates herein its responses to paragraphs 1 through 20 above as though they were set forth fully herein.

22. CHF denies the allegations of paragraph 22.

23. CHF denies that it has infringed, or is infringing, the '651 patent or the '039 patent, and denies that it has been or is now engaged in activities directed toward infringing those patents. The remaining allegations of paragraph 23 are too vague and indefinite for CHF to reasonably frame a response and are therefore denied.

24. CHF denies the allegations of paragraph 24.

25. CHF admits that paragraph 25 purports to demand a trial by jury as to all claims and defenses in this action, and CHF demands a trial by jury as to all claims, affirmative defenses, and counterclaims triable of right by a jury in this action.

AFFIRMATIVE DEFENSES

First Affirmative Defense

26. The Complaint and Jury Demand of PBS fails to state facts sufficient to constitute a claim upon which relief may be granted.

Second Affirmative Defense

27. CHF has not infringed the '651 patent, either literally or under the doctrine of equivalents.

Third Affirmative Defense

28. CHF has not infringed the '039 patent, either literally or under the doctrine of equivalents.

Fourth Affirmative Defense

29. The '651 patent is invalid for failure to comply with the provisions of Title 35, United States Code, Section 102 on the grounds that:

(a) the alleged invention claimed therein was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the named inventors;

(b) the alleged invention claimed therein was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States;

(c) the alleged invention claimed therein was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the named inventors;

(d) the named inventors did not invent the subject matter sought to be patented; or

(e) before the named inventors' alleged invention thereof, the alleged invention claimed therein was made in this country by another who had not abandoned, suppressed, or concealed it.

Fifth Affirmative Defense

30. The '039 patent is invalid for failure to comply with the provisions of Title 35, United States Code, Section 102 on the grounds that:

(a) the alleged invention claimed therein was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the named inventors;

(b) the alleged invention claimed therein was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States;

(c) the alleged invention claimed therein was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the named inventors;

(d) the named inventors did not invent the subject matter sought to be patented; or

(e) before the named inventors' alleged invention thereof, the alleged invention claimed therein was made in this country by another who had not abandoned, suppressed, or concealed it.

Sixth Affirmative Defense

31. The '651 patent is invalid under the provisions of Title 35, United States Code, Section 103, on the grounds that the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious at the time the claimed invention was made to a person having ordinary skill in the art to which the claimed invention pertains.

Seventh Affirmative Defense

32. The '039 patent is invalid under the provisions of Title 35, United States Code, Section 103, on the grounds that the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious at the time the claimed invention was made to a person having ordinary skill in the art to which the claimed invention pertains.

Eighth Affirmative Defense

33. The '651 patent is invalid for failure to comply with the provisions of Title 35, United States Code, Section 112, second paragraph, on the grounds that the drawings and description of the alleged invention fail to particularly point out and distinctly claim the subject matter that the applicants regarded as their invention.

Ninth Affirmative Defense

34. The '039 patent is invalid for failure to comply with the provisions of Title 35, United States Code, Section 112, second paragraph, on the grounds that the drawings and description of the alleged invention fail to particularly point out and distinctly claim the subject matter that the applicants regarded as their invention.

Tenth Affirmative Defense

35. The '651 patent is invalid for failure to comply with the provisions of Title 35, United States

Code, Section 171, on the grounds that the claimed design is primarily functional, not ornamental, and therefore is directed to nonstatutory subject matter for a design patent.

Eleventh Affirmative Defense

36. The '039 patent is invalid for failure to comply with the provisions of Title 35, United States Code, Section 171, on the grounds that the claimed design is primarily functional, not ornamental, and therefore is directed to nonstatutory subject matter for a design patent.

Twelfth Affirmative Defense

37. After receiving notice of the '651 patent, CHF has acted, based on advice of counsel, in the good faith belief that the '651 patent is invalid.

Thirteenth Affirmative Defense

38. After receiving notice of the '039 patent, CHF has acted, based on advice of counsel, in the good faith belief that the '039 patent is invalid.

COUNTERCLAIMS

FIRST COUNTERCLAIM

1. Defendant/Counterclaim Plaintiff CHF Industries, Inc. (hereinafter "CHF") re-alleges and incorporates herein (a) its responses to the allegations of paragraphs 1-25 of PBS's Complaint and Jury Demand, and (b) the affirmative defenses recited by CHF at paragraphs 26-38 of the Answer to which these

Counterclaims are appended. This First Counterclaim is asserted in Civil Action No. 06 CV 869 (LMM) against Plaintiff/Counterclaim Defendant Park B. Smith, Inc. (hereinafter "PBS") by CHF and arises under the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202 and under Title 28, United States Code, Sections 1331 and 1338(a). There is a case of actual controversy concerning the alleged infringement of U.S. Design Patent No. D493,651 S ("the '651 patent"), as set forth in the Complaint and Jury Demand filed by PBS in this action and in the above Answer of CHF to which these Counterclaims are appended.

2. This Court has subject matter jurisdiction over this counterclaim pursuant to the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202 and Title 28 of the United States Code, Sections 1331 and 1338(a).

3. This Court has personal jurisdiction over PBS with respect to these Counterclaims based on PBS's assertion in its Complaint and Jury Demand that it has its principal place of business in this Judicial District at 295 Fifth Avenue, New York, New York 10016, and PBS's filing of its Complaint and Jury Demand in this Court, by which PBS has submitted itself to the personal jurisdiction of this Court.

4. Venue for these Counterclaims lies in this Judicial District under Title 28 of the United States Code, Sections 1391(b) and (c), and 1400(b), on the grounds that: (a) PBS resides in this Judicial District; (b) PBS has a regular and established place of business in this Judicial District; and (c) by filing its Complaint

and Jury Demand in this Court, PBS has submitted itself to the personal jurisdiction and venue of this Court.

5. On August 3, 2004, the United States Patent and Trademark Office issued the '651 patent, which named Park B. Smith and Linda Johnson as inventors and Park B. Smith, Inc. as the assignee.

6. PBS claims to be the owner of the '651 patent, and to have the right to sue and recover damages for infringement of the '651 patent.

7. PBS has asserted that CHF manufactured, sold, and offered for sale, in this judicial district and elsewhere, various soft shade window treatment products identified as "Pole-Top Roman Shade," and that said products allegedly infringe the '651 patent.

8. CHF has not infringed, and is not infringing, the '651 patent.

9. Therefore, there exists a case of actual controversy between the parties as to the infringement of the '651 patent with respect to which CHF requests a declaratory judgment of non-infringement of the '651 patent in its favor.

SECOND COUNTERCLAIM

10. CHF re-alleges and incorporates herein (a) its responses to the allegations of paragraphs 1-25 of PBS's Complaint and Jury Demand, (b) the affirmative defenses recited by CHF at paragraphs 26-38 of the Answer to which these Counterclaims are appended, and

(c) paragraphs 1-9 of the First Counterclaim set forth above.

11. This Second Counterclaim is asserted in Civil Action No. 06 CV 869 (LMM) against PBS by CHF and arises under the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202 and under Title 28, United States Code, Sections 1331 and 1338(a). There is a case of actual controversy concerning the alleged infringement of U.S. De-sign Patent No. D505,039 S ("the '039 patent"), as set forth in the Complaint and Jury Demand filed by PBS in this action and in the above Answer to which these Counterclaims are appended.

12. This Court has subject matter jurisdiction over this counterclaim pursuant to the Declaratory Judgment Act, Title 28, United Stated Code, Sections 2201(a) and 2202 and Title 28, United States Code, Sections 1331 and 1338(a).

13. On May 17, 2005, the United States Patent and Trademark Office issued the '039 patent, which named Park B. Smith and Linda Johnson as inventors and Park B. Smith, Inc. as the assignee.

14. PBS claims to be the owner of the '039 patent, and to have the right to sue and recover damages for infringement of the '039 patent.

15. PBS has asserted that CHF manufactured, sold, and offered for sale, in this judicial district and elsewhere, various soft shade window treatment products identified as "Pole-Top Roman Shade," and that said products allegedly infringe the '039 patent.

16. CHF has not infringed, and is not infringing, the '039 patent.

17. Therefore, there exists a case of actual controversy between the parties as to the infringement of the '039 patent with respect to which CHF requests a declaratory judgment of non-infringement of the '039 patent in its favor.

THIRD COUNTERCLAIM

18. CHF re-alleges and incorporates herein (a) its responses to the allegations of paragraphs 1-25 of PBS's Complaint and Jury Demand, (b) the affirmative defenses recited by CHF at paragraphs 26-38 of the Answer to which these Counterclaims are appended, (c) paragraphs 1-9 of the First Counterclaim set forth above, and (d) paragraphs 10-17 of the Second Counterclaim set forth above.

19. This Third Counterclaim is asserted in Civil Action No. 06 CV 869 (LMM) against PBS by CHF and arises under the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202 and under Title 28, United States Code, Sections 1331 and 1338(a). There is a case of actual controversy concerning the validity of the '651 patent, as set forth in the Complaint and Jury Demand filed by PBS in this action and in the above Answer to which these Counterclaims are appended.

20. This Court has subject matter jurisdiction over this counterclaim pursuant to the Declaratory Judgment Act, Title 28, United Stated Code, Sections

2201(a) and 2202 and Title 28, United States Code, Sections 1331 and 1338(a).

21. PBS has asserted that the '651 patent was duly and lawfully issued on August 3, 2004.

22. On information and belief, the '651 patent is invalid and void under the provisions of Title 35, United States Code, Sections 102, 103, 112, and 171, on the grounds set forth in the Affirmative Defenses of the Answer to which this Counterclaim is appended, all of which are incorporated herein by reference.

23. Therefore, there exists a case of actual controversy between the parties as to the validity of the '651 patent with respect to which CHF requests a declaratory judgment of invalidity of the '651 patent.

FOURTH COUNTERCLAIM

24. CHF re-alleges and incorporates herein (a) its responses to the allegations of paragraphs 1-25 of PBS's Complaint and Jury Demand, (b) the affirmative defenses recited by CHF at paragraphs 26-38 of the Answer to which these Counterclaims are appended, (c) paragraphs 1-9 of the First Counterclaim set forth above, (d) paragraphs 10-17 of the Second Counterclaim set forth above, and (e) paragraphs 18-23 of the Third Counterclaim set forth above.

25. This Fourth Counterclaim is asserted in Civil Action No. 06 CV 869 (LMM) against PBS by CHF and arises under the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202 and under Title 28, United States Code, Sections 1331 and

1338(a). There is a case of actual controversy concerning the validity of the '039 patent, as set forth in the Complaint and Jury Demand filed by PBS in this action, and in the above Answer to which these Counterclaims are appended.

26. This Court has subject matter jurisdiction over this counterclaim pursuant to the Declaratory Judgment Act, Title 28, United Stated Code, Sections 2201(a) and 2202 and Title 28, United States Code, Sections 1331 and 1338(a).

27. PBS has asserted that the '039 patent was duly and lawfully issued on May 17, 2005.

28. On information and belief, the '039 patent is invalid and void under the provisions of Title 35, United States Code, Sections 102, 103, 112, and 171 on the grounds set forth in the Affirmative Defenses of the Answer to which this Counterclaim is appended, all of which are incorporated herein by reference.

29. Therefore, there exists a case of actual controversy between the parties as to the validity of the '039 patent with respect to which CHF requests a declaratory judgment of invalidity of the '039 patent.

FIFTH COUNTERCLAIM

30. CHF re-alleges and incorporates herein (a) its responses to the allegations of paragraphs 1-25 of PBS's Complaint and Jury Demand, (b) the affirmative defenses recited by CHF at paragraphs 26-38 of the Answer to which these Counterclaims are appended, (c) paragraphs 1-9 of the First Counterclaim set forth

above, (d) paragraphs 10-17 of the Second Counterclaim set forth above, (e) paragraphs 18-23 of the Third Counterclaim set forth above, and (f) paragraphs 24-29 of the Fourth Counterclaim set forth above.

31. This Fifth Counterclaim is asserted in Civil Action No. 06 CV 869 (LMM) against PBS by CHF and arises under the Declaratory Judgment Act, Title 28, United States Code, Sections 2201(a) and 2202, under Title 28, United States Code, Sections 1331 and 1338(a), and under Title 35, United Stated Code, Section 285. There is a case of actual controversy as to whether PBS has litigated Civil Action No. 06 CV 869 (LMM) in bad faith, on the grounds set forth in paragraphs 33-35 hereinbelow.

32. This Court has subject matter jurisdiction over this counterclaim pursuant to the Declaratory Judgment Act, Title 28, United Stated Code, Sections 2201(a) and 2202 and Title 28, United States Code, Sections 1331 and 1338(a).

33. On March 13, 2006, CHF provided PBS with prior art obtained from Country Curtains. The Country Curtains prior art discloses pole top roman shade designs that anticipate or render obvious the designs claimed in the '651 and '039 patents, and that disclose each of the points of novelty of the designs claimed in the '651 and '039 patents, such that there is no infringement of the '651 and '039 patents by the accused Pole-Top Roman Shades.

34. Nonetheless, PBS has persisted in pursuing its claims against CHF, without any good faith basis, vexatiously subjecting CHF to the considerable expense

and inconvenience of defending itself against PBS's baseless assertion of the '651 and '039 patents.

35. PBS's continued assertion of its claims against CHF after receipt of the Country Curtains prior art constitutes vexatious, bad faith litigation and, based on all of the foregoing, CHF requests a declaratory judgment in its favor that this is an exceptional case under Title 35, United States Code, Section 285.

PRAYER FOR RELIEF

WHEREFORE, Defendant/Counterclaim Plaintiff CHF Industries requests judgment be entered as to Plaintiff Park B. Smith's Complaint and Jury Demand, and Defendant/Counterclaim Plaintiff CHF Industries' Counterclaims, as follows:

1. For a judgment in CHF's favor (a) denying in its entirety the relief sought in the Prayer for Relief set forth in the Complaint and Jury Demand; (b) declaring that PBS takes nothing by its suit in this action; and (c) dismissing PBS's Complaint and Jury Demand in this action with prejudice.

2. For a judgment in CHF's favor declaring that: (a) U.S. Design Patent No. D493,651 is not infringed by the making, using, selling, or offering for sale, in the United States, or the importing into the United States, of any CHF product identified as a "Pole-Top Roman Shade;" (b) U.S. Design Patent No. D505,039 is not infringed by the making, using, selling, or offering for sale, in the United States, or the importing into the United States, of any CHF product identified as a "Pole-Top Roman Shade;" (c) U.S. Design

Patent No. D493,651 is invalid and void in law; (d) U.S. Design Patent No. D505,039 is invalid and void in law; and (e) after March 13, 2006, on which date CHF provided PBS with prior art obtained from Country Curtains, this case was improvidently and vexatiously pursued by PBS without any reasonable basis in law and fact, and is therefore an exceptional case under 35 U.S.C. § 285.

3. For an award from PBS to CHF, in an amount to be determined, of reasonable attorneys' fees and costs.

4. For such other and further relief as the Court may deem just and appropriate.

DEMAND FOR JURY TRIAL

Defendant CHF respectfully demands a trial by jury of any and all issues triable of right by a jury in this action.

Respectfully submitted,

Dated: March 24, 2006
New York, New York

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Attorneys for Defendant
CHF Industries, Inc.

CERTIFICATE OF SERVICE

I certify that on March 24, 2006, the Answer and Counterclaims of Defendant/ Counterclaim Plaintiff CHF Industries, Inc. were filed electronically with:

Clerk of Court
United States District Court Southern District of New York
Daniel Patrick Moynihan United States Courthouse
500 Pearl Street
New York, New York 10007

On the same date, one copy of the Answer and Counterclaims of Defendant/Counterclaim Plaintiff CHF Industries, Inc. was hand-delivered to:

For Plaintiff Park B. Smith, Inc.

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Kathryn M. Ryan (KR 8359)
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s/ Joy Arnold
A. Joy Arnold

08-1320

In The
United States Court of Appeals
For The Federal Circuit

PARK B. SMITH, INC.,

Plaintiff-Appellant,

v.

CHF INDUSTRIES, INC.,

Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK IN CASE NO. 06 CV 869, JUDGE LAWRENCE M. MCKENNA

BRIEF OF DEFENDANT-APPELLEE CHF INDUSTRIES, INC.

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Attorneys for Defendant-Appellee CHF Industries, Inc.

Dated: October 30, 2008

JURISDICTIONAL STATEMENT

As set forth more fully in CHF's Motion to Dismiss[1] and CHF's Motion for Reconsideration[2] (which are both incorporated by reference as if set forth fully herein), this Court lacks jurisdiction over PBS's appeal because PBS failed to file a timely appeal to this Court as required by Rules 3(c)(1) and 4(a)(1)(A) of the Federal Rules of Appellate Procedure ("FRAP").

The requirements for appealing a district court judgment set forth in FRAP 3(c)(1) and 4(a)(1)(A) are jurisdictional and cannot be waived. Bowles v. Russell, 127 S.Ct. 2360, 2366 (2007) (timely filing of a notice of appeal in a civil case is jurisdictional requirement); Smith v. Barry, 502 U.S. 244, 248 (1992) (dictates of Rule 3(c)(1) are jurisdictional and their satisfaction is a prerequisite to appellate review); Oja v. Army, 405 F.3d 1349, 1358 (Fed. Cir. 2005) ("It is, of course, beyond cavil that the provisions of . . . Fed. R. App. P. 4(a) . . . are mandatory and jurisdictional.").

PBS's failure to comply with the jurisdictional requirements of FRAP 3 and 4 deprives this Court of jurisdiction to hear PBS's appeal. As a threshold matter, CHF requests that the Court re-visit the issue of its jurisdiction to hear this appeal, based on the grounds

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[1] Motion of Defendant-Appellee CHF Industries, Inc. to Dismiss Appeal of Plaintiff-Appellant Park B. Smith, Inc. for Lack of Jurisdiction, dated May 29, 2008 (Docket No. 13) (hereinafter "CHF's Motion to Dismiss").

[2] Motion for Reconsideration of Order Denying Defendant-Appellee CHF Industries, Inc.'s Motion to Dismiss Appeal of Plaintiff-Appellant Park B. Smith, Inc., dated June 27, 2008 (Docket No. 22) (hereinafter "CHF's Motion for Reconsideration").

set forth in CHF's Motion to Dismiss and CHF's Motion for Reconsideration.

NOTICE: THIS IS AN UNPUBLISHED OPINION.

(The Court's decision is referenced in a "Table of Decisions Without Reported Opinions" appearing in the Federal Reporter. Use FI CTAF Rule 47.6 for rules regarding the citation of unpublished opinions.)

United States Court of Appeals, Federal Circuit.

MEADE INSTRUMENTS CORPORATION, Plaintiff-Appellee,

v.

REDDWARF STARWARE, LLC (also known as Reddwarf Instruments, LLC), Defendant-Appellant.

No. 99-1517.

June 23, 2000.

Rehearing and Rehearing en Banc Denied March 12, 2001.

Before RADER, GAJARSA, and LINN, Circuit Judges.

ON MOTION

LINN, Circuit Judge.

ORDER

*1 Meade Instruments Corporation moves to dismiss Reddwarf Starware, LLC's appeal for lack of jurisdiction. Reddwarf opposes and moves for costs and

fees incurred in responding to the motion to dismiss. Meade replies.

Meade filed an action against Reddwarf in the United States District Court for the Central District of California for a declaration of patent invalidity and noninfringement, for antitrust and unfair competition violations, and for an injunction against claims that Meade's product infringed Reddwarf's patent. Reddwarf counterclaimed for patent infringement. On July 2, 1999, the court entered summary judgment in favor of Meade on the noninfringement claim, expressly reserving judgment over the issue of attorney fees. The request for injunctive relief and the antitrust and unfair competition claims remained pending. On July 27, 1999, Reddwarf noted an appeal from the district court's July 2, 1999 judgment. On the same date, Reddwarf moved pursuant to Fed.R.Civ.P. 54(b) for certification of the July 2, 1999 judgment, and for certification of a May 11, 1998 order denying Reddwarf's motion to dismiss for lack of personal jurisdiction.

Pursuant to a stipulation of the parties, on August 24, 1999, the court dismissed without prejudice Meade's remaining claims and its request for injunctive relief, and removed from the calendar as moot Reddwarf's motion for Rule 54(b) certification. On January 18, 2000, the court "direct[ed] the entry of a final and appealable judgment forthwith," incorporating its earlier judgment of noninfringement, its dismissal pursuant to stipulation of Meade's remaining claims, and its award to Meade of $33,681.50 in attorney fees pursuant to 35 U.S.C. § 285. Reddwarf did not file a notice of appeal after entry of the January 18, 2000 judgment.

Meade moves to dismiss Reddwarf's appeal for lack of jurisdiction. Meade argues that Reddwarf's July 27, 1999 appeal was premature and ineffective to confer appellate jurisdiction to review the district court's final judgment, entered on January 18, 2000, which disposed of all claims asserted in the complaint. Meade argues that Reddwarf erred in failing to file a notice of appeal within 30 days of the final judgment as required by Fed. R.App. P. 4(a)(1)(A).

Reddwarf opposes dismissal, arguing that "the decision from which an appeal was take by Reddwarf was unquestionably a final one as to the only real issue in the case," and that the other remaining claims asserted by Meade "were merely gratuitous window dressing." It further asserts that its motion for Rule 54(b) certification "would in all likelihood have been granted" if Meade had not stipulated to dismissal of its remaining claims, and that "the stipulation and order took the place of the certification under Rule 54(b) and served to place the case in a like posture of finality for appeal purposes." Reddwarf additionally urges the court to follow the approach of "pragmatic finality" based on the circumstance of this case, arguing that "[t]o do otherwise would serve no purpose other than to reward Meade for its role in creating this situation in the first place." Reddwarf also moves for an award of costs and attorney fees "incurred in responding to this frivolous motion."

*2 Fed. R.App. P. 4(a)(2) provides that "[a] notice of appeal filed after the court announces a decision or order-but before the entry of the judgment or order-is treated as filed on the date of and after the entry." While the parties dispute the applicability of this rule, they agree that resolution of the jurisdictional question

must begin with the Supreme Court's decision in FirsTier Mortgage Company v. Investors Mortgage Insurance Company, 498 U.S. 269, 111 S.Ct. 648, 112 L.Ed.2d 743 (1991). In FirstTier, the Court was faced with a premature notice of appeal filed after the court orally announced its intention to grant summary judgment, but before the parties had submitted proposed findings of fact and conclusions of law and before the court had entered judgment. The Court concluded that "Rule 4(a)(2) permits a notice of appeal filed from certain nonfinal decisions to serve as an effective notice from a subsequently entered final judgment." It continued:

> Rule 4(a)(2) was intended to protect the unskilled litigant who files a notice of appeal from a decision that he reasonably but mistakenly believes to be a final judgment, while failing to file a notice of appeal from the actual final judgment. This is not to say that Rule 4(a)(2) permits a notice of appeal from a clearly interlocutory decision-such as a discovery ruling or a sanction order under Rule 11 of the Federal Rules of Civil Procedure-to serve as notice of appeal from the final judgment. A belief that such a decision is a final judgment would not be reasonable. In our view, Rule 4(a)(2) permits a notice of appeal from a nonfinal decision to operate as a notice of appeal from the final judgment only when a district court announces a decision that would be appealable if immediately followed by the entry of judgment. In these instances, a litigant's confusion is understandable, and

> permitting the notice of appeal to become effective when judgment is entered does not catch the appellee by surprise.

The Court concluded that because the trial court's oral ruling announced a decision purporting to dispose of all claims, the appellant's belief in the finality of that ruling was reasonable, and its premature notice of appeal should be treated as an effective notice from the later-entered judgment.

Before FirsTier, some of our sister circuits had adopted the doctrine of "cumulative finality" in which a premature notice of appeal ripened and secured appellate jurisdiction when the district court's judgment became final before disposition of the appeal.[3] Reddwarf argues the continued viability of that doctrine, relying on Lazy Oil Co., v. Witco Corporation, 166 F.3d 581, (3rd Cir. 1999), where the Third Circuit concluded that its decision outlining the cumulative finality doctrine had not been overruled by FirsTier. The court in Lazy Oil found no inconsistency because the Supreme Court in FirsTier "did not hold that the Rule 4(a)(2) situation – announcement of a final decision followed by notice of

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[3] See Sacks v. Rothberg, 845 F.2d 1098, 1099 (D.C. 1988); Gillis v. U.S. Dep't of H. & H. Services, 759 F.2d 565, 569 (6th Cir. 1985); Alcorn County v. Interstate Supplies, Inc., 731 F.2d 1160, 1165-66 (5th Cir. 1984); Cape May Greene, Inc. v. Warren, 698 F.2d 179, 184-85 (3rd Cir. 1983); Martin v. Campbell, 692 F.2d 112, 114 (11th Cir. 1982); Pireno v. New York State Chiropratic Ass'n, 650 F.2d 387, 389 n. 4 (2d Cir. 1981), aff'd. sum nom. Union Labor Life Ins. Co. v. Pireno, 458 U .S. 110 (1982); Anderson v. Allstate Ins. Co., 630 F.2d 677, 681-81 (9th Cir. 1980); Merchants & Planters Bank v. Smith, 516 F.2d 355, 356 n. 3 (8th Cir. 1975).

appeal and then entry of the judgment – is the only situation in which a premature notice of appeal will ripen at a later date." Reddwarf also relies heavily on Barrett v. Atlantic Richfield Company, 95 F.3d 375 (5th Cir. 1996), a case in which a group of plaintiffs had appealed an order granting summary judgment against them even though the claims asserted by other plaintiffs had remained pending. Although a new notice of appeal was not filed by the appellants after the remaining claims were disposed of by final order, the Barrett court nevertheless determined, based on FirsTier, that "[b]ecause the district court's order would have been appealable if followed by Rule 54(b) certification and order, Rule 4(a)(2) permits the court to exercise its jurisdiction."

*3 In contradistinction, a number of other circuits have concluded that FirsTier has limited the applicability of R. 4(a)(2). In Strasburg v. State Bar of Wisconsin, 1 F.3d 468 (7th Cir. 1993), the court opined that "FirsTier appears to save a notice of appeal filed after a decision when the litigant could reasonably believe that the outcome of the case is settled, even if the district court has ministerial duties left to complete." The court further explained that "a litigant seeking to take advantage of Rule 4(a)(2)'s saving provision must continue to be reasonably 'confused as to the status of the litigation'... until final judgment is actually entered. If the litigant becomes aware of the fact that the notice of appeal is invalid because no final judgment has yet been entered, then he or she has both the knowledge and the opportunity (for thirty more days) to correct the mistake." In United States v. Cooper, 135 F.3d 960 (5th Cir. 1998), the court ruled that after FirsTier,"[o]nly where the appealing party is fully certain of the court's

disposition, such that the entry of final judgment is predictably a formality, will appeal be proper." It additionally concluded that the expansive view of appellate jurisdiction outlined in its pre-FirsTier decisions "cannot survive" in light of FirsTier, and that FirsTier "allows premature appeals only where there has been a final decision rendered without a formal judgment."[4] See also In re Jack Raley Construction, Inc. v. Homestead Development Company, Inc., 17 F.3d 291 (9th Cir. 1994) (premature notice of appeal valid where only ministerial functions left to complete, not when trial court adjudication incomplete); Serine v. Peterson, 989 F.2d 371 (9th Cir. 1993) (appeal from magistrate order premature because order could not form the basis of a final judgment); but see Fadem v. U.S., 42 F.3d 533 (9th Cir. 1994) (absence of Rule 54(b) certification cured and premature appeal effective when remaining consolidated case dismissed), cert. granted, judgment vacated, case remanded for further consideration, 520 U.S. 1101, 117 S.Ct. 1103, 137 L.Ed.2d 306 (1997), opinion reinstated, 164 F.3d 1242 (9th Cir. 1999).

We conclude that the latter group of cases provides the better view of the law. In our view, the Supreme Court's FirsTier decision prevents us from asserting appellate jurisdiction over this case. Unlike the situation in FirsTier, the district court's order did not purport to dispose of all of Meade's claims and, importantly, Reddwarf's motion for Rule 54(b) certification belies any notion that it was under the mistaken impression that the district court's order was final and appealable. While

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[4] Cooper appears inconsistent with the Fifth Circuit's earlier decision in Barrett on which Reddwarf heavily relies, and it leaves doubt as to whether Barrett remains good law.

Reddwarf may be correct that absent Meade's stipulation to dismissal of its remaining claims the district court may have certified the issues for immediate review, that situation is not before us and the stipulation and order did not constitute a certification for finality purposes. It is not Meade's action that precludes our appellate jurisdiction, but rather Reddwarf's inaction in failing to appeal after the district court issued a final judgment resolving all claims and issues in the case.

*4 Accordingly,

IT IS ORDERED THAT:

(1) Meade's motion to dismiss is granted.

(2) Reddwarf's motion for costs and attorney fees is denied.

(3) Each side shall bear its own costs.

C.A.Fed.,2000.
Meade Instruments Corp. v. Reddwarf Starware, LLC
250 F.3d 759, 2000 WL 987268 (C.A.Fed.)

This case was not selected for publication in the Federal Reporter.

Not for Publication in West's Federal Reporter See Fed. Rule of Appellate Procedure 32.1 generally governing citation of judicial decisions issued on or after Jan. 1, 2007. See also Federal Circuit Rule 32.1 and Federal Circuit Local Rule 32.1. (Find CTAF Rule 32.1)

United States Court of Appeals, Federal Circuit.

STONEY POINT PRODUCTS, INC., Plaintiff-Appellee,

v.

John UNDERWOOD, Defendant-Appellant.

No. 01-1236.

June 7, 2001.

Plaintiff brought action seeking declaration of patent invalidity and noninfringement, unfair competition, deceptive trade practices, and patent misuse. Defendant counterclaimed for patent infringement, interference with prospective business advantage, and defamation/product disparagement. The United States District Court for the District of Minnesota entered partial summary judgment in favor of plaintiff on noninfringement and invalidity claims, and defendant appealed. On plaintiff's motion to dismiss appeal, the Court of Appeals, Gajarsa, Circuit Judge, held that premature appeal precluded Court of Appeals from exercising jurisdiction.

Motion granted.

*829 Before MAYER, Chief Judge, SCHALL and GAJARSA, Circuit Judges.

ON MOTION

GAJARSA, Circuit Judge.

ORDER

**1 Stoney Point Products, Inc. moves to dismiss John Underwood's appeal for lack of jurisdiction. Underwood opposes. Stoney Point replies.

Stoney Point filed an action against Underwood in the United States District Court for the District of Minnesota for a declaration of patent invalidity and noninfringement, unfair competition, deceptive trade practices, and patent misuse. Underwood counterclaimed for patent infringement, interference with prospective business advantage, and defamation/product disparagement. On December 22, 2000, the court granted summary judgment in favor of Stoney Point on the noninfringement and invalidity claims. Stoney Point's tort claims remained pending and, on January 12, 2001, those claims were set for trial on March 5, 2001.[5] On January 29, 2001, the district court denied Underwood's request to file a motion to reconsideration of the December 22, 2000 order, noting

[5] Underwood voluntarily dismissed his tort counterclaims before the district court's December 22, 2000 partial summary judgment order.

that a motion for reconsideration under Fed.R.Civ.P. 59(e) was untimely because it must be filed within 10 days of judgment and ruling that Underwood had failed to demonstrate "compelling circumstances," a requirement for reconsideration under the district court's Local Rule 7.1(g). On February 26, 2001, 65 days after entry of the December 22, 2000 partial summary judgment, Underwood filed a notice of appeal.

On March 2, 2001, pursuant to a stipulation of the parties, the district court entered final judgment on the infringement and invalidity claims pursuant to its December 22, 2000 order and dismissed without prejudice Stoney Point's tort claims. Underwood did not file a notice of appeal from the district court's March 2, 2001 judgment.

Stoney Point moves to dismiss Underwood's appeal for lack of jurisdiction. Stoney Point argues that Underwood's *830 February 26, 2001 appeal was premature and ineffective to confer appellate jurisdiction to review the district court's final judgment, entered on March 2, 2001, which disposed of all claims asserted in the complaint. Stoney Point argues that Underwood erred in failing to file a notice of appeal within 30 days of the final judgment as required by Fed. R.App. P. 4(a)(1)(A).

Underwood opposes dismissal, arguing that his notice of appeal was timely filed within 30 days of the court's January 29, 2001 order denying him leave to file a motion for reconsideration. Underwood argues that the district court's January 29, 2001 order contained a declaration that its December 22, 2000 order granting partial summary judgment was "final," thus,

Underwood's time to appeal began to run from the date of the court's January 29, 2001 declaration. Underwood additionally asserts that "[a]ll claims need not be finally determined before an appeal is pursued. The only requirement is that the claim being appealed is final."

[1] Underwood is mistaken as to when a judgment is final for purposes of judicial review. Absent certification under Fed.R.Civ.P. 54(b), a judgment disposing of only some asserted claims is not final for appeal purposes. See Aleut Tribe v. United States, 702 F.2d 1015, 1020 (Fed. Cir. 1983) ("an appeal from an Order that disposes of only some claims of an action may *not* be made without waiting for a decision on the remainder of the case, unless the requirements of Rule 54(b) of the Federal Rule of Civil Procedure are met"); see also 28 U.S.C. § 1295(a) (this court has jurisdiction "of an appeal from a final decision of the district court of the United States ... if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title"). In addition, contrary to Underwood's assertion, a notice of appeal must be filed "within 30 days after the judgment ... is entered," not within 30 days of an order declaring a judgment to be "final."[6] Fed. R. App. P. 4(a)(1)(A); 28 U.S.C. § 2107. While the district court granted partial summary judgment on the infringement and invalidity claims on December 22, 2000, it did not "enter" final judgment until March 2, 2001.

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[6] Although Underwood argues otherwise, the district court's January 29, 2001 order does not contain a declaration as to finality. It merely asserts that a Fed.R.Civ.P. 59(e) motion to amend must be filed within 10 days of judgment and that Underwood's motion was not submitted within that time period. It does not state that the order was a final judgment for appeal purposes.

**2 Moreover, Fed. R.App. P. 4(a)(2)[7] is unavailable to save Underwood's premature appeal. In FirsTier Mortgage Company v. Investors Mortgage Insurance Company, 498 U.S. 269, 276, 111 S.Ct. 648, 112 L.Ed.2d 743 (1991), the Supreme Court considered the parameters of Rule 4(a)(2) and stated:

> Rule 4(a)(2) was intended to protect the unskilled litigant who files a notice of appeal from a decision that he reasonably but mistakenly believes to be a final judgment, while failing to file a notice of appeal from the actual final judgment ... In our view, Rule 4(a)(2) permits a notice of appeal from a nonfinal decision to operate as a notice of appeal from the final judgment only when a district court announces a decision that would be appealable if immediately followed by the entry of judgment. In these instances, a litigant's confusion is understandable, *831 and permitting the notice of appeal to become effective when judgment is entered does not catch the appellee by surprise.

Thus, after FirsTier, Rule 4(a)(2) has limited applicability. See, e.g., United States v. Cooper, 135 F.3d 960, 963 (5th Cir. 1998) (After FirsTier "[o]nly where the appealing party is fully certain of the court's disposition, such that the entry of final

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[7] Fed. R.App. P. 4(a)(2) provides that "[a] notice of appeal filed after the court announces a decision or order-but before the entry of the judgment or order-is treated as filed on the date of and after the entry."

judgment is predictably a formality, will appeal be proper"); In re Jack Raley Construction, Inc. v. Homestead Development Company, Inc., 17 F.3d 291 (9th Cir. 1994) (premature notice of appeal valid where only ministerial functions left to complete, not when trial court adjudication incomplete); Strasburg v. State Bar of Wisconsin, 1 F.3d 468, 472 (7th Cir. 1993) ("a litigant seeking to take advantage of Rule 4(a)(2)'s saving provision must continue to be reasonably 'confus[ed] as to the status of the litigation'... until final judgment is actually entered).

[2] We conclude that FirsTier prevents us from asserting appellate jurisdiction over this case. The district court's order did not purport to dispose of all of Stoney Point's claims. Given the district court's January 26, 2001 order setting Stoney Point's remaining claims for trial on March 5, 2001 and Underwood's March 2, 2001 stipulation to the entry of final judgment, there is no reasonable basis for Underwood to assert that he was under the mistaken impression that the district court's December 22, 2000 order was final and appealable. Underwood's inaction in failing to appeal after the district court issued a final judgment resolving all claims and issues in the case requires us to dismiss this appeal for lack of jurisdiction.

Accordingly,

IT IS ORDERED THAT:

(1) Stoney Point's motion to dismiss is granted.

(2) Each side shall bear its own costs.

C.A.Fed.,2001.
Stoney Point Products, Inc. v. Underwood
15 Fed.Appx. 828, 2001 WL 706910 (C.A.Fed.)

28 U.S.C.A. § 1291

§ 1291. Final decisions of district courts

The courts of appeals (other than the United States Court of Appeals for the Federal Circuit) shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. The jurisdiction of the United States Court of Appeals for the Federal Circuit shall be limited to the jurisdiction described in sections 1292(c) and (d) and 1295 of this title.

28 U.S.C.A. § 1295

§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction--

(1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to copyrights, exclusive rights in mask works, or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title;

(2) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1346 of this title, except that jurisdiction of an appeal in a case brought in a district court under section 1346(a)(1), 1346(b), 1346(e), or 1346(f) of this title or under section 1346(a)(2) when the claim is founded upon an Act of Congress or a regulation of an executive department providing for internal revenue

shall be governed by sections 1291, 1292, and 1294 of this title;

(3) of an appeal from a final decision of the United States Court of Federal Claims;

(4) of an appeal from a decision of--

(A) the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to patent applications and interferences, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;

(B) the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. 1071); or

(C) a district court to which a case was directed pursuant to section 145, 146, or 154(b) of title 35;

(5) of an appeal from a final decision of the United States Court of International Trade;

(6) to review the final determinations of the United States International Trade Commission relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337);

(7) to review, by appeal on questions of law only, findings of the Secretary of Commerce under U.S. note 6 to subchapter X of chapter 98 of the Harmonized Tariff Schedule of the United States (relating to importation of instruments or apparatus);

(8) of an appeal under section 71 of the Plant Variety Protection Act (7 U.S.C. 2461);

(9) of an appeal from a final order or final decision of the Merit Systems Protection Board, pursuant to sections 7703(b)(1) and 7703(d) of title 5;

(10) of an appeal from a final decision of an agency board of contract appeals pursuant to section 8(g)(1) of the Contract Disputes Act of 1978 (41 U.S.C. 607(g)(1));

(11) of an appeal under section 211 of the Economic Stabilization Act of 1970;

(12) of an appeal under section 5 of the Emergency Petroleum Allocation Act of 1973;

(13) of an appeal under section 506(c) of the Natural Gas Policy Act of 1978; and

(14) of an appeal under section 523 of the Energy Policy and Conservation Act.

(b) The head of any executive department or agency may, with the approval of the Attorney General, refer to the Court of Appeals for the Federal Circuit for judicial review any final decision rendered by a board of contract appeals pursuant to the terms of any contract

with the United States awarded by that department or agency which the head of such department or agency has concluded is not entitled to finality pursuant to the review standards specified in section 10(b) of the Contract Disputes Act of 1978 (41 U.S.C. 609(b)). The head of each executive department or agency shall make any referral under this section within one hundred and twenty days after the receipt of a copy of the final appeal decision.

(c) The Court of Appeals for the Federal Circuit shall review the matter referred in accordance with the standards specified in section 10(b) of the Contract Disputes Act of 1978. The court shall proceed with judicial review on the administrative record made before the board of contract appeals on matters so referred as in other cases pending in such court, shall determine the issue of finality of the appeal decision, and shall, if appropriate, render judgment thereon, or remand the matter to any administrative or executive body or official with such direction as it may deem proper and just.

28 U.S.C.A. § 2107

§ 2107. Time for appeal to court of appeals

(a) Except as otherwise provided in this section, no appeal shall bring any judgment, order or decree in an action, suit or proceeding of a civil nature before a court of appeals for review unless notice of appeal is filed, within thirty days after the entry of such judgment, order or decree.

(b) In any such action, suit or proceeding in which the United States or an officer or agency thereof is a party, the time as to all parties shall be sixty days from such entry.

(c) The district court may, upon motion filed not later than 30 days after the expiration of the time otherwise set for bringing appeal, extend the time for appeal upon a showing of excusable neglect or good cause. In addition, if the district court finds--

(1) that a party entitled to notice of the entry of a judgment or order did not receive such notice from the clerk or any party within 21 days of its entry, and

(2) that no party would be prejudiced,

the district court may, upon motion filed within 180 days after entry of the judgment or order or within 7 days after receipt of such notice, whichever is earlier, reopen the time for appeal for a period of 14 days from the date of entry of the order reopening the time for appeal.

(d) This section shall not apply to bankruptcy matters or other proceedings under Title 11.

Federal Rules of Appellate Procedure Rule 4, 28 U.S.C.A.

Rule 4. Appeal as of Right--When Taken

(a) Appeal in a Civil Case.

(1) Time for Filing a Notice of Appeal.

(A) In a civil case, except as provided in Rules 4(a)(1)(B), 4(a)(4), and 4(c), the notice of appeal required by Rule 3 must be filed with the district clerk within 30 days after the judgment or order appealed from is entered.

(B) When the United States or its officer or agency is a party, the notice of appeal may be filed by any party within 60 days after the judgment or order appealed from is entered.

(C) An appeal from an order granting or denying an application for a writ of error coram nobis is an appeal in a civil case for purposes of Rule 4(a).

(2) **Filing Before Entry of Judgment.** A notice of appeal filed after the court announces a decision or order--but before the entry of the judgment or order--is treated as filed on the date of and after the entry.

(3) **Multiple Appeals.** If one party timely files a notice of appeal, any other party may file a notice of appeal within 14 days after the date when the first notice was filed, or within the time otherwise prescribed by this Rule 4(a), whichever period ends later.

(4) Effect of a Motion on a Notice of Appeal.

(A) If a party timely files in the district court any of the following motions under the Federal Rules of Civil Procedure, the time to file an appeal runs for all parties from the entry of the order disposing of the last such remaining motion:

(i) for judgment under Rule 50(b);

(ii) to amend or make additional factual findings under Rule 52(b), whether or not granting the motion would alter the judgment;

(iii) for attorney's fees under Rule 54 if the district court extends the time to appeal under Rule 58;

(iv) to alter or amend the judgment under Rule 59;

(v) for a new trial under Rule 59; or

(vi) for relief under Rule 60 if the motion is filed no later than 10 days after the judgment is entered.

(B)(i) If a party files a notice of appeal after the court announces or enters a judgment--but before it disposes of any motion listed in Rule 4(a)(4)(A)--the notice becomes effective to appeal a judgment or order, in whole or in part, when the order disposing of the last such remaining motion is entered.

(ii) A party intending to challenge an order disposing of any motion listed in Rule 4(a)(4)(A), or a

judgment altered or amended upon such a motion, must file a notice of appeal, or an amended notice of appeal--in compliance with Rule 3(c)--within the time prescribed by this Rule measured from the entry of the order disposing of the last such remaining motion.

(iii) No additional fee is required to file an amended notice.

(5) Motion for Extension of Time.

(A) The district court may extend the time to file a notice of appeal if:

(i) a party so moves no later than 30 days after the time prescribed by this Rule 4(a) expires; and

(ii) regardless of whether its motion is filed before or during the 30 days after the time prescribed by this Rule 4(a) expires, that party shows excusable neglect or good cause.

(B) A motion filed before the expiration of the time prescribed in Rule 4(a)(1) or (3) may be ex parte unless the court requires otherwise. If the motion is filed after the expiration of the prescribed time, notice must be given to the other parties in accordance with local rules.

(C) No extension under this Rule 4(a)(5) may exceed 30 days after the prescribed time or 10 days after the date when the order granting the motion is entered, whichever is later.

(6) **Reopening the Time to File an Appeal.** The district court may reopen the time to file an appeal for a period of 14 days after the date when its order to reopen is entered, but only if all the following conditions are satisfied:

(A) the court finds that the moving party did not receive notice under Federal Rule of Civil Procedure 77(d) of the entry of the judgment or order sought to be appealed within 21 days after entry;

(B) the motion is filed within 180 days after the judgment or order is entered or within 7 days after the moving party receives notice under Federal Rule of Civil Procedure 77(d) of the entry, whichever is earlier; and

(C) the court finds that no party would be prejudiced.

(7) **Entry Defined.**

(A) A judgment or order is entered for purposes of this Rule 4(a):

(i) if Federal Rule of Civil Procedure 58(a)(1) does not require a separate document, when the judgment or order is entered in the civil docket under Federal Rule of Civil Procedure 79(a); or

(ii) if Federal Rule of Civil Procedure 58(a)(1) requires a separate document, when the judgment or order is entered in the civil docket under Federal Rule of Civil Procedure 79(a) and when the earlier of these events occurs:

• the judgment or order is set forth on a separate document, or

• 150 days have run from entry of the judgment or order in the civil docket under Federal Rule of Civil Procedure 79(a).

(B) A failure to set forth a judgment or order on a separate document when required by Federal Rule of Civil Procedure 58(a)(1) does not affect the validity of an appeal from that judgment or order.

(b) Appeal in a Criminal Case.

(1) Time for Filing a Notice of Appeal.

(A) In a criminal case, a defendant's notice of appeal must be filed in the district court within 10 days after the later of:

(i) the entry of either the judgment or the order being appealed; or

(ii) the filing of the government's notice of appeal.

(B) When the government is entitled to appeal, its notice of appeal must be filed in the district court within 30 days after the later of:

(i) the entry of the judgment or order being appealed; or

(ii) the filing of a notice of appeal by any defendant.

(2) Filing Before Entry of Judgment. A notice of appeal filed after the court announces a decision, sentence, or order--but before the entry of the judgment or order--is treated as filed on the date of and after the entry.

(3) Effect of a Motion on a Notice of Appeal.

(A) If a defendant timely makes any of the following motions under the Federal Rules of Criminal Procedure, the notice of appeal from a judgment of conviction must be filed within 10 days after the entry of the order disposing of the last such remaining motion, or within 10 days after the entry of the judgment of conviction, whichever period ends later. This provision applies to a timely motion:

(i) for judgment of acquittal under Rule 29;

(ii) for a new trial under Rule 33, but if based on newly discovered evidence, only if the motion is made no later than 10 days after the entry of the judgment; or

(iii) for arrest of judgment under Rule 34.

(B) A notice of appeal filed after the court announces a decision, sentence, or order--but before it disposes of any of the motions referred to in Rule 4(b)(3)(A)--becomes effective upon the later of the following:

(i) the entry of the order disposing of the last such remaining motion; or

(ii) the entry of the judgment of conviction.

(C) A valid notice of appeal is effective--without amendment--to appeal from an order disposing of any of the motions referred to in Rule 4(b)(3)(A).

(4) **Motion for Extension of Time.** Upon a finding of excusable neglect or good cause, the district court may--before or after the time has expired, with or without motion and notice--extend the time to file a notice of appeal for a period not to exceed 30 days from the expiration of the time otherwise prescribed by this Rule 4(b).

(5) **Jurisdiction.** The filing of a notice of appeal under this Rule 4(b) does not divest a district court of jurisdiction to correct a sentence under Federal Rule of Criminal Procedure 35(a), nor does the filing of a motion under 35(a) affect the validity of a notice of appeal filed before entry of the order disposing of the motion. The filing of a motion under Federal Rule of Criminal Procedure 35(a) does not suspend the time for filing a notice of appeal from a judgment of conviction.

(6) **Entry Defined.** A judgment or order is entered for purposes of this Rule 4(b) when it is entered on the criminal docket.

(c) Appeal by an Inmate Confined in an Institution.

(1) If an inmate confined in an institution files a notice of appeal in either a civil or a criminal case, the notice is timely if it is deposited in the institution's internal mail system on or before the last day for filing. If an institution has a system designed for legal mail, the inmate must use that

system to receive the benefit of this rule. Timely filing may be shown by a declaration in compliance with 28 U.S.C. § 1746 or by a notarized statement, either of which must set forth the date of deposit and state that first-class postage has been prepaid.

(2) If an inmate files the first notice of appeal in a civil case under this Rule 4(c), the 14-day period provided in Rule 4(a)(3) for another party to file a notice of appeal runs from the date when the district court dockets the first notice.

(3) When a defendant in a criminal case files a notice of appeal under this Rule 4(c), the 30-day period for the government to file its notice of appeal runs from the entry of the judgment or order appealed from or from the district court's docketing of the defendant's notice of appeal, whichever is later.

(d) Mistaken Filing in the Court of Appeals. If a notice of appeal in either a civil or a criminal case is mistakenly filed in the court of appeals, the clerk of that court must note on the notice the date when it was received and send it to the district clerk. The notice is then considered filed in the district court on the date so noted.

Federal Rules of Civil Procedure Rule 54

Rule 54. Judgment; Costs

(a) Definition; Form. "Judgment" as used in these rules includes a decree and any order from which an appeal lies. A judgment should not include recitals of pleadings, a master's report, or a record of prior proceedings.

(b) Judgment on Multiple Claims or Involving Multiple Parties. When an action presents more than one claim for relief--whether as a claim, counterclaim, crossclaim, or third-party claim--or when multiple parties are involved, the court may direct entry of a final judgment as to one or more, but fewer than all, claims or parties only if the court expressly determines that there is no just reason for delay. Otherwise, any order or other decision, however designated, that adjudicates fewer than all the claims or the rights and liabilities of fewer than all the parties does not end the action as to any of the claims or parties and may be revised at any time before the entry of a judgment adjudicating all the claims and all the parties' rights and liabilities.

(c) Demand for Judgment; Relief to Be Granted. A default judgment must not differ in kind from, or exceed in amount, what is demanded in the pleadings. Every other final judgment should grant the relief to which each party is entitled, even if the party has not demanded that relief in its pleadings.

(d) Costs; Attorney's Fees.

(1) ***Costs Other Than Attorney's Fees.*** Unless a federal statute, these rules, or a court order provides otherwise, costs--other than attorney's fees--should be allowed to the prevailing party. But costs against the United States, its officers, and its agencies may be imposed only to the extent allowed by law. The clerk may tax costs on 1 day's notice. On motion served within the next 5 days, the court may review the clerk's action.

(2) ***Attorney's Fees.***

(A) *Claim to Be by Motion.* A claim for attorney's fees and related nontaxable expenses must be made by motion unless the substantive law requires those fees to be proved at trial as an element of damages.

(B) *Timing and Contents of the Motion.* Unless a statute or a court order provides otherwise, the motion must:

(i) be filed no later than 14 days after the entry of judgment;

(ii) specify the judgment and the statute, rule, or other grounds entitling the movant to the award;

(iii) state the amount sought or provide a fair estimate of it; and

(iv) disclose, if the court so orders, the terms of any agreement about fees for the services for which the claim is made.

(C) *Proceedings.* Subject to Rule 23(h), the court must, on a party's request, give an opportunity for adversary submissions on the motion in accordance with Rule 43(c) or 78. The court may decide issues of liability for fees before receiving submissions on the value of services. The court must find the facts and state its conclusions of law as provided in Rule 52(a).

(D) *Special Procedures by Local Rule; Reference to a Master or a Magistrate Judge.* By local rule, the court may establish special procedures to resolve fee-related issues without extensive evidentiary hearings. Also, the court may refer issues concerning the value of services to a special master under Rule 53 without regard to the limitations of Rule 53(a)(1), and may refer a motion for attorney's fees to a magistrate judge under Rule 72(b) as if it were a dispositive pretrial matter.

(E) *Exceptions.* Subparagraphs (A)-(D) do not apply to claims for fees and expenses as sanctions for violating these rules or as sanctions under 28 U.S.C. § 1927.

Federal Rules of Civil Procedure Rule 58

Rule 58. Entering Judgment

(a) **Separate Document.** Every judgment and amended judgment must be set out in a separate document, but a separate document is not required for an order disposing of a motion:

(1) for judgment under Rule 50(b);

(2) to amend or make additional findings under Rule 52(b);

(3) for attorney's fees under Rule 54;

(4) for a new trial, or to alter or amend the judgment, under Rule 59; or

(5) for relief under Rule 60.

(b) **Entering Judgment.**

(1) ***Without the Court's Direction.*** Subject to Rule 54(b) and unless the court orders otherwise, the clerk must, without awaiting the court's direction, promptly prepare, sign, and enter the judgment when:

(A) the jury returns a general verdict;

(B) the court awards only costs or a sum certain; or

(C) the court denies all relief.

(2) ***Court's Approval Required.*** Subject to Rule 54(b), the court must promptly approve the form of the judgment, which the clerk must promptly enter, when:

(A) the jury returns a special verdict or a general verdict with answers to written questions; or

(B) the court grants other relief not described in this subdivision (b).

(c) Time of Entry. For purposes of these rules, judgment is entered at the following times:

(1) if a separate document is not required, when the judgment is entered in the civil docket under Rule 79(a); or

(2) if a separate document is required, when the judgment is entered in the civil docket under Rule 79(a) and the earlier of these events occurs:

(A) it is set out in a separate document; or

(B) 150 days have run from the entry in the civil docket.

(d) Request for Entry. A party may request that judgment be set out in a separate document as required by Rule 58(a).

(e) Cost or Fee Awards. Ordinarily, the entry of judgment may not be delayed, nor the time for appeal extended, in order to tax costs or award fees. But if a timely motion for attorney's fees is made under Rule 54(d)(2), the court may act before a notice of appeal has

been filed and become effective to order that the motion have the same effect under Federal Rule of Appellate Procedure 4(a)(4) as a timely motion under Rule 59.

Fed. R. App. P. 4 Advisory Committee Notes

1993 Amendment

Note to Paragraph (a)(1). The amendment is intended to alert readers to the fact that paragraph (a)(4) extends the time for filing an appeal when certain posttrial motions are filed. The Committee hopes that awareness of the provisions of paragraph (a)(4) will prevent the filing of a notice of appeal when a posttrial tolling motion is pending.

Note to Paragraph (a)(2). The amendment treats a notice of appeal filed after the announcement of a decision or order, but before its formal entry, as if the notice had been filed after entry. The amendment deletes the language that made paragraph (a)(2) inapplicable to a notice of appeal filed after announcement of the disposition of a posttrial motion enumerated in paragraph (a)(4) but before the entry of the order, see Acosta v. Louisiana Dep't of Health & Human Resources, 478 U.S. 251 (1986) (per curiam); Alerte v. McGinnis, 898 F.2d 69 (7th Cir.1990). Because the amendment of paragraph (a)(4) recognizes all notices of appeal filed after announcement or entry of judgment--even those that are filed while the posttrial motions enumerated in paragraph (a)(4) are pending--the amendment of this paragraph is consistent with the amendment of paragraph (a)(4).

Note to Paragraph (a)(3). The amendment is technical in nature; no substantive change is intended.

Note to Paragraph (a)(4). The 1979 amendment of this paragraph created a trap for an unsuspecting litigant

who files a notice of appeal before a posttrial motion, or while a posttrial motion is pending. The 1979 amendment requires a party to file a new notice of appeal after the motion's disposition. Unless a new notice is filed, the court of appeals lacks jurisdiction to hear the appeal. Griggs v. Provident Consumer Discount Co., 459 U.S. 56 (1982). Many litigants, especially pro se litigants, fail to file the second notice of appeal, and several courts have expressed dissatisfaction with the rule. See, e.g., Averhart v. Arrendondo, 773 F.2d 919 (7th Cir.1985); Harcon Barge Co. v. D & G Boat Rentals, Inc., 746 F.2d 278 (5th Cir.1984), cert. denied, 479 U.S. 930 (1986).

The amendment provides that a notice of appeal filed before the disposition of a specified posttrial motion will become effective upon disposition of the motion. A notice filed before the filing of one of the specified motions or after the filing of a motion but before disposition of the motion is, in effect, suspended until the motion is disposed of, whereupon, the previously filed notice effectively places jurisdiction in the court of appeals.

Because a notice of appeal will ripen into an effective appeal upon disposition of a posttrial motion, in some instances there will be an appeal from a judgment that has been altered substantially because the motion was granted in whole or in part. Many such appeals will be dismissed for want of prosecution when the appellant fails to meet the briefing schedule. But, the appellee may also move to strike the appeal. When responding to such a motion, the appellant would have an opportunity to state that, even though some relief sought in a posttrial motion was granted, the appellant still plans to

pursue the appeal. Because the appellant's response would provide the appellee with sufficient notice of the appellant's intentions, the Committee does not believe that an additional notice of appeal is needed.

The amendment provides that a notice of appeal filed before the disposition of a posttrial tolling motion is sufficient to bring the underlying case, as well as any orders specified in the original notice, to the court of appeals. If the judgment is altered upon disposition of a posttrial motion, however, and if a party wishes to appeal from the disposition of the motion, the party must amend the notice to so indicate. When a party files an amended notice, no additional fees are required because the notice is an amendment of the original and not a new notice of appeal.

Paragraph (a)(4) is also amended to include, among motions that extend the time for filing a notice of appeal, a Rule 60 motion that is served within 10 days after entry of judgment. This eliminates the difficulty of determining whether a posttrial motion made within 10 days after entry of a judgment is a Rule 59(e) motion, which tolls the time for filing an appeal, or a Rule 60 motion, which historically has not tolled the time. The amendment comports with the practice in several circuits of treating all motions to alter or amend judgments that are made within 10 days after entry of judgment as Rule 59(e) motions for purposes of Rule 4(a)(4). See, e.g., Finch v. City of Vernon, 845 F.2d 256 (11th Cir.1988); Rados v. Celotex Corp., 809 F.2d 170 (2d Cir.1986); Skagerberg v. Oklahoma, 797 F.2d 881 (10th Cir.1986). To conform to a recent Supreme Court decision, however--Budinich v. Becton Dickinson and Co., 486 U.S. 196 (1988)--the amendment excludes

motions for attorney's fees from the class of motions that extend the filing time unless a district court, acting under Rule 58, enters an order extending the time for appeal. This amendment is to be read in conjunction with the amendment of Fed.R.Civ.P. 58.

Note to subdivision (b). The amendment grammatically restructures the portion of this subdivision that lists the types of motions that toll the time for filing an appeal. This restructuring is intended to make the rule easier to read. No substantive change is intended other than to add a motion for judgment of acquittal under Criminal Rule 29 to the list of tolling motions. Such a motion is the equivalent of a Fed.R.Civ.P. 50(b) motion for judgment notwithstanding the verdict, which tolls the running of time for an appeal in a civil case.

The proposed amendment also eliminates an ambiguity from the third sentence of this subdivision. Prior to this amendment, the third sentence provided that if one of the specified motions was filed, the time for filing an appeal would run from the entry of an order denying the motion. That sentence, like the parallel provision in Rule 4(a)(4), was intended to toll the running of time for appeal if one of the posttrial motions is timely filed. In a criminal case, however, the time for filing the motions runs not from entry of judgment (as it does in civil cases), but from the verdict or finding of guilt. Thus, in a criminal case, a posttrial motion may be disposed of more than 10 days before sentence is imposed, i.e. before the entry of judgment. United States v. Hashagen, 816 F.2d 899, 902 n. 5 (3d Cir.1987). To make it clear that a notice of appeal need not be filed before entry of judgment, the amendment states that an

appeal may be taken within 10 days after the entry of an order disposing of the motion, or within 10 days after the entry of judgment, whichever is later. The amendment also changes the language in the third sentence providing that an appeal may be taken within 10 days after the entry of an order *denying* the motion; the amendment says instead that an appeal may be taken within 10 days after the entry of an order *disposing* of the last such motion outstanding. (Emphasis added) The change recognizes that there may be multiple posttrial motions filed and that, although one or more motions may be granted in whole or in part, a defendant may still wish to pursue an appeal.

The amendment also states that a notice of appeal filed before the disposition of any of the posttrial tolling motions becomes effective upon disposition of the motions. In most circuits this language simply restates the current practice. See United States v. Cortes, 895 F.2d 1245 (9th Cir.), cert. denied, 495 U.S. 939 (1990). Two circuits, however, have questioned that practice in light of the language of the rule, see United States v. Gargano, 826 F.2d 610 (7th Cir.1987), and United States v. Jones, 669 F.2d 559 (8th Cir.1982), and the Committee wishes to clarify the rule. The amendment is consistent with the proposed amendment of Rule 4(a)(4).

Subdivision (b) is further amended in light of new Fed.R.Crim.P. 35(c), which authorizes a sentencing court to correct any arithmetical, technical, or other clear errors in sentencing within 7 days after imposing the sentence. The Committee believes that a sentencing court should be able to act under Criminal Rule 35(c)

even if a notice of appeal has already been filed; and that a notice of appeal should not be affected by the filing of a Rule 35(c) motion or by correction of a sentence under Rule 35(c).

Note to subdivision (c). In Houston v. Lack, 487 U.S. 266 (1988), the Supreme Court held that a *pro se* prisoner's notice of appeal is "filed" at the moment of delivery to prison authorities for forwarding to the district court. The amendment reflects that decision. The language of the amendment is similar to that in Supreme Court Rule 29.2.

Permitting an inmate to file a notice of appeal by depositing it in an institutional mail system requires adjustment of the rules governing the filing of cross-appeals. In a civil case, the time for filing a cross-appeal ordinarily runs from the date when the first notice of appeal is filed. If an inmate's notice of appeal is filed by depositing it in an institution's mail system, it is possible that the notice of appeal will not arrive in the district court until several days after the "filing" date and perhaps even after the time for filing a cross-appeal has expired. To avoid that problem, subdivision (c) provides that in a civil case when an institutionalized person files a notice of appeal by depositing it in the institution's mail system, the time for filing a cross-appeal runs from the district court's receipt of the notice. The amendment makes a parallel change regarding the time for the government to appeal in a criminal case.

Fed. R. Civ. P. 54 Advisory Committee Notes

1946 Amendment

Note. The historic rule in the federal courts has always prohibited piecemeal disposal of litigation and permitted appeals only from final judgments except in those special instances covered by statute. Hohorst v. Hamburg--American Packet Co., 1893, 13 S.Ct. 590, 148 U.S. 262, 37 L.Ed. 443; Rexford v. Brunswick-Balke-Collender Co., 1913, 33 S.Ct. 515, 228 U.S. 339, 57 L.Ed. 864; Collins v. Miller, 1920, 40 S.Ct. 347, 252 U.S. 364, 64 L.Ed. 616. Rule 54(b) was originally adopted in view of the wide scope and possible content of the newly created "civil action" in order to avoid the possible injustice of a delay in judgment of a distinctly separate claim to await adjudication of the entire case. It was not designed to overturn the settled federal rule stated above, which, indeed, has more recently been reiterated in Catlin v. United States, 1945, 65 S.Ct. 631, 324 U.S. 229, 89 L.Ed. 911. See also United States v. Florian, 1941, 61 S.Ct. 713, 312 U.S. 656, 85 L.Ed. 1105; Reeves v. Beardall, 1942, 62 S.Ct. 1085, 316 U.S. 283, 86 L.Ed. 1478.

Unfortunately, this was not always understood, and some confusion ensued. Hence situations arose where district courts made a piecemeal disposition of an action and entered what the parties thought amounted to a judgment, although a trial remained to be had on other claims similar or identical with those disposed of. In the interim the parties did not know their ultimate rights, and accordingly took an appeal, thus putting the finality of the partial judgment in question. While most appellate courts have reached a result generally in

accord with the intent of the rule, yet there have been divergent precedents and division of views which have served to render the issues more clouded to the parties appellant. It hardly seems a case where multiplicity of precedents will tend to remove the problem from debate. The problem is presented and discussed in the following cases: Atwater v. North American Coal Corp., C.C.A.2, 1940, 111 F.2d 125; Rosenblum v. Dingfelder, C.C.A.2, 1940, 111 F.2d 406; Audi-Vision, Inc. v. RCA Mfg. Co., Inc., C.C.A.2, 1943, 136 F.2d 621; *Zalkind v. Scheinman*, C.C.A.2, 1943, 139 F.2d 895; Oppenheimer v. F. J. Young & Co., Inc., C.C.A.2, 1944, 144 F.2d 387; Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corp., C.C.A.2, 1946, 154 F.2d 814, certiorari denied 1946, 66 S.Ct. 1353, 328 U.S. 859, 90 L.Ed. 1630; Zarati Steamship Co. v. Park Bridge Corp., C.C.A.2, 1946, 154 F.2d 377; Baltimore and Ohio R. Co. v. United Fuel Gas Co., C.C.A.4, 1946, 154 F.2d 545; Jefferson Electric Co. v. Sola Electric Co., C.C.A.7, 1941, 122 F.2d 124; Leonard v. Socony-Vacuum Oil Co., C.C.A.7, 1942, 130 F.2d 535; Markham v. Kasper, C.C.A.7, 1945, 152 F.2d 270; Hanney v. Franklin Fire Ins. Co. of Philadelphia, C.C.A.9, 1944, 142 F.2d 864; Toomey v. Toomey, App.D.C.1945, 149 F.2d 19, 80 U.S.App.D.C. 77.

In view of the difficulty thus disclosed, the Advisory Committee in its two preliminary drafts of proposed amendments attempted to redefine the original rule with particular stress upon the interlocutory nature of partial judgments which did not adjudicate all claims arising out of a single transaction or occurrence. This attempt appeared to meet with almost universal approval from those of the profession commenting upon it, although there were, of course, helpful suggestions for additional changes in language or clarification of

detail. But cf. Circuit Judge Frank's dissenting opinion in Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corp., supra, n. 21 of the dissenting opinion. The Committee, however, became convinced on careful study of its own proposals that the seeds of ambiguity still remained, and that it had not completely solved the problem of piecemeal appeals. After extended consideration, it concluded that a retention of the older federal rule was desirable, and that this rule needed only the exercise of a discretionary power to afford a remedy in the infrequent harsh case to provide a simple, definite, workable rule. This is afforded by amended Rule 54(b). It re-establishes an ancient policy with clarity and precision. For the possibility of staying execution where not all claims are disposed of under Rule 54(b), see amended Rule 62(h).

U.S. District Court
United States District Court for the Southern District of New York (Foley Square)
CIVIL DOCKET FOR CASE #: 1:06-cv-00869-LMM-JCF

Park B. Smith Inc. v. CHF Industries Inc.
Assigned to: Judge Lawrence M. McKenna
Referred to: Magistrate Judge James C. Francis
Case in other court: U.S. Court of Appeals for the Federal Circuit, 08-01320
USCA Federal Circuit, 08-01320
Cause: 35:183 Patent Infringement

Date Filed: 02/03/2006
Jury Demand: Defendant
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

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V.

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		Alison Joy Arnold (See above for address) *ATTORNEY TO BE NOTICED*

V.

Counter Defendant

Park B. Smith Inc.	represented by	**Richard Anthony De Palma** (See above for address) *LEAD ATTORNEY* *ATTORNEY TO BE NOTICED*

Date Filed	#	Docket Text
02/03/2006	1	COMPLAINT against CHF Industries Inc.. (Filing Fee $ 250.00, Receipt Number 569225)Document filed by Park B. Smith Inc..(js,) Additional attachment(s) added on 2/6/2006 (laq,). (Entered: 02/03/2006)
02/03/2006		SUMMONS ISSUED as to CHF Industries Inc.. (js,) (Entered: 02/03/2006)
02/03/2006	2	RULE 7.1 DISCLOSURE STATEMENT. Document filed by Park B. Smith Inc..(js,) Additional attachment(s) added on 2/6/2006 (laq,). (Entered: 02/03/2006)
02/03/2006		Mailed notice to Commissioner of Patents and Trademarks to report the filing of this action. (js,) (Entered: 02/03/2006)
02/03/2006		Magistrate Judge James C. Francis is so designated. (kco,) (Entered: 03/21/2006)
02/03/2006		Case Designated ECF. (laq,) (Entered: 03/22/2006)
02/08/2006	3	AFFIDAVIT OF SERVICE of Summons and Complaint. CHF Industries Inc. served on 2/3/2006, answer due 2/23/2006. Service was accepted by Camillo Faraone, Chief

		Financial Officer. Document filed by Park B. Smith Inc.. (Bush, Lindsay) (Entered: 02/08/2006)
02/22/2006	4	MOTION for an order, admitting Stephen L. Sulzer to Appear Pro Hac Vice. Document filed by CHF Industries Inc.. (sac,) (Entered: 02/23/2006)
02/22/2006	5	MOTION for an order, admitting James P. Calve to Appear Pro Hac Vice. Document filed by CHF Industries Inc.. (sac,) (Entered: 02/23/2006)
02/23/2006	6	STIPULATION AND ORDER; that the time within which dft. CHF Industries, Inc. must answer, move, or otherwise respond to the Complaint and Jury Demand of Plaintiff Park B. Smith shall be extended to 3/24/06. (Signed by Judge Lawrence M. McKenna on 2/23/06) (pl,) (Entered: 02/23/2006)
02/23/2006		Set Answer Due Date purs. to 6 Stipulation and Order, as to CHF Industries Inc. answer due on 3/24/2006. (pl,) (Entered: 02/23/2006)
02/23/2006	7	ORDER granting 5 Motion for James P. Calve to Appear Pro Hac Vice . (Signed by Judge Lawrence M. McKenna on 2/23/06) (js,)

		(Entered: 02/24/2006)
02/23/2006	8	ORDER granting 4 Motion for Stephen L. Sulzer to Appear Pro Hac Vice . (Signed by Judge Lawrence M. McKenna on 2/23/06) (js,) (Entered: 02/24/2006)
02/27/2006	9	ORDER that the motion is granted and that Stephen is admitted to the Bar of this Court pro hac vice. (Signed by Judge Lawrence M. McKenna on 2/27/2006) (jmi,) (Entered: 02/27/2006)
02/27/2006	10	ORDER that the motion is granted and that James P. Calve is admitted to the Bar of this Court pro hac vice. (Signed by Judge Lawrence M. McKenna on 2/27/2006) (jmi,) (Entered: 02/27/2006)
03/01/2006	11	ENDORSED LETTER addressed to Judge Lawrence M. McKenna from A. Joy Arnold dated 2/22/2006 re: defendant requests that this case be returned to the Clerk's office. ENDORSEMENT: Denied. Judge Batts has declined to accept the case as related. SO ORDERED. (Signed by Judge Lawrence M. McKenna on 3/1/2006) (kco,) (Entered: 03/01/2006)
03/14/2006		CASHIERS OFFICE REMARK on 8 Order on Motion to Appear

		Pro Hac Vice, 7 Order on Motion to Appear Pro Hac Vice in the amount of $50.00, paid on 3/2/2006, Receipt Number 571668. (jd,) (Entered: 03/14/2006)
03/14/2006		Minute Entry for proceedings held before Judge Lawrence M. McKenna : Pretrial Conference held on 3/14/2006. Next pretrial conference scheduled for 4/11/2006 at 2:00 p.m. (kco,) (Entered: 03/15/2006)
03/20/2006	12	CASE MANAGEMENT PLAN and SCHEDULING ORDER: Discovery due by 11/30/2006. (Signed by Judge Lawrence M. McKenna on 3/14/06) (kco,) (Entered: 03/21/2006)
03/20/2006	13	ORDER REFERRING CASE TO MAGISTRATE JUDGE. Order that case be referred to the Clerk of Court for assignment to a Magistrate Judge for GENERAL PRETRIAL. Referred to Magistrate Judge James C. Francis. (Signed by Judge Lawrence M. McKenna on 3/14/06) (kco,) (Entered: 03/21/2006)
03/24/2006	14	RULE 7.1 DISCLOSURE STATEMENT. Document filed by CHF Industries Inc.. (Attachments:

		# 1 Certificate of Service)(Arnold, Alison) (Entered: 03/24/2006)
03/24/2006	15	ANSWER to Complaint with JURY DEMAND., COUNTERCLAIM against Park B. Smith Inc.. Document filed by CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 03/24/2006)
04/03/2006	16	ENDORSED LETTER: addressed to Judge Larence M. Mckenna from Richard De Palma dated 3/31/2006 re: respectfully requesting that the Court grant an adjournment of the conference. ENDORSEMENT: Conference adjourned to 4/17/2006 at 4:30 p.m. So Ordered. (Signed by Judge Lawrence M. McKenna on 4/3/2006) (lb,) (Entered: 04/03/2006)
04/03/2006		Minute Entry for proceedings held before Judge James C. Francis : Telephone (Pretrial) Conference held on 4/3/2006 at 9:30 a.m.. (sac,) (Entered: 04/04/2006)
04/05/2006	17	LETTER addressed to Judge Lawrence M. McKenna from Stephen L. Sulzer dated 4/3/06 re: response to plaintiff's 3/31/06 letter. Document filed by CHF Industries Inc.(db,) (Entered: 04/06/2006)

04/13/2006	18	REPLY re: 15 Answer to Complaint, Counterclaim. Document filed by Park B. Smith Inc., Park B. Smith Inc.. (Attachments: # 1 Certificate of Service)(Ryan, Kathryn) (Entered: 04/13/2006)
04/13/2006	19	ENDORSED LETTER addressed to Judge Lawrence M. McKenna from Stephen Sulzer dated 4/11/06 re: counsel requests permission to file the exhibits to the declarations in support of summary judgment motion as hard copies. Approved and so ordered. (Signed by Judge Lawrence M. McKenna on 4/12/06) (dle,) (Entered: 04/14/2006)
04/17/2006		Minute Entry for proceedings held before Judge Lawrence M. McKenna : Pretrial Conference held on 4/17/2006. No Transcript. Judge's Decision: defendant to file a motion for summary judgment on notice. Briefing schedule to be determined thereafter. Parties are to continue to pursue any settlement discussion. (db,) (Entered: 04/19/2006)
04/28/2006	20	FILING ERROR - DEFICIENT DOCKET ENTRY - MOTION for Summary Judgment of Noninfringement. Document filed

		by CHF Industries Inc., CHF Industries Inc. Responses due by 5/12/2006 (Attachments: # 1 Statement of Material Facts)(Arnold, Alison) Modified on 5/1/2006 (kg). (Entered: 04/28/2006)
04/28/2006	21	CERTIFICATE OF SERVICE of Notice of Motion and Motion of Defendant CHF Industries, Inc. for Entry of Summary Judgment of Noninfringement of U.S. Patent Nos. Des. 505,039 and Des. 493,651 and Invalidity of Des. 493,651 and Statement of Material Facts served on Park B. Smith Inc. on 04/28/2006. Document filed by CHF Industries Inc., CHF Industries Inc.. (Arnold, Alison) (Entered: 04/28/2006)
04/28/2006	22	FILING ERROR -DEFICIENT DOCKET ENTRY - MEMORANDUM OF LAW in Support re: 20 MOTION for Summary Judgment of Noninfringement. Document filed by CHF Industries Inc., CHF Industries Inc. (Arnold, Alison) (Entered: 04/28/2006)
04/28/2006	23	CERTIFICATE OF SERVICE of Memorandum of Law in Support of Defendant CHF Industries, Inc.'s Motion for Entry of Summary

		Judgment of Noninfringement of U.S. Patent Nos. Des. 505,039 and 493,651 and Invalidity of Des. 493,651 served on Park B. Smith Inc. on 04/28/2006. Document filed by CHF Industries Inc., CHF Industries Inc.. (Arnold, Alison) (Entered: 04/28/2006)
05/01/2006		***NOTE TO ATTORNEY TO RE-FILE DOCUMENT - DEFICIENT DOCKET ENTRY ERROR. Note to Attorney Alison Arnold to RE-FILE Document 20 MOTION for Summary Judgment of Noninfringement. ERROR(S): Filing Error of Attachment. Rule 56.1 Statement must be filed separately. Event found under Other Answers. (kg) (Entered: 05/01/2006)
05/01/2006	24	MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)*. Document filed by CHF Industries Inc., CHF Industries Inc.. Responses due by 5/12/2006 (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 05/01/2006)
05/01/2006	25	RULE 56.1 STATEMENT. Document filed by CHF Industries Inc., CHF Industries Inc..

		(Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 05/01/2006)
05/01/2006	26	MEMORANDUM OF LAW in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office). Corrected Memorandum of Law with Certificate of Service and Errata attached re Memorandum of Law electronically filed as Document No. 22 on April 28. 2006.* Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Errata to Memorandum of Law)(Arnold, Alison) (Entered: 05/01/2006)
05/01/2006	27	DECLARATION of Nari Jal Mehta in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)..* Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/01/2006	28	DECLARATION of Leo Kavanaugh in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from*

		the Clerk's Office).. Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/01/2006	29	DECLARATION of Ori Katzin in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)*.. Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/01/2006	30	DECLARATION of Paul Leconte in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)*.. Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/01/2006	31	DECLARATION of Nancy Ciaschini in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)*.. Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/01/2006	32	DECLARATION of Jenifer Thoden in Support re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-*

		filed as directed by notice from the Clerk's Office).. Document filed by CHF Industries Inc.. (cd,) (Entered: 05/02/2006)
05/30/2006		Minute Entry for proceedings held before Judge Lawrence M. McKenna : Status Conference held on 5/30/2006 re briefing schedule on deft's motion for summary judgment. (cd,) (Entered: 06/06/2006)
06/30/2006	33	CROSS MOTION for Summary Judgment *Partial of Infringement.* Document filed by Park B. Smith Inc.. (Attachments: # 1 Affidavit Linda Smith# 2 Affidavit De Palma Declaration# 3 Affidavit Durkin Declaration# 4 Exhibit Exhibit A# 5 Exhibit Exhibit B# 6 Exhibit Exhibit C# 7 Exhibit Exhibit D# 8 Exhibit Exhibit E# 9 Exhibit Exhibit F# 10 Exhibit Exhibit G# 11 Exhibit Exhibit H# 12 Exhibit Exhibit I# 13 Exhibit Exhibit J 1-40# 14 Exhibit Ex. J 41-80# 15 Exhibit Ex. J. 81-125# 16 Exhibit Exhibit J 126-164# 17 Exhibit Exhibit J 165-216# 18 Exhibit Exhibit J 217-278# 19 Exhibit Exhibit J 279-329# 20 Exhibit Exhibit J 330-419# 21 Exhibit Exhibit J 420-478# 22 Exhibit Exhibit K)(Ryan, Kathryn)

		(Entered: 06/30/2006)
06/30/2006	34	CROSS MOTION for Summary Judgment *Loacl Rule 56.1 Statement*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 06/30/2006)
06/30/2006	35	CROSS MOTION for Summary Judgment *Brief*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 06/30/2006)
06/30/2006	36	CROSS MOTION for Summary Judgment *Ex. 1 to Brief*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 06/30/2006)
06/30/2006	37	CROSS MOTION for Summary Judgment *Certificate of Service*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 06/30/2006)
06/30/2006	38	RESPONSE to Motion re: 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office). Response to Local R. 56.1 Statement*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 06/30/2006)
07/24/2006	39	ENDORSED LETTER addressed to Judge James C. Francis from Kathryn Ryan dated 7/10/06 re:

		Counsel writes to request an informal conference with the Court in advance of Park B. Smith's prospective motion for a protective order against defendant CHF Industries, Inc.'s CHF's First requests for admissions are patently abusive, and plaintiff need not respond to them. So Ordered. (Signed by Judge James C. Francis on 7/20/06) (jco,) (Entered: 07/24/2006)
07/27/2006	40	ENDORSED LETTER addressed to Judge McKenna from Stephen L. Sulzer dated 7/26/06 re: counsel requests an extension of time from July 31, 1006 to August 9, 2006 for CHF to file its reply memorandum in support of its motion for summary judgment.....; Approved (Signed by Judge Lawrence M. McKenna on 7/27/06) (djc,) (Entered: 07/27/2006)
07/27/2006	41	ENDORSED LETTER addressed to Judge Lawrence M. Mckenna from Stephen L. Sulzer dated 7/26/2006 re: requesting an extension of time from 7/31/2006 to 8/9/2006 for CHF to file its reply memorandum in support of its motion for summary judgment ;if PBS receives an extension of time from 8/15/2006 to 8/25/2006 to file

		its reply memorandum, CHF does not object; CHF also seeks leave to file its submissions in the form of a single consolidated memorandum of law that would combine CHF's reply memorandum in support of its motion for summary judgment with its memorandum in opposition to PBS's cross motion. ENDORSEMENT: Approved. So Ordered. (Signed by Judge Lawrence M. McKenna on 7/27/2006) (lb,) (Entered: 07/28/2006)
08/04/2006	42	ENDORSED LETTER addressed to Judge Lawrence M. McKenna from Stephen Sulzer dated 8/2/06 re: counsel for dft requests permission to file hard copies of exhibits. Granted. (Signed by Judge Lawrence M. McKenna on 8/4/06) (dle,) (Entered: 08/04/2006)
08/09/2006	43	REPLY MEMORANDUM OF LAW in Support re: 33 CROSS MOTION for Summary Judgment *Partial of Infringement.*, 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office).*. Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold,

		Alison) (Entered: 08/09/2006)
08/09/2006	44	NOTICE of Appendix to Defendant CH,F, Inc.'s Consolidated Reply Memorandum re: 43 Reply Memorandum of Law in Support of Motion,. Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 08/09/2006)
08/09/2006	45	COUNTER STATEMENT TO 25 Rule 56.1 Statement. Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 08/09/2006)
08/09/2006	46	DECLARATION of Paul E. Leconte in Support re: 33 CROSS MOTION for Summary Judgment *Partial of Infringement.*, 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office)*.. Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 08/09/2006)
08/09/2006	47	DECLARATION of Ori Katzin in Support re: 33 CROSS MOTION for Summary Judgment *Partial of*

		Infringement., 24 MOTION for Summary Judgment *of Infringement (Document no. 20 re-filed as directed by notice from the Clerk's Office).*. Document filed by CHF Industries Inc., CHF Industries Inc.. (Attachments: # 1 Certificate of Service)(Arnold, Alison) (Entered: 08/09/2006)
08/24/2006	48	ENDORSED LETTER addressed to Judge Lawrence M. McKenna from Kathryn M. Ryan dated 8/23/06 re: a request a one-week extension of time from 8/25/06 to 9/1/06 to file reply papers. ENDORSEMENT: Granted. SO ORDERED. (Signed by Judge Lawrence M. McKenna on 8/24/06) (kco,) (Entered: 08/24/2006)
09/01/2006	49	REPLY MEMORANDUM OF LAW in Support re: 33 CROSS MOTION for Summary Judgment *Partial of Infringement.*. Document filed by Park B. Smith Inc.. (Attachments: # 1 Exhibit 1# 2 Certificate of Service)(Ryan, Kathryn) (Entered: 09/01/2006)
09/11/2006	50	MOTION to Approve Leave to File a Sur-Reply *to Plaintiff Park B. Smith, Inc.'s Reply Memorandum of Law in Further Support of Plaintiff's Cross-Motion for Partial*

		Summary Judgment of Infringement. Document filed by CHF Industries Inc.. (Sulzer, Stephen) (Entered: 09/11/2006)
09/11/2006	51	REPLY MEMORANDUM OF LAW in Opposition re: 33 CROSS MOTION for Summary Judgment *Partial of Infringement. Defendant CHF Industries, Inc.'s Sur-Reply to Plaintiff Park B. Smith, Inc.'s Reply Memorandum of Law in Further Support of Plaintiff's Cross-Motion for Partial Summary Judgment of Infringement.* Document filed by CHF Industries Inc.. (Sulzer, Stephen) (Entered: 09/11/2006)
09/11/2006	52	FILING ERROR - WRONG DOCUMENT TYPE SELECTED FROM MENU - NOTICE of Motion and Motion for Leave to File a Sur-Reply to Plaintiff Park B. Smith, Inc.'s Reply Memorandum of Law in Further Support of Plaintiff's Cross-Motion for Summary Judgment of Infringement re: 50 MOTION to Approve Leave to File a Sur-Reply *to Plaintiff Park B. Smith, Inc.'s Reply Memorandum of Law in Further Support of Plaintiff's Cross-Motion for Partial Summary Judgment of*

		Infringement., 51 Reply Memorandum of Law in Oppisition to Motion,. Document filed by CHF Industries Inc.. (Sulzer, Stephen) Modified on 9/12/2006 (gf,). (Entered: 09/11/2006)
09/12/2006		***NOTE TO ATTORNEY TO RE-FILE DOCUMENT - DOCUMENT TYPE ERROR. Note to Attorney S. Sulzer to RE-FILE Document 52 Notice (Other), Notice (Other), Notice (Other). Use the document type Motion found under the document list Motions. (gf,) (Entered: 09/12/2006)
09/12/2006	53	MOTION for Leave to File Sur-Reply. Document filed by CHF Industries Inc.. (Sulzer, Stephen) (Entered: 09/12/2006)
09/12/2006	54	RESPONSE to Motion re: 53 MOTION for Leave to File Sur-Reply.. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 09/12/2006)
09/13/2006	55	RESPONSE in Support re: 53 MOTION for Leave to File Sur-Reply.. Document filed by CHF Industries Inc.. (Sulzer, Stephen) (Entered: 09/13/2006)
10/03/2006	56	MEMORANDUM AND ORDER granting 50 Motion to Approve file

		sur-reply memorandum, granting 53 Motion for Leave to File Document (not to exceed ten (10) pages by 10/3/06). (Signed by Judge Lawrence M. McKenna on 9/18/06) Copies Mailed by Chambers.(db,) (Entered: 10/03/2006)
10/03/2006	57	RESPONSE in Support re: 33 CROSS MOTION for Summary Judgment *Partial of Infringement. Response to Sur-Reply*. Document filed by Park B. Smith Inc.. (Ryan, Kathryn) (Entered: 10/03/2006)
11/20/2006		Minute Entry for proceedings held before Judge James C. Francis : Interim Pretrial Conference held on 11/20/2006. (dle,) (Entered: 11/30/2006)
11/27/2006	58	ORDER; that discovery is stayed pending determination of the summary judgment motions currently before Judge Mckenna. Counsel shall advise me promptly when those motions are decided. Additional relief as set forth in this Order. (Signed by Judge James C. Francis on 11/27/06) (pl,) (Entered: 11/27/2006)
05/29/2007	59	NOTICE OF CHANGE OF ADDRESS by James P. Calve on behalf of CHF Industries Inc.. New

		Address: Connolly Bove Lodge & Hutz LLP, 1875 Eye Street N.W., Suite 1100, Washington, DC, USA 20006, 202-331-7111. (Calve, James) (Entered: 05/29/2007)
05/29/2007	60	NOTICE OF CHANGE OF ADDRESS by Stephen L. Sulzer on behalf of CHF Industries Inc.. New Address: Connolly Bove Lodge & Hutz LLP, 1875 Eye Street N.W., Suite 1100, Washington, DC, USA 20006, 202-331-7111. (Sulzer, Stephen) (Entered: 05/29/2007)
09/25/2007	61	NOTICE OF CHANGE OF ADDRESS by Alison Joy Arnold on behalf of CHF Industries Inc.. New Address: Heller Ehrman LLP, Times Square Tower, 7 Times Square, New York, New York, USA 10036-6524, (212) 832-8300. (Arnold, Alison) (Entered: 09/25/2007)
10/01/2007	62	NOTICE OF CHANGE OF ADDRESS by Alison Joy Arnold on behalf of CHF Industries Inc.. New Address: Heller Ehrman LLP, Times Square Tower, 7 Times Square, New York, New York, 10036-6524, (212) 763-7600. (pl) (Entered: 10/02/2007)
03/06/2008	63	ORDER denying 33 Motion for

		Summary Judgment; granting 24 Motion for Summary Judgment and defendant's motion for summary judgment of invalidity of the '651 patent is denied. The Clerk is directed to enter judgment in favor of Defendant dismissing the complaint. (Signed by Judge Lawrence M. McKenna on 3/6/08) (cd). (Entered: 03/07/2008)
03/06/2008		Transmission to Judgments and Orders Clerk. Transmitted re: 63 Order on Motion for Summary Judgment,,,, to the Judgments and Orders Clerk. (cd). (Entered: 03/07/2008)
03/10/2008	64	CLERK'S JUDGMENT in favor of CHF Industries Inc. against Park B. Smith Inc.. granting deft's motion for summary judgment for noninfingement and denying pltff's motion (Signed by J. Michael McMahon, Clerk on 3/10/08) (jf) (Additional attachment(s) added on 3/10/2008: # 1 NOTICE OF RIGHT TO APPEAL) (jf). (Entered: 03/10/2008)
04/09/2008	65	NOTICE OF APPEAL from 64 Clerk's Judgment. Document filed by Park B. Smith Inc. Filing fee $ 455.00, receipt number E 647048. *(Notice of Appeal deleted in error*

		and now Reentered.) (tp) (Entered: 04/22/2008)
04/09/2008		Transmission of Notice of Appeal and Certified Copy of Docket Sheet to US Court of Appeals re: 65 Notice of Appeal. (tp) (Entered: 04/22/2008)
04/09/2008		Transmission of Notice of Appeal to the District Judge re: 65 Notice of Appeal. (tp) (Entered: 04/22/2008)
04/09/2008	66	AMENDED NOTICE OF APPEAL TO THE FEDERAL CIRCUIT from 64 Clerk's Judgment. Document filed by Park B. Smith Inc. Filing fee $ 455.00, receipt number E 647048. *(65 Notice of Appeal returned from USCA Second Circuit and is being forwarded to Federal Circuit along with this Amended Notice.)* (tp) (Entered: 04/22/2008)
04/22/2008		Transmission of Notice of Appeal and Certified Copy of Docket Sheet to US Court of Appeals Federal Circuit re: 65 Notice of Appeal, 66 Notice of Appeal to the Federal Circuit. (tp) (Entered: 04/22/2008)
04/22/2008		Transmission of Notice of Appeal to the District Judge re: 65 Notice of Appeal, 66 Notice of Appeal to the Federal Circuit. (tp) (Entered:

		04/22/2008)
05/02/2008		USCA Case Number 2008-1320 from the U.S. Court of Appeals for the Federal Circuit assigned to 65 Notice of Appeal filed by Park B. Smith Inc., 66 Notice of Appeal to the Federal Circuit, filed by Park B. Smith Inc.. (dt) (Entered: 05/09/2008)
05/06/2008	67	JOINT STIPULATION AND ORDER OF DISMISSAL that CHF's Counterclaims are hereby voluntarily dismissed without prejudice. Each party shall bear its own Attorneys' fees, expenses, and costs. (Signed by Judge Lawrence M. McKenna on 5/6/08) (pl) Modified on 5/6/2008 (pl). (Entered: 05/06/2008)
05/20/2008		Minute Entry for proceedings held before Judge Lawrence M. McKenna: Status Conference held on 5/20/2008. (js) (Entered: 06/06/2008)
02/11/2009		USCA Case Number 2008-1320 from the USCA Federal Circuit assigned to 66 Notice of Appeal to the Federal Circuit, filed by Park B. Smith Inc.(tp) (Entered: 02/13/2009)
03/04/2009	68	MANDATE of USCA for the

		Federal Circuit (Certified Copy) as to 65 Notice of Appeal filed by Park B. Smith Inc., 66 Amended Notice of Appeal to the Federal Circuit, filed by Park B. Smith Inc. USCA Case Number 2008-1320. Ordered, Adjudged and Decreed that the judgment of the District Court is VACATED AND REMANDED. Jan Horbaly, Clerk USCA for the Federal Circuit. Issued As Mandate: 2/27/2009. (nd) Modified on 3/4/2009 (nd). (Entered: 03/04/2009)
03/04/2009		Transmission of USCA Mandate/Order to the District Judge re: 68 USCA Mandate,. (nd) (Entered: 03/04/2009)
03/04/2009	69	NOTICE of Substitution of Attorney. Old Attorney: Kathryn M. Ryan, New Attorney: Richard A. DePalma, Address: Thompsom Hine LLP, 335 Madison Avenue, 12th Floor, New York, New York, USA 10017, 212-344-5680. Document filed by Park B. Smith Inc.. (De Palma, Richard) (Entered: 03/04/2009)
03/05/2009	70	SO ORDERED NOTICE OF SUBSTITUTION OF COUNSEL; that Thompson Hine LLP, 335 Madison Avenue, 12th Floor, New

		York, New York 10017, be and hereby is substituted for Baker & McKenzie LLP, 1114 Avenue of the Americas, 4th Floor, New York, NY 10035, as attorneys for plaintiff Park B. Smith Inc. in the above-captioned matter. SO ORDERED. (Signed by Judge Lawrence M. McKenna on 3/5/2009) (tve) Modified on 3/5/2009 (tve). (Entered: 03/05/2009)
03/17/2009	71	CASE MANAGEMENT PLAN AND SCHEDULING ORDER: Next pretrial conference 9/3/09 at 3:30 p.m. Depositions are not to commence prior to 6/1/09; document discovery may proceed; either side may file a motion for summary judgment without a conference or further permission. (Signed by Judge Lawrence M. McKenna on 3/17/2009) (jfe) (Entered: 03/18/2009)
03/17/2009		Minute Entry for proceedings held before Judge Lawrence M. McKenna: Status Conference held on 3/17/2009 on remand in re: Mandate issued by Federal Circuit. All parties present. Court directs counsel to file motion for Admission PHV as to Attorney Todd P. Taylor-admitted today for purposes of this conference only. Court stays

		discovery depositions until May 31, 2009; thereafter, parties to take deposition discovery. Next status conference is set for September 3, 2009 at 3:30pm. (mro) (Entered: 03/18/2009)
03/20/2009	73	MOTION for Todd P. Taylor to Appear Pro Hac Vice. Document filed by CHF Industries Inc.(dle) (Entered: 03/27/2009)
03/24/2009	72	ORDER that the motion is granted and that Todd P. Taylor is admitted to the Bar of this Court pro hac vice. (Signed by Judge Lawrence M. McKenna on 3/24/09) (dle) (Entered: 03/24/2009)
03/24/2009		Transmission to Attorney Admissions Clerk. Transmitted re: 72 Order Admitting Attorney Pro Hac Vice, to the Attorney Admissions Clerk for updating of Attorney Information. (dle) (Entered: 03/24/2009)
03/30/2009	74	NOTICE OF APPEARANCE by Rebecca Anne Brazzano on behalf of Park B. Smith Inc. (Brazzano, Rebecca) (Entered: 03/30/2009)
04/16/2009	75	MOTION for Summary Judgment *of Noninfringement, or in the Alternative, Invalidity of U.S. Patent Nos. Des. 505,039 and Des.*

		493,651. Document filed by CHF Industries Inc..(Sulzer, Stephen) (Entered: 04/16/2009)
04/16/2009	76	MEMORANDUM OF LAW in Support re: 75 MOTION for Summary Judgment *of Noninfringement, or in the Alternative, Invalidity of U.S. Patent Nos. Des. 505,039 and Des. 493,651*.. Document filed by CHF Industries Inc.. (Attachments: # 1 Exhibit 1, # 2 Exhibit 2, # 3 Exhibit 3, # 4 Exhibit 4, # 5 Exhibit 5, # 6 Exhibit 6, # 7 Exhibit 7, # 8 Exhibit 8, # 9 Exhibit A, # 10 Exhibit B, # 11 Exhibit C, # 12 Exhibit D, # 13 Exhibit E, # 14 Exhibit F, # 15 Exhibit G, # 16 Exhibit H, # 17 Exhibit I, # 18 Exhibit J)(Sulzer, Stephen) (Entered: 04/16/2009)
04/16/2009	77	RULE 56.1 STATEMENT. Document filed by CHF Industries Inc.. (Sulzer, Stephen) (Entered: 04/16/2009)
04/23/2009		CASHIERS OFFICE REMARK on 73 Motion to Appear Pro Hac Vice in the amount of $25.00, paid on 03/20/2009, Receipt Number 682197. (jd) (Entered: 04/23/2009)

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(2)

No. 08-1378

Supreme Court, U.S.
FILED
OCT 13 2009
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

CHF INDUSTRIES, INC.,

Petitioner,

v.

PARK B. SMITH, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether a notice of appeal filed within thirty days of a judgment by the District Court, but before the entry of an order dismissing remaining counterclaims (by stipulation), is deemed timely under Fed. R. App. P. 4(a)(2), where the judgment resolved the main claim in the case and rendered the counterclaims moot, and where the appealing party reasonably believed the case had terminated and the other party has not been prejudiced.

RULE 29.6 STATEMENT

Respondent Park B. Smith, Inc. has no parent corporation and no publicly held company owns 10% or more of it stock.

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Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed.Cir. 2008)*(en banc)*, *cert. denied*, No. 08-1031, 77 U.S.L.W. 3556 (U.S. 2009) 11

E-Pass Techs., Inc. v. 3Com Corp., 343 F. 3d 1364 (Fed. Cir. 2003) 7

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Meade Instruments Corp. v. Reddwarf Starware, LLC, No. 99-1571, 2000 WL 987268 (Fed. Cir. June 23, 2000)(non-precedential), *cert. denied*, 534 U.S. 950, 122 S.Ct. 345 (2001) 7, 8

Miller v. Special Weapons, L.L.C., 369 F.3d 1033 (8th Cir. 2004) 8

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Strasburg v. State Bar of Wisconsin, 1 F.3d 468 (7th Cir. 1993), *cert. denied*, 510 U.S. 1047, 114 S.Ct. 698 (1994) 8, 9

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Other:

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STATEMENT OF THE CASE

The Petitioner at p. 4 misrepresents the Memorandum and Order of the District Court as "interlocutory." The Memorandum and Order was a final disposition of Plaintiff's claims of infringement on the two design patents in suit, by granting summary judgment of non-infringement, which were Plaintiff's sole claims in the action.

The Petitioner at p. 5 misrepresents the circumstances surrounding the execution of the stipulation to dismiss the counterclaims, and the reasonable belief Respondent had regarding the finality and appealability of the March 10, 2008, judgment when it filed the Notice of Appeal on April 8, 2008. The counterclaims in this action were garden variety declaratory judgment counterclaims for non-infringement, invalidity and attorneys fees relating to the same two design patents in suit. When Senior District Judge Lawrence M. McKenna granted Petitioner's motion for summary judgment of non-infringement in his Memorandum and Order, and the clerk entered judgment, he did not reserve jurisdiction over any of the claims in the case or order the parties to take any further action; thus, the counterclaims became moot. It was reasonable, therefore, for Respondent to believe that the District Court Memorandum and Order, and judgment entered thereon on March 10, 2008, addressed all of the claims and that the case had been terminated and was ripe for appeal.

Respondent's actions, and the District Court's actions, after Respondent it filed its Notice of Appeal confirm Respondent's reasonable understanding that the case was ripe for appeal. After filing its Notice of Appeal, Respondent was contacted by Petitioner, who insisted that the parties needed to stipulate to dismiss the counterclaims. Although Respondent believed this was unnecessary to terminate the action, it agreed to do so. Respondent did not "negotiate" the terms of the Stipulation of Dismissal, but rather simply signed the Stipulation drafted by Petitioner. Significantly, even the District Court believed that the action had been terminated. When Petitioner attempted to electronically file the Stipulation of Dismissal, the District Court sent the parties an email on May 6, 2008, stating: "WARNING: CASE CLOSED on 03/10/2008", the date the clerk entered judgment on the Memorandum and Order granting summary judgment for non-infringement. (App. pp. 1a-3a).

SUMMARY OF REASONS FOR DENYING THE PETITION

The Petition should be denied because Petitioner has not established that there is a conflict among the circuit courts on the application of *FirsTier Mortgage Co. v. Investors Mortgage Ins. Co.*, 498 U.S. 269, 111 S.Ct. 648 (1991), when Fed.R.App.P. 4(a)(2), is invoked. To the contrary, the circuit courts have applied Fed.R.App.P. 4(a)(2) consistently and uniformly, looking at the facts of the specific case to determine whether the party who filed the Notice of Appeal had a reasonable belief that the case had ended, in accordance with *FirsTier*. A conflict does not arise merely because different courts interpret *FirsTier* differently depending

on the different facts of the case before the court, or because different courts come to different conclusions. *See e.g.* Gressman, Geller, Shapiro, Bishop & Hartnett, *Supreme Court Practice*, Section 4.3 (9th ed. 2007)("[T]here must be a real or 'intolerable' conflict on the same matter of law of fact, not merely an inconsistency in dicta or in the general principles utilized."). Moreover, even if a conflict existed, this is not an appropriate case for this Court to exercise its extraordinary and discretionary jurisdiction to address such a conflict.[1]

REASONS FOR DENYING THE PETITION

I. Petitioner Has Not Established That This Case Meets the Court's Requirements for Granting Certiorari Because There is No Conflict Among the Circuits

Petitioner has not met its burden of establishing a conflict among the circuits in the application of Fed.R.App.P. 4(a)(2) following this Court's decision in *FirsTier*. Indeed, as discussed below, the cases on which Petitioner relies show that there is no conflict.

The issue in *FirsTier* was whether an appeal was timely when it was filed after the District Court handed down an oral decision from the bench and simultaneously requested proposed findings of fact and conclusions of law from the parties but before the District Court issued its findings of fact and conclusions

---

1. Petitioner's assertion that the Federal Circuit violated federal statutes which govern the scope of its jurisdiction, even if true, is not grounds for a writ of certiorari. *See* Supreme Court Rule 10.

of law and before the entry of judgment. 498 U.S. at 271-72. In analyzing the issue, this Court noted that:

> Rule 4(a)(2) was intended to codify a general practice in the courts of appeal of deeming certain premature notices of appeal effective. . . . The Rule recognizes that, unlike a tardy notice of appeal, certain premature notices do not prejudice the appellee and the technical defect of prematurity therefore should not be allowed to extinguish an otherwise proper appeal.

Id. at 273. Without deciding whether the decision of the District Court in *FirsTier* was final, this Court held that "Rule 4(a)(2) permits a notice of appeal filed from certain nonfinal decisions to serve as an effective notice from a subsequently entered final judgment." *Id.* at 274. This Court then went on to provide a framework from which appellate and circuit courts could determine whether Rule 4(a)(2) applies to a given set of facts. In doing so, this Court discussed with approval two cases that were cited by the Advisory Committee's Note to Rule 4(a)(2) where a timely filed appeal was found despite the fact that the notice was filed after a nonfinal judgment. In *Ruby v. Secretary of Navy*, 365 F.2d 385 (9th Cir.), *cert. denied*, 386 U.S. 1011, 87 S.Ct. 1358 (1967), the order of the District Court dismissing the complaint without dismissing the action was not final because the appellant in that case could have amended his complaint. Despite this, the notice of appeal filed after the nonfinal ruling dismissing the complaint was held to be a timely notice from the subsequently filed order dismissing the action. Similarly, in *Firchau v. Diamon Nat'l Corp.*, 345 F.2d

269 (9th Cir. 1965), appellant filed a notice of appeal with respect to only one of the claims dismissed by the District Court. While noting that the ruling dismissing the complaint might not have been appealable, the Ninth Circuit held that the prematurely filed notice was deemed to be a notice of appeal from the subsequently filed judgment dismissing the complaint. From these cases, this Court concluded that "Rule 4(a)(2) was intended to protect the unskilled litigant who files a notice of appeal from a decision he reasonably but mistakenly believes to be a final judgment, while failing to file a notice of appeal from the actual final judgment." *FirsTier*, 498 U.S. at 275-76.

The circuit courts are following the framework laid out by this Court in *FirsTier*. For example, Petitioner cites *Barrett v. Atlantic Richfield Co.*, 95 F.3d 375 (5th Cir. 1996), as an example in which Rule 4(a)(2) is interpreted inconsistently with *FirsTier*. However, the *Barrett* court discussed *FirsTier* in depth and found that the facts in *Barrett* were similar to those in *FirsTier*. Specifically, in both cases the court's order would have been appealable if the court had entered judgment immediately. It is irrelevant that judgment would have been entered using different procedures in the two cases. Therefore, *Barrett* is not inconsistent with *FirsTier*. Neither is *ADAPT of Philadelphia v. Philadelphia Housing Auth.*, 433 F.3d 353 (3rd Cir. 2006). In fact, *ADAPT* falls squarely within the examples set out in *FirsTier*. The orders appealed from were discovery orders, which by the plain language of *FirsTier* do not fall within Rule 4(a)(2). *ADAPT*, 433 F.3d at 363.

Similarly, in *Outlaw v. Airtech Air Conditioning & Heating Inc.*, 412 F.3d 156 (D.C. Cir. 2005), the plaintiff filed a notice of appeal while claims were still pending against one of the defendants. The court then *sua sponte* dismissed the claims against the remaining defendant. The District Court specifically noted that it was dismissing the remaining claim because "otherwise, there may be some question whether the Court's [summary judgment] Order represents a final judgment that may be appealed at this time." *Id.* at 159. The Circuit Court analyzed the issue of the premature filing under *FirsTier*, specifically noting that "prior to *FirsTier*, many circuits had a broader understanding of when a premature notice of appeal could become effective" and that "those prior lines of precedent must be limited in light of *FirsTier*." *Id.* at 160. The *Outlaw* court further noted that this Court's "articulation of its test for applying Rule 4(a)(2) provides some direction." *Id.* at 161. Following the direction set out in *FirsTier*, the *Outlaw* court found that Rule 4(a)(2) applied because the order from which the plaintiff appealed would have been appealable if judgment had been entered pursuant to Federal Rule of Civil Procedure 54(b). *Id.* at 161. It is clear from the detailed analysis conducted by the *Outlaw* court that, contrary to Petitioner's assertion at 29-30, circuit court's are not improperly interpreting Rule 4(a)(2) "broadly" or improperly "ignor[ing] or unduly circumscrib[ing]" the application of *FirsTier*. Therefore, there is no conflict for this Court to address. *See also United States v. Bryson (In re Bryson)*, 406 F.3d 284 (4th Cir. 2005)(court found that all claims had essentially been resolved at the time of the filing of the notice of appeal so the criteria of *FirsTier* was met).

Nor is there a conflict among the published and unpublished decisions of the Federal Circuit, or the Federal Circuit and *FirsTier*. The decisions cited by Petitioner are factually distinguishable from *FirsTier* and the instant action. In *Meade Instruments Corp. v. Reddwarf Starware, LLC*, No. 99-1571, 2000 WL 987268 (Fed. Cir. June 23, 2000)(non-precedential), *cert. denied*, 534 U.S. 950, 122 S.Ct. 345 (2001), the District Court explicitly reserved judgment on one of the claims in the action. Even more significantly, the defendant in *Meade* filed a motion for Rule 54(b) certification on the same day on which it filed its premature notice of appeal. It was clear, therefore, that the defendant did not have a reasonable but mistaken belief that the District Court's order was a final judgment, as required by *FirsTier*. Likewise, in *Stoney Point Products, Inc. v. Underwood*, 15 Fed.Appx. 828 (Fed. Cir. June 7, 2001), the District Court's Order did not dispose of all of plaintiff's claims and a trial date on the remaining claims was set prior to the date on which the defendant filed its premature notice of appeal. The defendant in *Stoney Point*, could not have had a reasonable belief that the District Court's order disposed of all of the claims in the action. The Federal Circuit's decision, therefore, falls squarely within *FirsTier*.[2]

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2. The remaining Federal Circuit cases cited by Petitioner are consistent with *FirsTier*. *See, e.g., E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364 (Fed. Cir. 2003) (premature notice of appeal ripened upon dismissal of counterclaims); *State Contracting & Eng'g Corp. v. Florida*, 258 F.3d 1329 (Fed. Cir. 2001) (premature notice of appeal ripened upon entry of certification).

The decisions discussed above are consistent with the cases which Petitioner asserts interpret Rule 4(a)(2) consistently with *FirsTier*. *See* Petitioner at 31. For example, in *Strasburg v. State Bar of Wisconsin*, 1 F.3d 468 (7th Cir. 1993), *cert. denied*, 510 U.S. 1047, 114 S.Ct. 698 (1994), *overruled on other grounds by Otis v. City of Chicago*, 29 F.3d 1159 (7th Cir. 1994), the District Court retained jurisdiction over some of the claims asserted and explicitly warned plaintiff that its notice of appeal was a "nullity." *Id.* at 469-70. Thus, as in *Meade* and *Stoney Point*, the plaintiff in *Strasburg* could not have had a reasonable belief that the case was fully resolved. Similarly, in *United States v. Cooper*, 135 F.3d 960 (5th Cir. 1998), the defendant filed a notice of appeal from a magistrate judge's report. As with the discovery orders in *ADAPT*, a magistrate's report does not dispose of a party's claims. Thus, both *ADAPT*, which Petitioner asserts conflicts with *FirsTier*, and *Cooper*, which Petitioner claims is consistent with *FirsTier*, are in fact consistent with *FirsTier* and with one another.[3]

3. *See also Barrett v. United States*, 462 F.3d 28 (1st Cir. 2006) (premature notice of appeal from order dismissing some claims ripened because the order would have been appealable if certified); *Fields v. Oklahoma State Penitentiary*, 511 F.3d 1109 (10th Cir. 2007) (premature notice of appeal from an order that did not dispose of all of the claims may ripen upon a subsequent final order having finality indicia); *Miller v. Special Weapons, L.L.C.*, 369 F.3d 1033(8th Cir. 2004)(no jurisdiction on appeal found where unresolved claims at time of notice of appeal were pending and claimant moved to amend claim to plead new legal basis).

Petitioner's writ should be denied because there is no conflict between the circuits on the application of Fed.R.App.P. 4(a)(2) in view of *FirsTier*.

II. Even if a Conflict Existed, The Petition Should be Denied Because This is Not The Proper Case For This Court to Exercise Its Extraordinary and Discretionary Jurisdiction to Resolve That Conflict

Petitioner's assertion that Respondent's Notice of Appeal was not timely because the decision of the District Court in the instant action was not final, suffers from the same defect as the argument of IMI in *FirsTier*. As this Court explained in *FirsTier*, the decision of the District Court need not be "final" at the moment it is issued. Rule 4(a)(2) "permits a premature filing of notice of appeal from [the District Court decision] to relate forward to judgment and serve as an effective notice of appeal *from the final judgment.*" *Id.* at 275 (emphasis in original). The litigant need not have a reasonable belief that he is appealing from a "final" decision, just a reasonable belief that the case had ended. *See Strasburg*, 1 F.3d at 471. The District Court's Order in the instant action disposed of the main claim and rendered the counterclaims moot. It was as reasonable for Respondent in the instant action to believe that the case had ended as it was for the appellants in *Ruby* and *Firchau*, both of which were discussed with approval and relied upon by this Court in deciding *FirsTier*.

The rationale and public policy behind the prohibition against the appeal of clearly nonfinal orders that do not dispose of all claims in the case does not apply to the instant action. Clearly interlocutory orders

such as discovery orders are not appealable to prevent piecemeal litigation and unnecessary delays in litigations while the trial court waits for a decision on each of its orders. Moreover, parties attempting to appeal such orders cannot have any reasonable belief that such cases had been terminated. In contrast, in this matter, the order appealed from resolved the matter on the merits, and Respondent reasonably believed that the case had ended. As evidenced by the District Court's email to the parties after the Stipulation of Dismissal was filed by Petitioner on the counterclaims, even the District Court believed the case had ended. The facts of the instant case, thus, fall squarely within this Court's opinion in *FirsTier*. As this Court noted in *FirsTier*, in circumstances such as these

> the litigant's confusion is understandable, and permitting the notice of appeal to become effective when judgment is entered does not catch the appellee by surprise. Little would be accomplished by prohibiting the court of appeals from reaching the merits of such an appeal.

FirsTier, 498 U.S. at 276. As with *FirsTier*, "this case presents precisely the situation contemplated by Rule 4(a)(2)'s drafters." *Id.* at 277. This case, therefore, is not the right one in which to address any alleged conflict among the circuits. This Court should wait for a case in which the appellate court has misinterpreted and misapplied *FirsTier* so that its ruling would be outcome determinative.

Finally, this case is inappropriate for this Court's review because the standard applied by the District Court for determining infringement for design patents was corrected by the Federal Circuit during the pendency of this matter. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)*(en banc)*, *cert. denied*, No. 08-1031, 77 U.S.L.W. 3556 (U.S. 2009). As a result, while the District Court's summary judgment ruling disposed of the claims in this matter, it applied a standard for design patent infringement determined by the Federal Circuit to be in need of correction, and the case was remanded to the District Court, where the case now resides, to apply that corrected standard. If this Court wishes to revisit the issues addressed in *FirsTier*, it should do so with a case in which there is no doubt that the correct legal standard was applied by the trial court in deciding the merits of the action.

This is not a proper case for this Court to exercise its extraordinary and discretionary jurisdiction to address any alleged conflict in applying *FirsTier*.

CONCLUSION

The Petition raises no compelling reason for review, and it should be denied.

Respectfully submitted,

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APPENDIX

APPENDIX — E-MAIL FROM THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

From: NYSD_ECF_Pool@nysd.uscourts.gov
[mailto: NYSD_ECF_Pool@nysd.uscourts.gov]
Sent: Tuesday, May 06, 2008 5:05 PM
To: deadmail@nysd.uscourts.gov
Subject: Activity in Case 1:06-cv-00869-LMM-JCF Park B. Smith Inc. v. CHF Industries Inc. Stipulation and Order of Dismissal

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Supreme Court, U.S.
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No. 08-1378

In The Supreme Court of The United States

CHF INDUSTRIES, INC.,

Petitioner,

v.

PARK B. SMITH, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

STATEMENT

Petitioner CHF Industries, Inc. ("CHF") respectfully submits this Reply Brief in support of its Petition for Writ of Certiorari. In attempting to reconcile the Federal Circuit's misapplication of Rule 4(a)(2) with this Court's decision in *FirsTier Mortgage Co. v. Investors Mortgage Insurance Co.*, 498 U.S. 269 (1991), Respondent Park B. Smith, Inc. ("PBS") contends that it reasonably believed the District Court's partial summary judgment ended the case. No litigant could have a *reasonable* belief that this case was finished when partial summary judgment was entered in March 2008, because the plain words of Federal Rule of Civil Procedure 54(b) make it abundantly clear that a partial summary judgment, in and of itself, does not end a litigation.

Moreover, PBS's state of mind when the District Court entered partial summary judgment on March 6, 2008 (or its Rule 58 judgment on March 10, 2008) is inconsequential in this case. Even if PBS mistakenly believed on March 10, 2008 that the case had ended, the evidence of record conclusively demonstrates that PBS actually knew, at least as of April 23, 2008, that neither the March 6 partial summary judgment, nor the March 10 Rule 58 judgment, had ended the case or were final, appealable orders.

PBS tries without success to explain away the conflict between the Federal Circuit's decision below and the rationale set forth in *FirsTier*, as well as the

split between the Circuits as to whether Rule 4(a)(2) should apply to partial summary judgments like the one entered here. PBS selectively focuses on procedural details in the case law when it suits PBS's purposes and ignores them when it does not. Contrary to PBS's analysis, there is a clear conflict between the Federal Circuit's decision below and the rationale of *FirsTier,* and there is a well-recognized and troublesome split between the Circuits that should be resolved by this Court.

If anything, PBS's opposition brief highlights the confusion in the Circuits and further demonstrates why the Court should grant Petitioner's request for a writ of certiorari.

I. THE FEDERAL CIRCUIT'S DECISION DIRECTLY CONFLICTS WITH *FIRSTIER.*

A. Respondent Did Not Have a Reasonable Belief That the District Court's Partial Summary Judgment Ended the Case.

The Supreme Court explained in *FirsTier* that "Rule 4(a)(2) was intended to protect the unskilled litigant who files a notice of appeal from a decision ***that he reasonably but mistakenly believes to be a final judgment,*** while failing to file a notice of appeal from the actual final judgment." 498 U.S. at 276 (emphasis added). The Court added that Rule 4(a)(2) does not permit a notice of appeal "from a clearly interlocutory decision — such as a discovery ruling . . . — to serve as a notice of appeal from the final judgment." *Id.* The

Court so held because "[a] belief that such a decision is a final judgment would *not* be reasonable." *Id.*

PBS argues that there is no conflict between the Federal Circuit's decision here and *FirsTier* because PBS allegedly had a reasonable belief that the case ended when partial summary judgment was entered dismissing PBS's infringement claims. (Opp. Br. 9, 10.) This argument is factually and legally flawed, for several reasons.

First, no litigant faced with the circumstances here could have a ***reasonable*** belief that the case was finished when partial summary judgment was entered in March 2008, because, by definition, a partial summary judgment is an interlocutory order that leaves some claims or counterclaims to be litigated. Regardless of PBS's relative level of skill as a litigant, the plain words of Rule 54(b) of the Federal Rules of Civil Procedure make it abundantly clear that a partial summary judgment, in and of itself, is not a final, appealable judgment, and does not end the litigation. Fed. R. Civ. P. 54(b) (A-95).

Second, PBS's alleged belief that "the case had ended" as of March 6, 2008 (Opp. Br. 9, 10) became immaterial when, on April 23, 2008, PBS expressly acknowledged on the record that the case was not over. The only significant evidence on this point — *i.e.*, the parties' jointly stipulated dismissal of CHF's remaining counterclaims — is dispositive. (A-29 – A-32.) The Joint Stipulation & Order of Dismissal ("JSOD") conclusively establishes that, at least as of April 23, 2008, when PBS's counsel executed it, PBS had ***actual knowledge*** that the

partial summary judgment it wished to appeal was ***not*** a final judgment, because CHF still had pending counterclaims, of real substance, that had to be resolved.

The JSOD expressly acknowledges that CHF had asserted counterclaims seeking a declaration that the patents-in-suit are invalid under 35 U.S.C. §§ 102, 103, 112, and 171, as well as a declaration that this case is exceptional under 35 U.S.C. § 285. (A-30.) The JSOD also expressly acknowledges that all of those counterclaims were still pending in the litigation. (A-31.) Finally, the JSOD stipulated that CHF's counterclaims were being voluntarily dismissed, ***without prejudice***. (*Id.*) The JSOD leaves no doubt that, at least as of April 23, 2008, PBS actually knew that the case had not ended, and that neither the District Court's March 6, 2008 partial summary judgment nor its March 10 Rule 58 judgment was effective as a final judgment.

Both the Federal Circuit and the Seventh Circuit have acknowledged that "a litigant seeking to take advantage of Rule 4(a)(2)'s saving provision must continue to be reasonably 'confused as to the status of the litigation' . . . until final judgment is actually entered." *Meade Instrs. Corp. v. Reddwarf Starware, LLC*, No. 99-1517, 2000 WL 987268, *3 (Fed. Cir. June 23, 2000) (non-precedential), quoting *Strasburg v. State Bar of Wisconsin*, 1 F.3d 468 (7th Cir. 1993) (A-65, A-70). Once the litigant becomes aware that its notice of appeal is invalid because no final judgment has yet been entered, it has both the knowledge and the opportunity (for thirty more days) to correct the mistake. *Id.* Thus, to perfect its appeal here, PBS needed to file a notice of appeal within 30 days of the date that judgment was

deemed entered under Fed. R. Civ. P. 58(c)(2)(B). This PBS inexcusably failed to do.

Third, PBS attempts to justify its alleged belief that the case was over with the bald assertion that CHF's counterclaims somehow became moot. (Opp. Br. i, 1, 9.) As a matter of due process, a defendant's counterclaims do not simply vanish when a plaintiff's claims are dismissed. *See, e.g., Altvater v. Freeman*, 319 U.S. 359, 363 (1943) ("We have here not only bill and answer but a counterclaim. Though the decision of non-infringement disposes of the bill and answer, it does not dispose of the counterclaim which raises the question of validity . . . ."); *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 99-101 (1993) (approving of district court decisions to consider invalidity even where they find that a patent is not infringed, and noting that "validity has the greater public importance.").

In this case, CHF has a substantial interest in prevailing on its invalidity counterclaims, so that it will not face additional infringement claims under the patents-in-suit. *See id.* at 99-100 ("A company once charged with infringement must remain concerned about the risk of similar charges if it . . . markets similar products in the future."). CHF also has a real interest in prevailing on its exceptional case counterclaim, which would permit CHF to recover attorneys' fees. If, as Respondent now asserts, CHF's counterclaims were moot, or could be lightly disregarded as mere "garden variety declaratory judgment counterclaims" (Opp. Br. 1), CHF would not have insisted on a stipulation dismissing its counterclaims ***without prejudice.***

Further still, if Petitioner's counterclaims were actually mooted by the District Court's partial summary judgment (or by its entry of the March 10 Rule 58 judgment), the District Court would not have accepted the parties' Joint Sitpulation, and would not have endorsed it as "SO ORDERED," or entered it on May 6, 2008. (*See* A-32; A-136 (Docket No. 67).)

In short, regardless of PBS's belief in March, at least as of April 23, 2008, PBS was fully aware that the case had not ended, and that neither the District Court's March 6 partial summary judgment nor its March 10 Rule 58 judgment was effective as a final judgment. That knowledge was re-confirmed on May 6, 2008, when the District Court entered the parties' Joint Stipulation as its own Order of Dismissal, finally closing the case.

As purported evidence of finality, Respondent points only to an e-mail from the Court Clerk's office indicating "CASE CLOSED on 03/10/2008." (Opp. Br. 2, 10.) That *pro forma* notice was automatically generated in response to the parties' Joint Stipulation, and District Judge McKenna's entry of the Joint Stipulation as his own Order of Dismissal. (*See id.* at A-1a – A-3a.) If there was still any thought in PBS's mind as to whether the case was closed in March 2008, Petitioner submits that Judge McKenna's May 6, 2008 Order trumps the Clerk's computer-generated notice. And this is particularly true where, as here, Respondent had expressly acknowledged in the parties' April 23, 2008 Joint Stipulation that the case indeed was not yet over.

For all these reasons, no litigant could have had a reasonable belief that the case had ended in March 2008. In these circumstances, the Federal Circuit's decision to give effect to PBS's premature notice of appeal clearly flies in the face of the basic requirement set forth in *FirsTier*.

B. Partial Summary Judgments Do Not Meet the Rationale of *FirsTier* Because They Do Not Give Rise to a Reasonable Belief That They Are Final Judgments.

Respondent also argues implicitly that there is no conflict between the Federal Circuit's decision here and the Supreme Court's decision in *FirsTier* because the District Court's partial summary judgment would have been appealable upon entry of a final judgment pursuant to Rule 54(b) of the Federal Rules of Civil Procedure. (Opp. Br. 6.) Contrary to Respondent's assertions, a partial summary judgment cannot meet the basic requirement of *FirsTier*, because partial summary judgments, by definition, never dispose of all claims, counterclaims, or other claims in a case, and by their very nature cannot give rise to a ***reasonable*** belief that they are final judgments, in either legal or practical terms.

The Court in *FirsTier* does state that Rule 4(a)(2) would render a premature notice of appeal effective "when a district court announces a decision that *would be* appealable if immediately followed by the entry of judgment." 498 U.S. at 276. The Court said this in a factual context that involved only one plaintiff, one

defendant, and one set of claims, all of which were resolved by a decision announced from the bench. As the Court observed, in those circumstances, there was no question that the district court's bench ruling would have been appealable under 28 U.S.C. § 1291 had the judge issued a Rule 58 judgment immediately following the bench ruling, and had the clerk entered the judgment on the docket. *Id.* at 277. The *FirsTier* Court doesn't refer to partial summary judgments, or cite to Federal Rule of Civil Procedure 54(b). This makes sense because, by definition, partial summary judgment orders do not dispose of all claims and counterclaims in a case, and by their very nature cannot give rise to a reasonable belief that they are final judgments, in either legal or practical terms.

The *FirsTier* Court thus addressed two extreme sets of circumstances — on the one hand, cases where the district court announces a decision that is clearly final, in the sense that it disposes of all claims or counterclaims in the case, and leaves nothing to be done other than the ministerial act of entering final judgment, and on the other hand, cases where the district court announces a clearly non-final order, such as a discovery order. As the Circuits have recognized, there is a wide range of procedural circumstances that fall between these two extremes. *See, e.g., Outlaw v. Airtech Air Cond. & Heating, Inc.*, 412 F.3d 156, 161 (D.C. Cir. 2005).

This has left open the question of whether a premature notice of appeal from a partial summary judgment order is effective under Rule 4(a)(2), because it "would be appealable" if immediately followed by the

entry of judgment. *See, e.g.,* Michael E. Tigar & Jane B. Tigar, Federal Appeals Jurisdiction and Practice § 6.3 (3d ed. 2008) (*FirsTier* "has posed problems" in cases where, when a notice of appeal is filed, the district court has not completed adjudication on all issues). This question cries out to be resolved in this case because, as shown above and in Part II. below, decisions in the Federal Circuit and other Circuits clearly conflict with the rationale set forth in *FirsTier.* Moreover, as shown below, the Circuits have been in open and unresolved conflict with each other over this issue for years.

II. THE CIRCUITS ARE DEEPLY SPLIT CONCERNING THE CORRECT APPLICATION OF RULE 4(A)(2).

There is unquestionably a deep split in the Circuits and widespread confusion as to the correct application of Rule 4(a)(2), particularly with respect to premature appeals from partial summary judgments. Respondent engages in a superficial, but failed effort to reconcile the conflicting decisions from the Federal Circuit and other Circuits with each other and *FirsTier.* (Opp. Br. 5-9.) But the cases themselves recognize the split that exists among the Circuits. *E.g., State Contracting & Eng'g Corp. v. Florida,* 258 F.3d 1329, 1335 (Fed. Cir. 2001) (noting the split as to whether a premature notice of appeal ripens upon entry of a Rule 54(b) certification); *Miller v. Special Weapons, L.L.C.,* 369 F.3d 1033, 1035 (8th Cir. 2004) (disagreeing with Circuits that apply a rule of "cumulative finality").

Moreover, numerous articles comment on the substantial split and confusion surrounding *FirsTier*. *E.g.*, Peter R. Afrasiabi, *The Growing Split Over Whether Premature Notices of Appeal Preserve Appellate Review*, 55-JUL Fed. Law. 42 (2008) (identifying Circuit splits, including the split concerning partial summary judgments); Bruce P. Merenstein, *Premature Notices of Appeal*, The Legal Intelligencer, Sept. 5, 2008, http://thelegalintelligencer.typepad.com/tli/2008/09/premature-notic.html ("This confusion is unlikely to abate until . . . the Supreme Court resolves the circuit split that has followed its decision in FirsTier.").

Respondent attempts to explain Petitioner's cases that illustrate the unmistakable split in the Circuits, trying to show why each case was decided properly within the framework of *FirsTier*. Respondent's analysis misses the point — *i.e.*, that the disposition of each case involving a premature notice of appeal depended on the Circuit in which the case was filed. The First, Fourth, Tenth, and D.C. Circuits interpret the scope of Rule 4(a)(2) broadly even after *FirsTier*. The Seventh and Eighth Circuits interpret Rule 4(a)(2) narrowly and more consistently with the rationale of *FirsTier*. And the Third, Fifth, and Federal Circuits have cases that follow both approaches.

The Federal Circuit's order taking jurisdiction in this case (A-6) does not cite any authority, but appears to follow the Federal Circuit cases that directly conflict with both the rationale of *FirsTier* and the intent of Rule 4(a)(2). *E.g.*, *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1367 (Fed. Cir. 2003); *State Contracting*, 258 F.3d at 1335.

There is also a separate, unpublished line of Federal Circuit cases that applies Rule 4(a)(2) consistently with *FirsTier*, and declines to save premature notices of appeal under the circumstances of this case. *See Meade*, 2000 WL 987268, *3 (A-65, A-71); *Stoney Point Prods., Inc. v. Underwood*, 15 Fed.Appx. 828, 831 (Fed. Cir. June 7, 2001) (non-precedential) (A-73, A-77 – A-78). Respondent seeks to explain these cases on grounds that additional procedural events (*e.g.*, the defendant filing a motion for Rule 54(b) certification simultaneously with its premature notice of appeal in *Meade*, and the court setting a trial date on the remaining claims in *Stoney Point*) negated any mistaken belief that the partial summary judgment was a final judgment. (Opp. Br. 7.) However, Respondent's entry into the Joint Stipulation here and the District Court's entry of the Joint Stipulation as an Order eliminate any meaningful distinction between this case and *Meade* or *Stoney Point*. The Federal Circuit should have followed *FirsTier* and these cases that follow *FirsTier*.

In addition to the split within the Federal Circuit, there is a deep split between the other Circuits on this issue. For example, in *Outlaw*, 412 F.3d at 161-63, the D.C. Circuit held that Rule 4(a)(2) saved a premature notice of appeal filed after a partial summary judgment, in direct conflict with decisions such as *Miller*, 369 F.3d at 1035 (8th Cir.), and *DeJohn v. Temple University*, 537 F.3d 301, 307 n. 3 (3d Cir. 2008), which take the opposite approach. Nothing in Respondent's exegesis adequately addresses this split of authority.

At bottom, Respondent has failed to reconcile the Circuit split after *FirsTier*, particularly in the procedural circumstances of this case. If anything, that split has only worsened since *FirsTier* was decided more than 18 years ago. This Court should grant certiorari to resolve the division in the Circuits over the scope of Rule 4(a)(2) and the proper application of *FirsTier*.

III. RESPONDENT HAS NOT IDENTIFIED ANY EQUITIES THAT WARRANT DENIAL OF CERTIORARI.

Finally, Respondent urges this Court to look the other way because the Federal Circuit revised the test for design patent infringement and Respondent would like to try its hand under the revised test. (Opp. Br. 11.) But the Federal Circuit's jurisdictional statute, Rule 4(a)(2), and *FirsTier* trump Respondent's desire. As this Court observed in *United States v. City of N.Y.*, 129 S.Ct. 2230, 2236 (2009), it must decide jurisdictional questions "irrespective of the possibility of harsh consequences."

In fact, the only prejudice here will be to the Petitioner, if the Court declines to grant certiorari. Unless the Federal Circuit's error is corrected, Petitioner will be deprived of the repose it should have been granted, and will continue to suffer the waste of resources required to litigate a case that should have ended more than a year ago.

CONCLUSION

For the foregoing reasons, the writ of certiorari should be granted.

Respectfully submitted,

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